

BULKY DOCUMENTS

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Proceeding/Serial No: 91161373

Filed: 01-12-2007

Title: Notice of Filing of Testimony Deposition
Transcript Pursuant to 37 C.F.R. 2.125(c)

Part 1 of 2



TTAB
78 136 703

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN ITALIAN PASTA COMPANY)

Opposer,)

v.)

Opposition No. 91/161,373

BARILLA G. E R. FRATELLI -)
SOCIETA PER AZIONI)

Applicant.)

01-12-2007

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

NOTICE OF FILING OF TESTIMONY DEPOSITION
TRANSCRIPT PURSUANT TO 37 C.F.R. § 2.125(c)

Applicant, BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI ("Applicant") hereby give notice to Opposer, AMERICAN ITALIAN PASTA COMPANY ("Opposer") in the above-identified Opposition proceeding that a certified transcript and accompanying exhibits 10-28 of the testimony deposition of Kenneth B. Germain taken by Applicant on December 20, 2006 in Chicago, Illinois (attended by Cheryl Burbach on behalf of Opposer and Brian Banner, Esq. on behalf of Applicant), has been filed with the U.S. Patent and Trademark Office, before the Trademark Trial and Appeal Board. This transcript and Applicant deposition exhibits 17B, 18, 21, and 22 are being filed under seal pursuant to the Protective Order entered in this case. A redacted copy of the Germain deposition, excluding the confidential portions, is also appended for the public record. All of Applicant's exhibits except for 17B, 18, 21, and 22 are available for the public record. Please note that 17B is incorrectly referred to as exhibit 16B in the transcript.

Counsel for Applicant has filed and served the transcript and accompanying exhibits 10-28 in accordance with the rules of the Trademark Trial and Appeal Board.

January 11, 2007

Respectfully submitted,
BARILLA G. E R. FRATELLI -
SOCIETA PER AZIONI

By: Brian Banner
Brian Banner, Esq
G. Franklin Rothwell, Esq.
Rothwell, Figg, Ernst & Manbeck
1425 K Street N.W.
Suite 800
Washington D.C. 20005

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the following **NOTICE OF FILING OF TESTIMONY DEPOSITION TRANSCRIPT PURSUANT TO 37 C.F.R. § 2.125©**) was served on this 12th day of January, 2007, by U.S. Mail postage pre-paid on the following counsel for Opposer:

Thomas H. Van Hoozer, Esq.
Hovey Williams, LLP.
2405 Grand Boulevard
Suite 400
Kansas City, Missouri 64108



Patrick Collares

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL
AND APPEAL BOARD

ORIGINAL

AMERICAN ITALIAN PASTA)
COMPANY) OPPOSITION NO. 91161373
OPPOSER)
VS.)
BARILLA G.E.R.)
FARTELLI-SOCIETA PER) DEPOSITION TAKEN ON
AZIONI) BEHALF OF APPLICANT
APPLICANT.)

* * * * *

DEPONENT: KENNETH B. GERMAIN

DECEMBER 20, 2006

12:56 P.M.

Reported by: Jennifer E. Davis, CSR

1 APPEARANCES:

2 On behalf of the Plaintiffs,
3 Cheryl L. Burbach, Esq.
4 Hovey Willlliams, LLP
5 2405 Grand Boulevard, Suite 400
6 Kansas City, Missouri 64108
7 (816) 474-9057

8 On behalf of the Defendants,
9 Brian E. Banner, Esq.
10 Rothwell, Figg, Ernst & Manbeck P.C.
11 1425 K Street, NW, Suite 800
12 Washington, D.C. 20005
13 (202) 783-6040

14 * * * * *

1 S T I P U L A T I O N S

2 IT IS HEREBY STIPULATED AND AGREED by and between
3 counsel for the applicant and counsel for the opposer that
4 this deposition may be taken in stenographic shorthand by
5 Jennifer E. Davis, Certified Court Reporter, and afterwards
6 reduced into typewriting.

7 IT IS FURTHER STIPULATED AND AGREED by and between
8 the parties that presentment to the attorneys of record of
9 a copy of this deposition shall be considered submission
10 to the witness for signature pursuant to 703.01(j) --
11 37 CFR 2.123(e) (5); but shall in no way be considered as
12 a waiver of the witness's signature, to be signed by the
13 witness at any time before or at the trial of this case,
14 and if not signed by the time of trial it may be used as if
15 signed.

16 IT IS FURTHER STIPULATED AND AGREED between
17 counsel for the respective parties hereto that the
18 deposition of the witness may be signed before a notary
19 public

20 * * * * *

21

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24

I N D E X

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WITNESS: KENNETH B. GERMAIN

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KENNETH B. GERMAIN

Having been previously sworn the Witness testified as follows:

DIRECT EXAMINATION

BY MR. BANNER:

Q. Mr. Germain, my name is Brian Banner. I'll be taking your deposition in this matter today on behalf of Barilla. When I conclude Ms. Cheryl Burbach representing the opposer will be taking your cross. As you know testimonial depositions are like a trial, but there's no judge. In an opposition proceedings such as this, no judge is around so we are going to take your verbal answers to my verbal questions down, and that's going to be used in a brief before the Trademark Trial and Appeal Board; do you understand?

A. Yes.

Q. I'll ask you to speak clearly, and not nod your head in any direction so that the court reporter can report what your answers to my questions are. On occasions I mess up a question, and if you don't understand

1 what I'm asking you, stop and ask me to
2 rephrase the question.

3 A. Yes, sir.

4 Q. Please understand that if you need a break
5 at any time or water or coffee or whatever,
6 answer the question that's been asked of
7 you, and then we will stop, and you can
8 have a break. Sometimes it happens that
9 you will give an answer to a question and
10 we will go on. Then you will remember
11 something to highlight or magnify your
12 answer, and you'll want to tell us what
13 that is. If that happens, tell us that you
14 want to add something to your previous
15 answer, and at that point in time, while
16 it's fresh in your mind we will stop and
17 you can add that to your prior answer.
18 You're not -- are you taking any
19 medications or prescriptions that might
20 make it difficult for you to understand
21 what's going to happen in this deposition
22 today?

23 A. No.

24 Q. Would you please state your full name for

1 the record?

2 A. Kenneth Barry Germain.

3 Q. Want to spell your middle?

4 A. Spell?

5 Q. The middle name?

6 A. B-A-R-R-Y.

7 Q. Okay. Are you appearing today pursuant to
8 the Notice of Deposition that I have marked
9 Exhibit 10?

10 MR. BANNER: Please mark this Exhibit 10.

11 (Applicant's Exhibit No. 10 was marked for the purpose of
12 identification.)

13 A. Yes. And there's an attached subpoena
14 also.

15 Q. Okay. Please tell us your educational
16 achievements since high school?

17 A. I attended Rutgers College, part of Rutgers
18 University, and received a Bachelorette
19 degree in 1966. Had academic honors, Phi
20 Beta Kappa stuff like that. I proceeded
21 immediately to law school and went to New
22 York University where I obtained a JD
23 degree in 1969. I was on the NYU Law
24 Review, generally a good student. Those

1 are all my academic degrees.

2 Q. Thank you. Who is your current employer?

3 A. I'm a partner at Thompson Hine, LLP in the
4 Cincinnati office.

5 Q. Were you ever employed by a corporation or
6 an individual as a brand director or
7 marketing director?

8 A. No.

9 Q. Did you ever teach trademark law?

10 A. Many times.

11 Q. When and where?

12 A. My first academic appointment, well, my
13 first professorial appointment was at the
14 University of Kentucky in Lexington,
15 Kentucky. I started there in 1971, and as
16 early as the winter term of 1972 I taught a
17 course called, Unfair Trade Practices which
18 is sort of an introduction to what we now
19 call Intellectual Property Law. From that
20 time forward, almost every year I have
21 taught that course, a revised version of
22 that course, another course called
23 Trademarks and Unfair Competition or
24 another course called Trademark Practice

1 and Procedure, most years.

2 Q. Okay. Thank you. In teaching trademark
3 law, did you ever have an occasion to
4 review proper trademark use versus improper
5 trademark use?

6 A. Yes. It's a typical topic for those
7 courses.

8 Q. Can you explain for me what proper
9 trademark use is?

10 A. Trademark use or also called use as a
11 trademark, means that the party claiming
12 that it has created a trademark has put
13 that mark on goods or on packages or goods
14 or on shelf displays used in close in
15 connection with goods, the thing claimed to
16 be the trademark, in a way such that normal
17 buyers and normal competitors would
18 perceive that there is a claim that this
19 term or name or symbol or device identifies
20 and distinguishes the source of those
21 goods.

22 Q. Thank you. Is there, is there any
23 requirements for marking a trademark that
24 is normal before it is registered?

1 A. There's no requirement, but it is fairly
2 typical for a party claiming that a word,
3 name, symbol or device is a trademark to
4 adorn that word, name, symbol or device
5 with a TM symbol. TM short form for
6 trademark. It's a way of saying, I view
7 this as a trademark, and I hope you do
8 also.

9 Q. And if a mark is federally registered is
10 there some sort of -- is there any symbol
11 that one would normally be able to attach
12 with the trademark?

13 A. Yes. The most normal symbol is a capital R
14 in a circle. It's the federal registration
15 symbol. One could also use a legend
16 registered at the United States Patent and
17 Trademark Office or the phrase, registered
18 trademark. Those all would serve the same
19 purpose.

20 Q. Thank you. In teaching trademark law, did
21 you ever review cases dealing with the
22 issue of genericness of a trademark?

23 A. Well, once again, genericness is a very
24 common topic with the general validity of

1 marks. And genericness came up in every
2 iteration of a trademark or trademark
3 related course that I've ever taught.
4 Beyond that I've, of course, been aware of
5 cases on genericness because of my
6 practice, and because of my work as an
7 expert witness, and of my work as a
8 lecturer.

9 Q. Okay. Thank you. In teaching trademark
10 law, did you ever review cases on acquired
11 distinctiveness?

12 A. Pretty much the same answer as the last
13 one. Acquired distinctiveness, also known
14 as secondary meaning, is a common topic in
15 all trade dress and trademark related
16 cases. Unless a mark is inherently
17 distinctive it has to have acquired
18 distinctiveness, also known as secondary
19 meaning, before it can be recognized to be
20 a mark.

21 Q. Thank you. Have you ever studied case law
22 on the evidence necessary to prove acquired
23 distinctiveness?

24 A. Yes.

1 Q. Can you tell me a little bit about what is
2 needed for acquired distinctiveness?

3 A. Yes. The concept is that a term, typically
4 a term which in it's inception is
5 descriptive of the relevant goods or
6 services, over time, and through
7 advertising promotions, declarations, use
8 of trademark, notators like TM and R -- not
9 R in a circle but TM. That the term can
10 take on a second in time, sometimes called
11 secondary meaning, as a trade indicator and
12 not merely as a descriptive term. So
13 length of time in use, mode of use
14 particularly focus on the term and claims
15 of trademark status, amount of advertising,
16 particularly focused advertising on this
17 term. Sometimes look for claims. Look for
18 this color. Look for this mark. That's a
19 symbol of our proprietorship. All of those
20 things help to establish secondary meaning.

21 Q. Okay. In teaching trademark law, did you
22 ever have an occasion to review the
23 difference between mere advertising and
24 trademark usage?

1 A. Yes.

2 Q. Can you please tell me what mere
3 advertising and trademark usage, how they
4 differ?

5 A. Well advertising, whether it's called mere
6 or not, is designed to draw attention to a
7 product or service and to excite a desire
8 to buy it. A lot of advertising is focused
9 on characteristics or at least claimed
10 characteristics of the product or service.
11 Buy my product because it runs well, lasts
12 longer, stands up under pressure better,
13 descriptive things, is less expensive.
14 Trademark usage is different in that its
15 purpose is to identify the purveyor and to
16 distinguish that purveyor from other
17 purveyors of similar goods or services.

18 Q. Okay. Thank you. In teaching trademark
19 law do you continue to study and review
20 case law dealing with proper trademark
21 usage?

22 A. Yes.

23 Q. Have you ever lectured to employees of the
24 United States Patents and Trademark Office

1 on trademark law or trademark practice?

2 A. Yes, both.

3 Q. When?

4 A. I think my first lecture to the USPTO
5 trademark examining operation -- that's the
6 examiners -- was back in the mid 80s. And
7 I think that was on the substantive topic
8 of the certain sections of the Lanham Act.
9 At that time my recollection tells me that
10 there were some members, they were then
11 called members of the Trademark Trial and
12 Appeal Board, in attendance. In the later
13 years I have lectured there to the same
14 kind of audience on numerous occasions.
15 I'm guessing half a dozen, and all of those
16 occasions I lectured on recent
17 developments in cases. Perhaps some
18 statutory developments on a wide variety of
19 topics.

20 Q. So you -- do you follow the legislative
21 developments and case law developments in
22 trademark law and practice and unfair
23 competition as part of your profession?

24 A. Yes.

1 Q. Have you lectured to bar groups or
2 associations on trademark case law
3 development in practice?

4 A. Yes. Almost 200 times in total. I guess
5 that includes ones before the PTO.

6 Q. When you address those groups, do you ever
7 speak about genericness versus
8 descriptiveness versus acquired
9 distinctiveness?

10 A. Yes.

11 Q. When you address those groups, do you ever
12 talk about case law developments on proper
13 trademark usage?

14 A. Probably. I don't recall any times when
15 that topic was discussed. I might mention
16 that in the early 1980s I also was an
17 author for years of what is colloquially
18 known as the Annual Review of American
19 Trademark Law.

20 Q. What is that?

21 A. Well, the technical name is something like
22 the blank -- fill in a number -- Year of
23 Administration Lanham Trademark Act of
24 1946. It was a project started by Walter

1 Derenburg who, in fact, was my law school
2 professor for two courses called Unfair
3 Trade Practices I and II. And he was
4 probably the single best known trademark
5 practitioner/academic in the country. For
6 the first 25 years of existence of the
7 Lanham Act, which actually took effect in
8 1947, Professor Derenburg wrote this
9 lengthy article which was then published in
10 The Trademark Reporter. Which was in those
11 days published by The United States
12 Trademark Association. And that
13 organization later morphed into the
14 International Trademark Association.
15 Professor Derenburg stopped doing this
16 after 25 years. For a few years it was
17 done by some of his proteges, and then I
18 was given the honor of the task. I did it
19 myself for 2 years, the entire project, and
20 then I did it with another co-author for
21 2 years, and I served as the overall
22 editor. The trade -- this project requires
23 the author to read every single case
24 decided by an American Court or American

1 Administrative body such as the Trademark
2 Trial and Appeal Board, analyze each case
3 and summarize each case. I became steeped
4 in these cases for the 4 years that I did
5 this project.

6 Q. Thank you. Are you familiar with the All
7 Ohio Annual Institute on Intellectual
8 Property?

9 A. Very.

10 Q. How are you familiar with a that?

11 A. When I moved to Cincinnati approximately
12 18 years ago I realized that the Ohio IP
13 Bar could profit from a high quality
14 seminar on intellectual property law. Such
15 a seminar did not then exist. So I
16 conceived of, and then with a partner,
17 created a program which, and I gave it that
18 name. The concept is that all Ohio
19 practitioners will be able to get high
20 quality IP education, continuing legal
21 education, no farther than 2 hours from
22 their home. And the way we achieve that,
23 because Ohio is a pretty good size state,
24 is to hold the seminar in two cities on

1 consecutive days. Typically, almost all
2 the time it was in Cleveland, in the north,
3 twice or three times in Akron, and then
4 every year here in Cincinnati. So I
5 conceived the program. I created it. I
6 have administered it all these years, and I
7 lecture in it every year.

8 Q. How many years are we talking about?

9 A. We just did the 16th last September. So
10 next September will be the 17th, and it
11 drew over 400 attendees.

12 Q. Wow.

13 A. A few even snuck in across the state
14 border.

15 Q. In preparation for this annual event in two
16 cities, you say, do you review materials
17 and current trademark law in practice?

18 A. Yes. Every year I have given the update
19 talk on trademark and trade dress, and
20 related trade identifiers. I also attend
21 the program, and hear many of the other
22 speakers.

23 MR. BANNER: I'd like to have marked as Exhibit 11 that
24 document.

1 (Applicant's Exhibit No. 11 was marked for the purpose of
2 identification.)

3 Q. And then I will hand you Exhibit 11, and
4 ask you to identify it for the record,
5 please?

6 A. This is the lecture outline I developed for
7 the 16th rendition of the All Ohio Annual
8 Institute on Intellectual Property.

9 Q. Okay. Thank you. Have you ever
10 participated in an INTA or International
11 Trademark Association or its predecessor,
12 the United States Trademark Association
13 Annual Meeting, as a lecturer on US
14 trademark law and/or trademark practice?

15 A. Yes. A number of times. The first one was
16 in 1979. Then during my years as a writer
17 or co-writer of The Annual Review four
18 times in the 80s, and then since then a
19 number of other times as requested.

20 Q. Do you continue to study legislative case
21 law developments including annual Trademark
22 Trial and Appeal Board decisions, to remain
23 knowledgeable in developments in all
24 aspects of trademark law and practice?

1 A. Yes.

2 Q. Are you familiar with, for example, the
3 case of, IN RE: American On-Line, the
4 Trademark Trial and Appeal Board concluded
5 that the mark Instant Massager was not
6 generic for computer and telecommunications
7 services?

8 A. Yes. I'm familiar with the case.

9 MR. BANNER: Please mark Exhibit Number 12.

10 (Applicant's Exhibit No. 12 was marked for the purpose of
11 identification.)

12 Q. I'll hand you what has been marked as
13 Applicant's Exhibit Number 12, and ask you
14 to identify that document for me?

15 A. This is a so-called certificate of Kenneth
16 B. Germain. A document that I signed, and
17 I apologize, I forgot to cross the T in my
18 own name, on November 28th of this year.

19 Q. And what do you agree to do under this
20 certificate in brief one?

21 A. I agree to observe the terms of a
22 stipulated protective agreement that the
23 parties entered into and which was filed
24 with the TTAB in February of 2005.

1 Q. Thank you.

2 MR. BANNER: Please mark this Applicant's Exhibit Number
3 13.

4 (Applicant's Exhibit No. 13 was marked for the purpose of
5 identification.)

6 Q. I'm handing you Applicant's Exhibit Number
7 13, and ask you to identify it for the
8 record?

9 A. This is a report bearing the title,
10 Rebuttal Exert Report of Kenneth B.
11 Germain. It looks like a true copy of the
12 report that I submitted in connection with
13 this case. I signed it on December 14th,
14 and I did cross the T this time. It has
15 Exhibit Numbers 1, 2, and 3 appended.

16 Q. Directing your attention to Tab Number 1 or
17 Exhibit Number 1, I should say; can you
18 identify that for me?

19 A. This is what I call my long resume. I also
20 have a one-pager that I use on certain
21 occasions. This one runs 20 pages.

22 Q. Is it accurate today?

23 A. I strive to keep it up to date, and I think
24 it is.

1 Q. Directing your attention to Exhibit Number
2 2. Can you identify what that is?

3 A. This is a list of cases over the past
4 four years or so 2003, 4, 5, 6 -- which, of
5 course, 2006 is almost over -- cases in
6 which I have provided in-court testimony or
7 deposition testimony.

8 Q. Okay. To your knowledge is it accurate
9 today?

10 A. Yes.

11 Q. Thank you.

12 MR. BANNER: Please mark this as Applicant's Exhibit
13 Number 14.

14 (Applicant's Exhibit No. 14 was marked for the purpose of
15 identification.)

16 Q. I'm going to hand you Applicant's Exhibit
17 Number 14, and ask you to identify it for
18 the record?

19 A. This is the other report that I wrote and
20 signed in connection with this case. This
21 one bears the title of Expert Report of
22 Kenneth B. Germain. I also signed this on
23 December 14th of this year. It has the
24 same three Exhibits numbered 1, 2, and 3 as

1 the Rebuttal Report.

2 Q. And those exhibits are accurate today?

3 A. Yes.

4 Q. Thank you.

5 MR. BANNER: Please mark this Exhibit 15. Applicant's
6 Exhibit 15.

7 (Applicant's Exhibit No. 15 was marked for the purpose of
8 identification.)

9 Q. I'm going to hand you what's been marked
10 Applicant's Exhibit 15, and ask you to
11 identify it, please?

12 A. This is the March 6, 2006 Declaration of
13 Ann Willoughbay. I think I added a letter.
14 Are the letters in the wrong order? I
15 think it's misspelled. It should be
16 W-I-L-L-O-U-G-H-B-Y.

17 MS. BURBACH: As it is in the first line.

18 A. Yes. As it is here, but not in the title.

19 Q. Okay. Did you study this Declaration in
20 preparation of your Rebuttal Expert Report
21 identified previously?

22 A. Yes, I did.

23 Q. Did you study it in the preparation for
24 today's deposition?

1 A. Yes.

2 Q. Drawing your attention to paragraph number
3 four on page two. What, if any,
4 conclusions did you draw from your review
5 of the declarations?

6 A. Well --

7 Q. Regarding the contents of paragraph four?

8 A. -- in a more general sense, the conclusions
9 I drew about Ms. Willoughby's Declaration
10 are detailed in my Rebuttal Expert Report,
11 specifically, starting on page five. And
12 the particular comments that relate to her
13 paragraph four appear in my paragraph
14 number eight.

15 Q. What are those?

16 A. Well one thing is that Ms. Willoughby was a
17 marketing person. Said that, quote,
18 consumers of food products can regard a
19 term or phrase as puffery, and still
20 associate and identify that term or phrase
21 as a branding statement, close quotes. I
22 noted that that is possible, but for a term
23 such as American's Favorite Pasta, which is
24 the term at issue in this case, which is so

1 highly descriptive and slash generic, and
2 so self-laudatory as that phrase. It is
3 very, very hard to convert that merely
4 descriptive slash generic term into a
5 trademark via acquired distinctiveness.
6 Ms. Willoughby doesn't seem to appreciate
7 that.

8 Q. Do you have any special knowledge or do you
9 have any understanding of the BMW,
10 America's Strongest -- BMW, The Ultimate
11 Driving Machine, mark that she refers to in
12 paragraph four, regarding the focus that
13 that particular advertising might have had?

14 A. Yes. Ms. Willoughby uses BMW, The Ultimate
15 Driving Machine as one of a few examples of
16 slogans which have served as trademarks.
17 And she postulates by analogy that
18 America's Favorite Pasta would be in that
19 kind of category. My belief is that she is
20 completely wrong for two reasons.

21 Q. Why?

22 A. Well, in its inception BMW, The Ultimate
23 Driving Machine is not merely descriptive,
24 and certainly not as vanilla, mundane,

1 routine, ordinary as America's Favorite
2 Pasta. So, therefore, it would not have
3 taken as much effort or as much time or as
4 much combination effort and time to get
5 secondary meaning. Secondly, the BMW
6 slogan was the focal point of a lot of
7 advertising for a long time. It's actually
8 been in use for 30 years. It's been, well,
9 a focal point, and it indeed has been
10 federally registered. And I think was
11 probably federally registered some years
12 ago. So American's Favorite Pasta, at
13 least as claimed by the opposer in this
14 case, is not registered and the opposer has
15 only started the registration process very
16 recently.

17 Q. What advantages are there to registering a
18 trademark to the owner?

19 A. Registration gives constructive notice
20 nationally, including to Alaska and Hawaii
21 and US territories, of the claim of
22 ownership of the registrant. It also
23 creates presumptions of validity and
24 ownership and exclusive right to use the

1 mark in commerce in favor of the
2 registrant. It is the gateway to a higher
3 status called incontestability which is
4 available no sooner than the fifth
5 anniversary of the registration. And all
6 marks that have attained incontestable
7 status then get a higher level of
8 presumptive validity, in fact, it's called
9 conclusive.

10 Q. Is it real expensive and real difficult for
11 a business to register a trademark in the
12 United States? I should break that down.
13 Is it real expensive for a business to
14 register a trademark in the United States?

15 A. I think the answer, basically, is no. At
16 least if the company is a company of any
17 size and substance. If it's just a mom and
18 pop store selling sandwiches maybe it would
19 be considered expensive at that level.

20 Q. Do you know approximately how much it would
21 cost a person to come to your firm to
22 register a word trademark that is
23 inherently distinctive?

24 A. Well the filing fee that the USPTO charges

1 is something like \$325 these days. I think
2 it's a little more if you file in paper
3 rather than electronically. Law firms will
4 charge \$500, maybe, it will vary from firm
5 for the processing that's involved at least
6 to get the application on file. And maybe
7 some follow-up charges based on office
8 practice. So it's a \$1000, \$1,500 maybe.

9 Q. So it's not the type of investment that
10 normally a business would have to go to a
11 bank to borrow money for?

12 A. Again, not a business of any size or
13 substance, this would not be a daunting
14 expense.

15 Q. In your experience as a teacher and as a
16 practicing professional, is it normal to
17 recommend to businesses to seek federally
18 registration of their brands?

19 A. Very normal.

20 Q. And the reason they would want to do that
21 is what?

22 A. To get the benefits that I just mentioned,
23 and also to send a signal to -- a few
24 different signals. One is a signal to

1 competitors when the competitors see the R
2 in a circle appear on the mark that's a no
3 trespassing sign. It's no trespassing
4 protected by the US Government. And the
5 other thing is by having the mark
6 registered, that mark will then show up in
7 every search run of the federal register
8 and serve as a warning to parties that have
9 not yet adopted a mark that perhaps they
10 should not adopt this one.

11 Q. Okay. Thank you. Directing your attention
12 to paragraph five, of Anne Willoughby's
13 declaration. Do you draw any conclusions
14 from her statements in paragraph number
15 five?

16 A. Yes. As I pointed out in one of the
17 paragraphs of my report, this part of this
18 Ms. Willoughby's declaration is pretty
19 wishy washy. For example, she quotes her
20 own earlier declaration -- what she called
21 a report -- in which she said she had
22 reached the conclusion that quote, all of
23 these trade dress features including the
24 phrase America's Favorite Pasta serves as a

1 trademark function and help consumers
2 recognize the Mueller's brand, end quote.
3 And then she goes on to say, and this is
4 quoting the current declaration. This
5 reflects that a number of constituent
6 elements may serve either individually or
7 collectively to provide a brand identity,
8 end quote. Well I've noted that it's very
9 vague. She's, this, her declaration is
10 focusing on America's Favorite Pasta which
11 is the term or phrase that's at issue in
12 this particular opposition proceeding.
13 Yet, that is only one of many words, names,
14 symbols, devices that appear in what she
15 refers to as the trade dress, meaning the
16 packaging of this product, which is Pasta.
17 And her phrase that either individually or
18 collectively may provide a brand identity.
19 Well, it's one thing to say that the
20 entirety has a brand identity function.
21 It's another thing to say one of the
22 elements itself by itself functions as a
23 trademark. And she skirts that issue, and
24 I think she does not get to where she is

1 supposed to be.

2 Q. Okay. Thank you. I'm going to have this
3 marked --

4 A. I want to state one thing for the record.
5 That is, I apparently have a typo or
6 perhaps my own error in my Rebuttal Expert
7 Report at the top of page seven in
8 paragraph number nine. It starts to say in
9 paragraph 10 of Ms. Willoughby's
10 declaration and that's obviously an error.
11 It should be in paragraph five. I don't
12 know how 10 got in there, I apologize.

13 Q. Thank you for point that out.

14 MR. BANNER: Would you please mark that as Applicants
15 Number 16.

16 (Applicant's Exhibit No. 16 was marked for the purpose of
17 identification.)

18 Q. I'm going to hand you now what is being
19 marked Applicant's Exhibit Number 16, and
20 ask you to identify it for the record?

21 A. This is the deposition with exhibits of
22 Anne Willoughby from November 3, 2006.

23 Q. Did you study this deposition in
24 preparation of your Rebuttal Expert Report?

1 A. I did.

2 Q. Did you study this deposition and the
3 contents thereof in preparation for your
4 testimony today?

5 A. Yes.

6 Q. Did you draw any conclusions based on her
7 testimony in that deposition as to the
8 level of her knowledge of trademark law?

9 A. Yes, I did. And my analysis of this
10 deposition transcript appears in paragraph
11 numbered 10, pages 7 and 8 of my rebuttal
12 report. Basically, I think that Ms.

13 Willoughby demonstrated very clearly that
14 she does not have a firm grip -- she
15 doesn't have a good grip on trademark law
16 as it applies to the matter in this case.

17 Q. Okay. Do you in looking at her deposition,
18 do you have an opinion on whether her
19 statement America's Favorite Pasta
20 identifies and represents a trademark from
21 Mueller's; is that accurate or not in your
22 opinion?

23 A. I do have an opinion.

24 Q. What might that opinion be?

1 A. That she doesn't have an adequate basis to
2 opine that it is.

3 Q. Okay. Thank you.

4 MR. BANNER: Let's take a look then at Applicant's
5 Exhibit Number 17.

6 (Applicant's Exhibit No. 17 was marked for the purpose of
7 identification.)

8 Q. Can you identify that Exhibit 17 for me,
9 for the record I should say?

10 A. Yes.

11 Q. What is it?

12 A. This is the declaration of Drew Lericos,
13 L-E-R-I-C-O-S that was submitted in
14 connection with this opposition proceeding
15 and which was dated March 3, 2006.

16 Q. Did you review this declaration in
17 preparation of your expert report
18 previously identified?

19 A. Yes, I did.

20 Q. Did you review this report in preparation
21 of your testimony here today?

22 A. Yes.

23 Q. Did you formulate an opinion of any kind
24 based on the three page declaration that

1 Mr. Lericos gave on 3/3/06 in this exhibit?

2 A. Yes. Once again, as with Ms. Willoughby
3 with Mr. Lericos I read not only the
4 declaration but also his deposition. And
5 so I examined both of them in tandem and
6 you will see in my expert report document,
7 which was marked Exhibit 14, that in
8 paragraphs eight and nine there are summary
9 of my thoughts about these documents.

10 Q. Can you summarize what those thoughts of
11 these documents might be?

12 A. I'll try, but they are actually quite a few
13 aspects here, and I'll do what I can.

14 Q. Thank you. Would it be easier if I just
15 asked you questions?

16 A. Perhaps.

17 Q. Turning to Tab A of the Applicant's Exhibit
18 16. Do you know what this is, can you
19 identify what this might be?

20 A. This is a print ad, I think or it could be
21 a screen shot. But I think it's a print ad
22 shows Rachel Ray in the circle. Her head
23 in the circle on the lower right, and it
24 shows a box of Mueller's, bow ties,

1 positioned right above Rachel Ray, and it's
2 a coupon?

3 Q. What does the coupon say?

4 A. Manufacturer's coupon save \$0.55 if you buy
5 two of Mueller's 12-ounce or larger boxes
6 and there's also a picture of the box which
7 is not very clear. I can read the word
8 Mueller's, but I can't see what other text
9 might be on it.

10 Q.

11

12 A. REDACTED

13

14 Q. This was marked Exhibit 79. Mark this as
15 Tab B, this is Exhibit 16.

16 MS. BURBACH: And Brian, I note that this is designated
17 confidential attorney's eyes only. So I
18 don't know where we are going, but if we
19 need to designate part of this
20 confidential.

21 MR. BANNER: We can designate this part confidential.
22 But I am going to ask you for your opinion
23 based on what you reviewed of that, because
24 it's not attached here. So mark in the

1 record this is attorney's eyes only, and
2 we'll file it under sealed in the TTOB. I
3 don't know why, what was the date of that
4 2004?

5 (Applicant's Exhibit No. 16 Tab B was marked CONFIDENTIAL
6 ATTORNEY'S EYES ONLY)

7 MS. BURBACH: 2004. The client wants it to be that way.

8 MR. BANNER: We want to keep the client happy. Thank
9 you for pointing that out.

10 Q.

11

12

13

14 A.

REDACTED

15

16

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20

21 Q. Okay. Turning to Tab Number C, letter C in
22 the declaration of Drew Lericos. Did you
23 study this in preparation of your Expert
24 Report?

1 A. I believe I had these exhibits, but I don't
2 think I had them all in color.

3 Q. Okay. From your -- do you see the
4 registration symbol anywhere on the first
5 page? We'll just focus in on the first
6 page of Tab C?

7 A. Yes. It's attached to the brand name,
8 Mueller's.

9 Q. Okay. Do you see it anywhere else?

10 A. Well I see it twice on the page. It's in
11 this central Mueller's, and it's also
12 towards the top of the page, which may be
13 the box top or the side or something like
14 that. This is a flattened box, I think.

15 Q. Okay. And do you see the phrase America's
16 Favorite Pasta anywhere?

17 A. I do. It's positioned where what I think
18 is the top of the front of the box.

19 Q. Is there any marking next to America's
20 Favorite Pasta?

21 A. No.

22 Q. Turning to the second page of Tab C?

23 MS. BURBACH: By the way, this part doesn't need to be
24 confidential, correct.

1 Q. Right. Correct.

2 MS. BURBACH: We were just -- we are no longer in the
3 confidential section.

4 Q. Only B is confidential. This is a box. I
5 direct your attention to this page, and ask
6 you if you see the R in a circle anywhere?

7 A. I see the R in a circle, gosh, four times,
8 I believe. It appears attached to
9 Mueller's five times. It's the big version
10 of Mueller's, center, toward the top left,
11 and toward the top right. There's also an
12 italicized passage under that where the
13 word Mueller's, and the R in a circle
14 appear one, two, three times.

15 Q. Before moving on, can you read the last
16 sentence of that italicized paragraph?

17 A. Yes. Taste why Mueller's -- R in a
18 circle -- is America's Favorite Pasta. And
19 I note that favorite and pasta start with
20 lower case letters.

21 Q. Is there an exclamation point?

22 A. There is. At the end.

23 Q. Is this in your opinion as a teacher of
24 trademark law; is this good trademark

1 usage?

2 A. No. It's horrible.

3 Q. Why?

4 A. Because it's including the mark or the
5 claimed mark in an ordinary sentence, in a
6 way that is totally descriptive. Taste why
7 Mueller's is America's -- possessive form
8 of America -- favorite pasta. It's purely
9 descriptive, and without a symbol such as
10 TM, without capitals on F and P, without
11 different typography, without a statement
12 such as the one that's in the lower right
13 hand part of this exhibit about an inch or
14 an inch and a half above the number 3392,
15 you see Mueller's is a registered trademark
16 of CPC International Inc. That's another
17 way of telling people such and such a thing
18 is a trademark.

19 Q. What's the copy right date on this?

20 A. 1998.

21 Q. Thanks.

22 A. I see one more use of R in are a circle, if
23 you care. In the Pasta with a twist
24 section there's a recipe. One teaspoon

1 Argo, R in a circle, corn starch. So that
2 means that the copy writer understood or
3 someone informed the copy writer that Argo
4 was a registered trademark, corn starch is
5 the generic of that product.

6 Q. Thank you.

7 MR. BANNER: I think we are done with the tabs. So
8 let's go to Number 18. Please mark this
9 Applicant's Exhibit Number 18.

10 (Applicant's Exhibit No. 18 was marked for the purpose of
11 identification.)

12 Q. And I'm handing you Exhibit Number 18, and
13 I'm asking you if you can identify that?

14 A. This is the November 3, 2006 deposition of
15 Andrew John Lericos, and I believe that's
16 the same person as Drew Lericos.

17 Q. I think it is. Did you review this
18 declaration?

19 A. Deposition.

20 Q. Or deposition, in preparation of your
21 report?

22 A. I did.

23 Q. Did you review it again today in
24 preparation of your testimony here?

1 A. Yes.

2 Q. Did you draw any conclusions from this
3 deposition as to Mr. Lericos's knowledge of
4 trademark law?

5 A. Yes. It's, unsophisticated, kind of
6 confused. My comments on this deposition
7 also appear in paragraph 11 of my Expert
8 Report that you see has many subdivisions,
9 A through K.

10 Q. Rather than go through every one of those,
11 can you perhaps summarize a little bit what
12 is in those?

13 A. As I indicated in the begin of paragraph
14 11, this deposition basically reiterates
15 and confirms things that I found in Mr.
16 Lericos's declaration, and which was
17 commented on in paragraph nine of my Expert
18 Report. More specifically, he talks about
19 the branding elements in the, appearing on
20 the packages of AIPC's, Mueller's packages.
21 And he notes that America's Favorite Pasta,
22 which he refers to as a slogan, is kind of
23 a third level identifier. He says that the
24 Mueller name shown in its red banner

1 version is the first level identifier. The
2 second level identifier is a combination of
3 a white background with red and blue making
4 it Americana. And the third one is the
5 phrase, America's Favorite Pasta. What
6 this means is that if he is right, and this
7 is consistent with the testimony of some
8 other AIPC witnesses in this case, that the
9 highest position that America's Favorite
10 Pasta could have is third level. When you
11 combine a term that is by its nature,
12 highly descriptive slash generic and
13 self-laudatory with marketing attitude that
14 put its in the third level position, you're
15 not likely to have anything that amounts to
16 a trademark.

17 Q. Okay. On page 12 of your Expert Report can
18 you please explain to me what is meant in
19 sub-paragraph (C) by your statements there?

20 A. Well, he referred to a slogan, quote, make
21 Pasta better with Mueller's, America's
22 Favorite Pasta, end quote. And there he
23 has, at least it shows up in the
24 deposition, capitals A, F, and P on

1 America's Favorite Pasta. Once again,
2 though, it's fundamentally a descriptive
3 usage of that three-word phrase. And he
4 gives some other examples, which I refer to
5 by pages and lines that are in the same
6 category. These are not proper use as a
7 trademark.

8 Q. What would be proper use as a trademark in
9 your opinion?

10 A. Showing America's Favorite Pasta not as
11 part of a phrase, longer phrase or
12 sentence, but in a highlighted position
13 preferably with a term such as trademark or
14 a legend explaining this is a trademark of
15 or even better with an R and a circle
16 showing that it had been federally
17 registered. Also you can use a slogan like
18 BMW, The Ultimate Driving Machine
19 separately and with enough focus and
20 emphasis so that people do come to
21 recognize it as a trade identifier. I
22 don't see any evidence in this case or
23 almost no evidence that America's Favorite
24 Pasta has had that kind of prominence.

1 Q. How would someone use in a car like a BMW
2 the phrase The Ultimate Driving Machine on
3 a car on, on the packages for a car, so
4 that it acquired this gestalt
5 identification of origin and source?

6 A. I think that BMW, The Ultimate Driving
7 Machine probably achieved its notoriety
8 mostly through billboards, visual ads, and
9 things of that sort, and those are not
10 technically trademark use for any
11 particular goods. Because there's a
12 requirement for tangible goods that the
13 mark be affixed to or used in close
14 physical connection with the goods.
15 However, if you wanted to make it affixed
16 it's pretty easy. All you have to do is
17 put a tag on the car even if it's a
18 removable tag. You could hang the tag on
19 it. You could put a sticker on the window,
20 something of that sort.

21 Q. So it doesn't have to be permanently
22 affixed?

23 A. No. No such requirement.

24 Q. Is it possible in your opinion to use in an

1 operating manual, a trademark?

2 A. Certainly you can use it there. It might
3 not qualify as a proper specimen for a
4 trademark registration. But if it were
5 delivered with the car in close
6 proximity --

7 Q. It teaches you how to drive the car. This
8 is where the hood is. This is where the,
9 all of the stuff that they give you with a
10 new car?

11 A. Yes. That could qualify.

12 MR. BANNER: Please mark this Applicants Exhibit Number
13 19.

14 (Applicant's Exhibit No. 19 was marked for the purpose of
15 identification.)

16 Q. I'm going to hand you a copy of Applicant's
17 Exhibit Number 19, and ask you if you can
18 identify it for the record, please?

19 A. This is the declaration with exhibits of
20 Timothy Webster filed in connection with
21 this opposition, and signed on March 3,
22 2006.

23 Q. Did you study that declaration in
24 preparation of your Expert Report?

1 A. Yes, I did.

2 Q. Did you study this declaration for today's
3 deposition?

4 A. Yes.

5 Q. In studying this declaration this
6 three-page declaration. Did you formulate
7 any opinions with regard to paragraph
8 number three of the declaration on page
9 two?

10 A. Yes. Let me say at the outset of this
11 answer that my comments on Mr. Websters
12 declaration are found on page five in
13 paragraph seven, lower case B of my Expert
14 Report. And my related comments on Mr.
15 Webster's 2002 affidavit in the other case,
16 the New World Pasta case are found in 7C
17 also on page five. Going back to paragraph
18 three of Mr. Websters declaration, I don't
19 agree that there is any clarity or any
20 basis for believing that in the
21 October 2000 Asset Purchase Agreement with
22 Best Foods that the slogan, America's
23 Favorite Pasta was transferred, it's
24 ownership was transferred from Best Foods

1 to AIPC?

2 Q. And why do you arrive at that conclusion?

3 A. I have looked at that document, the Asset
4 Purchase Agreement --

5 MR. BANNER: Okay. Let me interrupt you right here, and
6 have you mark this Applicant's Exhibit 20.
7 (Applicant's Exhibit No. 20 was marked for the purpose of
8 identification.)

9 Q. Can you tell me what this might be?

10 A. Well, the first page of this exhibit is a
11 December 4, 2006 letter from Stewart
12 Cobert, C-O-B-E-R-T, of Unilever,
13 U-N-I-L-E-V-E-R, to you Mr. Banner saying
14 that he is attaching a document which you
15 requested. And that document, starting
16 with page number five, I don't know where
17 pages one through four might have gone, and
18 it also seems to start with --

19 Q. Maybe that's a better copy, I don't know?

20 A. No. This is how I received it originally.

21 Q. Okay.

22 A. And it starts, the first obvious tab on
23 page five is tabbed letter B, and I don't
24 know where tab A would have gone. This is

1 a schedule of so-called, quote,
2 intellectual property, close quotes. Which
3 it was the schedule that was part of this
4 Asset Purchase Agreement.

5 Q. Where's the page. I couldn't figure out
6 what you were talking about, now I got it.

7 A. Yes. So this is the schedule of
8 intellectual property, and it includes on
9 this page lettered five, a couple of design
10 patents, and then on the next page which is
11 numbered one, it has registered trademarks.
12 And that page and the next few pages some
13 of them US Trademarks and then foreign
14 trademark's, and stuff like that.

15 Q. Okay. Is the slogan, America's Favorite
16 Pasta located on any of the pages that make
17 up Applicant's Exhibit Number 20?

18 A. No. I couldn't find it and I looked.

19 Q. I couldn't either. Did you draw any
20 conclusion from this schedule?

21 A. Well --

22 Q. As to what the seller might have thought
23 was the asset that it was selling to --

24 MS. BURBACH: I'm actually going to enter an objection

1 here. This is not a complete copy of the
2 Asset Purchase Agreement. This is one
3 schedule of it. I don't believe he can
4 consider it in its entirety. Therefore, it
5 lacks foundation, and calls for
6 speculation, and I don't think it is
7 admissible in it's current state.

8 MR. BANNER: I believe you and I signed a stipulation
9 yesterday regarding this exact document.

10 MS. BURBACH: That's fine. But the whole document is not
11 in front of Mr. Germain.

12 MR. BANNER: Oh, I see what you are saying.

13 MS. BURBACH: Because I think there are other portions
14 that I think --

15 MR. BANNER: Let's get the whole thing.

16 MS. BURBACH: Yeah.

17 MR. BANNER: That was your 101. This is going to be
18 back on confidential, because I think this
19 is a document that is marked attorney's
20 eyes only.

21 MS. BURBACH: I think you're right.

22 MR. BANNER: Mark this Applicant's Exhibit Number 21,
23 please. Which is confidential, and it is
24 the Asset Purchase Agreement to which this

1 document, Applicant's Exhibit 20 refers, I
2 believe, it's page five the listing of --
3 is it page five?

4 (Applicant's Exhibit 21 was marked for the purpose of
5 identification and is marked CONFIDENTIAL.)

6 MS. BURBACH: I think it is.

7 MR. BANNER:

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12 Q.

13 A.

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REDACTED

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REDACTED

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12 Q.

13 A.

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15 Q.

Is it normal for in your experience as a teacher, professor, practitioner of many years; is it normal for businesses that sell the assets of business to identify intellectual property specifically?

19

20 A.

Yes.

21 Q.

Why is that?

22 A.

Well, it's good practice for any property that's being transferred, any aspect of property. I think it's especially

23

24

1 important for intangible property such as
2 intellectual property, because it doesn't
3 have physical existence. And these are
4 sophisticated documents, written by
5 sophisticated parties, and they go into
6 quite a bit of detail when it comes to
7 design patents, registered trademark, US
8 and foreign, I think copy writes too. And
9 there is not reason that I'm aware of that
10 they couldn't have had a page saying
11 unregistered trademarks or trademarks not
12 registered or with no Governmental
13 Authority and any mark of anything viewed
14 by the seller, and presumably by the buyer
15 as a mark of that category that's being
16 transferred should be a such a page.

17 Q. Thank you for your opinion. Returning to,
18 then, the Applicant's Exhibit Number 19.
19 Would you please take a look at paragraph
20 five, and tell me if you formulated any
21 opinion based on Applicant's Exhibit 19
22 which is the declaration of Timothy
23 Webster?

24 A. Yes.

1 Q. What would that be?

2 A. I noted in page, on page five, it's
3 paragraph 7B of my Expert Report. That
4 Mr. Webster in this declaration repeatedly
5 referred to opposer's phrase, America's
6 Favorite Pasta, as a slogan, the word
7 slogan. I also noted that he never
8 referred to that phrase as a brand or as a
9 trademark. And I view this as an admission
10 against interest that is certainly
11 applicable to Mr. Webster personally, and
12 perhaps also applicable to opposer. It's
13 not currently his employer, but he was the
14 CEO of the opposer at relevant times. And
15 it's about his experience as CEO that he
16 files this declaration. It seems to me
17 that this is an admission against interest
18 that America's Favorite Pasta was not
19 viewed by AIPC as a trademark. And as a
20 result, that's, that undermines it's
21 position in this opposition.

22 Q. Did you anywhere in reviewing his
23 declaration, and the attachments thereto
24 draw any conclusions with regard to marking

1 of trademarks, in his opinion of marking of
2 trademarks?

3 A. Well, yeah. In reference to his 2002
4 affidavit, which is paragraph of 7C of my
5 report, he repeatedly referred to
6 Mueller's, and Mueller's Brand, and when he
7 did that he showed the word Mueller's in
8 all caps. That's a typical, conventional
9 way of showing a trademark. Setting it
10 aside from ordinary text. However, with
11 only one exception, maybe there's no
12 exceptions at all in the this one. When he
13 referred to America's Favorite Pasta he
14 only capitalized the initial letters A, F,
15 and P. So that shows an inconsistency, and
16 a differentiation as to the status of
17 Mueller's on the one hand, and America's
18 Favorite Pasta on the other.

19 Q. Okay. Thank you. Directing your attention
20 to the paragraph six of Timothy Webster's
21 declaration. Did you formulate any opinion
22 regarding the ability of AIPC to use any
23 markings during any of their reviews of
24 packaging?

1 A. I'm sorry, I don't understand that
2 question. Had the word ability in it, and
3 it didn't make sense to me.

4 Q. Okay. That's okay. I sometimes don't make
5 sense. Did, to your knowledge, did AIPC
6 according to the CEO routinely have or
7 periodically have reviews of its packaging?

8 A. Yes.

9 Q. During the reviews of its packaging, did it
10 have any opportunity to do anything with
11 regard to marking of anything?

12 A. Of course. Every time there is a package
13 review there's an opportunity to change the
14 layout, change the colors, add verbiage,
15 subtract verbiage, add a trademark
16 indicator such as TM or a verbal
17 explanation, this is a trademark of some
18 company. There's all those things are
19 obvious, and they're available every time.

20 Q. Okay.

21 MR. BANNER: I'm going to ask you to mark this
22 Applicant's Exhibit 22.

23 (Applicant's Exhibit No. 22 was marked for the purpose of
24 identification.)

1 Q. I'm handing you a copy of Applicant's
2 Exhibit 22, and ask you to identify it for
3 the record?

4 A. This is the deposition transcript from Mr.
5 Webster's November 9, 2006 deposition taken
6 in connection with this case.

7 Q. Did you review this in preparation of
8 writing your expert report?

9 A. Yes, I did.

10 Q. Did you review that in preparation for
11 today's testimony?

12 A. Yes.

13 Q. In reviewing that deposition did you
14 formulate any conclusions or opinions
15 regarding the level of legal understanding
16 that Mr. Webster has with regard to
17 trademark usage?

18 A. Yes. Preliminarily my detailed discussion
19 of this is found in paragraph 7D of my
20 Expert Report. It starts on the bottom of
21 page five, and carries all the way over to
22 a little below the middle on page eight.
23 And would you remind me of what your
24 specific question is, please?

1 Q. What level of knowledge does Mr. Webster
2 have with regard to trademark usage, proper
3 trademark usage?

4 A. Well he doesn't seem to understand the
5 stuff having to do with the Asset Purchase
6 Agreement, and the fact that America's
7 Favorite Pasta is not listed there on the
8 relevant schedule.

9 Q. I think he thought it was listed there?

10 MS. BURBACH: I would object to him testifying on the
11 record.

12 Q. Okay. Strike that.

13 A. I'm sorry. Well, actually, page six, foot
14 note one of my report says, Mr. Webster
15 admitted he did not know the whereabouts of
16 schedule 2.1A or have any recollection of
17 whether America's Favorite Pasta appeared
18 there.

19 Q. Okay.

20 A. I have the strong feeling that Mr. Webster
21 as CEO of AIPC felt that since that company
22 had spent so much time, effort, and money
23 on the New World Pasta litigation which had
24 to do with whether America's Favorite Pasta

1 constituted a false advertisement that the
2 company sort of owed it to that phrase to
3 protect its honor as a trademark.

4 MS. BURBACH: I'm going to object to that. That's not a
5 response to the question. It calls for
6 speculation, and there's no foundation for
7 that statement.

8 Q. Do you have any knowledge regarding
9 Mr. Webster's opinion about the impact
10 America's Favorite Pasta as used on its
11 packages has on the public?

12 A. I don't think he has any proof. I don't
13 think he provided any proof that the public
14 views America's Favorite Pasta as a
15 trademark.

16 Q. Okay. Is it possible for someone to use a
17 descriptive term for a number of years,
18 both as a primary descriptive term in the
19 phrase such as what we read on the side of
20 the 1998 box, Taste Why Mueller's is
21 America's Favorite Pasta, exclamation
22 point; and use part of that phrase as a
23 trademark at the same time?

24 A. I think it's possible, but it's swimming

1 upstream.

2 Q. What does the use of a phrase in a
3 descriptive sense do to the use of a the
4 same phrase on a packaging as puffery do to
5 that phrase in terms of it's impact on the
6 consumer?

7 A. A slogan that amounts to puffery is by its
8 nature a boastful rather generalized
9 favorable statement. It's the kind of
10 statement that consumers tend to blow off.
11 Oh, that's the manufacturer or the seller
12 saying good things about its own product.
13 It also has sort of a descriptive aspect to
14 it. What is this? It's America's Favorite
15 Pasta. So what do I learn from that? It's
16 a American product or at least it's aimed
17 at an American audience. Favorite is an
18 laudatory descriptive term, and Pasta is a
19 generic which has no trademark
20 significance. If the phrase, if that
21 three-word phrase appears both in the
22 sentence that you stated, and separately on
23 the box -- it does appear separately on the
24 box -- it's possible with the right kind of

1 handling that the phrase, America's
2 Favorite Pasta could get secondary meaning.
3 They didn't do any of the right things or
4 they did only one. They often showed
5 America's Favorite Pasta fairly separately,
6 sometimes in pretty good size letters,
7 sometimes in a different color on the box,
8 but that's the only thing they did right.

9 MR. BANNER: Please mark this as Applicant's Exhibit
10 Number 23.

11 (Applicant's Exhibit No. 23 was marked for the purpose of
12 identification.)

13 Q. I'm going to hand you Applicant's Exhibit
14 Number 23, and I'm asking you if you
15 recognize this, and can identify this at
16 all?

17 A. I think these are a few pages I printed off
18 the AIPC website a week or so ago.

19 Q. And turning to, I guess, it's the, it says
20 one of one. It's the third page in. Can
21 you read for me the listing of the brands
22 under retail that this shows?

23 A. Yes. Under the heading, brands, this
24 appears, quote, Supplies Branded Pasta to

1 marketers and distributors, such as
2 Mueller's, Golden Grain, Ms. Grass, Ronco,
3 Luxury, R & F, Global A1, Pennsylvania
4 Dutch, and Anthony's, close quotes.

5 Q. Can you read the paragraph just above it
6 beginning with AIPC?

7 A. Sure. AIPC has established a significant
8 market presence in North America by
9 developing strategic customer relationships
10 with food industry leaders that have
11 substantial pasta requirements.

12 Q. What if any conclusion do you draw, rather,
13 what is the date of the bottom right of
14 this?

15 A. Well, that's the date I printed it,
16 12/12/06. So it's very current.

17 Q. Do you draw any conclusion from the
18 statement of the brands on this page?

19 A. Yes. The conclusion is a negative one.
20 That America's Favorite Pasta is not viewed
21 and claimed as a brand by AIPC.

22 Q. Okay. Have you received the Notice of
23 Reliance that has been filed in this case
24 by the opposer?

1 A. I have reviewed a number of Notices of
2 Reliance by opposer in this case. They are
3 listed in my Exhibit 3 to my Expert and
4 Rebuttal Expert Reports.

5 Q. Okay.

6 MR. BANNER: Do you want to go through these?

7 MS. BURBACH: I don't know what you're going to ask him.

8 Q. Okay. I'm going to show you what we are
9 going to mark 24.

10 (Applicant's Exhibit No. 24 was marked for the purpose of
11 identification.)

12 Q. Which is also the opposer's Exhibit 117,
13 and ask you to take a look at it. Can you
14 tell me what it is? Can you identify it
15 for the record?

16 A. Yes. This is a copy of a certified copy of
17 the registration number 2,467,054 for a
18 trademark, America's Favorite Truck Camper.

19 Q. And can you tell me what the goods are in
20 that?

21 A. Yes. Recreational vehicles, namely truck
22 campers and fifth wheel trailers.

23 Q. And to your knowledge, is America's
24 Favorite disclaimed in that?

1 A. No.

2 Q. And to your knowledge, is the word, is the
3 wording America's Favorite used as part of
4 other peoples' trademarks?

5 A. Well, the phrase America's Favorite is used
6 here as part of the overall registered
7 mark, America's Favorite Truck Camper. The
8 last two words, truck camper, are
9 disclaimed, meaning that they are the
10 registrant admits that they don't have
11 trade identity significance. And the
12 overall four letter mark was registered
13 under section 2F of the Lanham Act, which
14 indicates that the claim of acquired
15 distinctiveness alias secondary meaning was
16 made and accepted.

17 Q. Okay. And what is, we've already talked
18 about acquired distinctiveness. What is
19 the way that one can prove secondary
20 meaning or acquired distinctiveness. I
21 believe there's more than one way in the --
22 do you know?

23 A. Yes. For purposes of registration, the
24 applicant can -- the applicant can either

1 adduce proof of acquired distinctiveness.

2 The proof can come in either direct or

3 indirect forms. Direct would be, an

4 example of direct would be a consumer

5 survey that identified, in which, a

6 substantial portion of the surveyed

7 population identifies the term as

8 indicating a single source. Indirect would

9 be evidence of such things as longevity of

10 use, amount of money spent on advertising,

11 examples of focused advertising, things of

12 that sort. And then there is another way

13 which also can be used in tandem sometimes

14 which is a claim that the term claimed to

15 be a mark has been in use in commerce for

16 at least a period of 5 years, and that it

17 therefore should get a presumption of

18 secondary meaning.

19 Q. Thank you. I'm going to hand you what
20 should be marked as Applicant's 25, and ask
21 you to take a look at that, and see if you
22 have seen that?

23 (Applicant's Exhibit No. 25 was marked for the purpose of
24 identification.)

1 Q. Can you identify it for me?

2 A. I think I've seen this. It's the decision
3 of the lower Court, the Western District of
4 Missouri, in American Italian Pasta Company
5 versus New World Pasta Company back in
6 February of '03.

7 Q. Okay. Did you read that at all?

8 A. I think I did.

9 Q. Do you recall what the decision of the
10 District Court was in that case?

11 A. I think it was the same as the decision
12 later of the Eighth Circuit Court of
13 Appeals.

14 Q. Let me hand you Applicant's Exhibit Number
15 26.

16 MR. BANNER: Please mark this 26.

17 (Applicant's Exhibit No. 26 was marked for the purpose of
18 identification.)

19 Q. Which I'm going to ask you to identify what
20 it is?

21 A. This is the Eighth Circuit opinion that I
22 mentioned a minute ago. It's dated June 7,
23 2004.

24 Q. And what does the Court, and the Court of

1 Appeals say about the phrase, America's
2 Favorite Pasta in terms of its
3 descriptiveness?

4 A. It says, the Court says, that that phrase
5 is puffery. Which means that it's vague,
6 generalized, favorable, boastful, and
7 doesn't have the kind of specific content
8 which makes it measurable against a
9 standard of truthfulness or falsity.

10 Q. Do you agree?

11 A. Yes.

12 Q. To your knowledge, would the Patent and
13 Trademark Office be bound by the Eighth
14 Circuit's opinion in that case?

15 A. I think that the PTO would view these
16 two cases, the two opinions, the District
17 Court, and the Eighth Circuit Opinions as
18 not on the same issue that the PTO is
19 dealing with. Therefore not bound by the
20 decision reached by those two Courts.

21 MR. BANNER: Please mark this Applicant's Exhibit 27.

22 (Applicant's Exhibit No. 27 was marked for the purpose of
23 identification.)

24 Q. I'm going to hand you now a serious of one,

1 two, three, four, color prints, and ask you
2 if you can identify what they might be?

3 A. These are pages that I've seen before.
4 Again, I'm not sure I saw them in color,
5 but I think I'm pretty sure I've seen these
6 before. They are photos -- not the world's
7 highest quality -- of some packages. These
8 happen to be bags and boxes of Mueller's
9 products.

10 Q. Take a look at the first page. Do you find
11 any R in a circle anywhere in that picture?

12 A. Yes. It's attached to Mueller's.

13 Q. Do you see the phrase, the words, America's
14 Favorite anywhere?

15 A. I do. It's right over Mueller's, and its
16 third word is Noodle.

17 Q. Is what?

18 A. Noodle.

19 Q. Thank you. Turning to the second page.
20 What did you see there?

21 A. Well, on the left side there is a box of
22 Mueller's elbow macaroni and right in the
23 middle of the front of that box is the
24 phrase, America's Favorite Pasta. On the

1 right side is a bag of hardy egg noodles,
2 also Mueller's brand, and right above the
3 word Mueller's the phrase, America's
4 Favorite Noodle.

5 Q. Turn to the third page. That's a -- what
6 is that?

7 A. That looks like a blow-up of the left, side
8 box of elbow macaroni from the second page.

9 Q. And the fourth page?

10 A. The fourth page is the back of the bag.
11 It's an AIPC product. I can't really tell
12 what it is. From the dress I would guess
13 it's a Mueller's bag, but I can't really
14 tell.

15 Q. Looking at that, do you see the logo for
16 the house mark of the opposer in this case
17 prominently displayed there?

18 A. In red. Yes. The red circle with the bar
19 running through it. AIPC. And then it
20 does indicate below that, that it's a
21 Mueller's product, I guess. Mueller's is a
22 registered trademark of the American
23 Italian Pasta Company.

24 Q. It does?

1 A. Yes.

2 Q. What else do we have?

3 A. The AIPC logo appears as an R in a circle.

4 MR. BANNER: Can we take to break.

5 MS. BURBACH: That's a great idea.

6 (Brief recess.)

7 (Applicant's Exhibit No. 28 was marked for the purpose of
8 identification.)

9 Q. I'm going to show you Applicant's Exhibit
10 Number 28, and ask you to identify it,
11 specifically, take a look at the very first
12 page that you're reading. Thumb through
13 it, take your time, and tell us what it is
14 for the record?

15 A. This looks like the file history or time
16 prosecution history for the mark now being
17 opposed Barilla-America's Favorite Pasta.

18 Q. What does it mean when a mark is published
19 for opposition, what is all that about?

20 A. Well, whenever a party seeks to put a mark
21 on the principal register of the USPTO, the
22 party, that party has to file an
23 application asking for such treatment.
24 That application is referred to as

1 trademark examining attorney who is a
2 person who works for the PTO. That person
3 exams the mark and its related goods or
4 services, and conducts a search to see if
5 that mark would conflict with any other
6 marks already registered or previously
7 filed for registration. When that person,
8 the trademark examining attorney, either
9 initially or later after some back and
10 forth with the applicant's counsel
11 concludes that the mark deserves to be
12 registered, then that person sends it to a
13 division for publication. Publication is,
14 first, there's a notice of publication
15 which is an indication that it's going to
16 be published. And then when it appears in
17 the official Gazette of the United States
18 Patent and Trademark Office as a published
19 mark that triggers an initial 30-day period
20 during which any interested and concerned
21 party can either file a Notice of
22 Opposition, which is a formal challenge or
23 can move to extend the time in which such a
24 Notice of Opposition can be filed.

1 Q. So the publication signals the end of
2 prosecution; is that right?

3 A. It's the end of the work by the trademark
4 examining attorney.

5 Q. And his function is to do what?

6 A. To examine the mark to determine whether it
7 deserves to be placed on the principal
8 register.

9 Q. And he does that in relation to what
10 statute?

11 A. Well, it's under the Lanham Act.
12 Particularly sections one and two, most
13 particularly sections one and two.

14 Q. Okay. Can you please turn to the very
15 first, not the first, but the most recent
16 office action in there. I think it's the
17 fourth or fifth page down. It will say
18 Office Action, I see they have some -- I
19 should have the date. I'm sorry. I don't
20 have the dates. Can you tell us for the
21 record, what is that, what is an Office
22 Action?

23 A. An Office Action is, basically, a rejection
24 letter. It's a document that runs usually

1 just a few pages, and in which the
2 trademark examining attorney explains his
3 or her reason for refusing to register --
4 to move this mark toward registration.

5 Q. And the date of that one you're looking at
6 is?

7 A. June 18, 2003.

8 Q. In looking at that Office Action, is there
9 a reason for this examiner to reject my
10 client's application?

11 A. No. The reason given is that the client,
12 the applicant has refused to disclaim the
13 phrase, America's Favorite Pasta, apart
14 from the mark as in its entirety.

15 Q. And if the applicant doesn't disclaim it
16 what happens?

17 A. The office refuses to publish the mark, and
18 the applicant either has to asceed to it by
19 dropping, letting the application die or
20 take an appeal.

21 Q. And that appeal would be to whom?

22 A. The Trade Mark Trial and Appeal Board.

23 Q. Moving closer to the top, returning to the
24 front page, what was the date of the

1 publication, the Notice of Publication?

2 A. The Notice of Pub. is dated March 3, 2004.

3 Q. So something happened between that Office
4 Action you just referred to, and the Notice
5 of Publication?

6 A. That's correct.

7 Q. Could you please look at that packet of
8 papers, and tell us if you find anything
9 that would indicate something happened?

10 A. Yes. There is a document entitled,
11 Response to Office Action.

12 Q. What's the date?

13 A. It was received in the PTO on December 3rd,
14 2003. And in it the applicant, through its
15 counsel has entered a disclaimer. They
16 requested disclaimer of America's Favorite
17 Pasta.

18 Q. Okay. I offer this witness to you Ms.
19 Burbach for cross-examination both as to
20 his testimony, his Expert Report, Rebuttal
21 Expert Report, and his testimony today.
22 Referencing the right to rehabilitate him.
23 Time is about 3:00.

24 CROSS-EXAMINATION

1 MS. BURBACH:

2 Q. Mr. Germain, my name is Cheryl, as I
3 introduced myself earlier. I'm here on
4 behalf of American Italian Pasta Company,
5 who is the opposer as you know, in this
6 proceeding. Clearly, you have had a lot of
7 experience in trademark law, and I
8 understand probably based your past
9 testimony experience and expert experience
10 the rules of evidence, rules of civil
11 procedure. And I don't believe this
12 question was asked, but as a trademark
13 attorney I assume that you're familiar with
14 the Trademark Trial and Appeal Board
15 manuals and procedures?

16 A. Yes.

17 Q. Have you reviewed any of those rules since
18 you've been retained in this proceeding?

19 A. No.

20 Q. Have you ever represented parties in any
21 opposition or cancellation proceeding?

22 A. Yes.

23 Q. In the course of that representation, did
24 you ever take any depositions or

1 cross-examine any witnesses in a deposition
2 during a testimony period?

3 A. I don't think so.

4 Q. Well, and I'm sure you're aware of this, as
5 you understand this is a testimony
6 deposition. Unlike a discovery deposition
7 it will be automatically filed with the
8 Trademark Trial and Appeal Board. And I
9 would remind you as Mr. Banner said, be
10 cognizant that there is no judge in the
11 room. And I would ask you to respond to
12 questions asked, and be cognizant if
13 there's a dispute we will have to deal with
14 it later. So maybe we can avoid that.
15 Have you ever been retained as an expert as
16 an expert in an opposition or a
17 cancellation proceeding?

18 A. Yes.

19 Q. Did you testify in an opposition or
20 cancellation proceeding?

21 A. I believe I did.

22 Q. How often do you served as an expert in
23 your practice?

24 A. It's a hard question to answer, because it

1 varies. And since it's litigation based,
2 it's necessarily fluctuates. Through the
3 years I have testified in court
4 approximately 15 times. Some years there's
5 more some years there's less.

6 Q. Well, is it true that you have probably
7 been retained as an expert more often than
8 that, but just not gotten to the testimony
9 period?

10 A. Yes. I've been deposed probably dozens of
11 times. I've been retained many more times
12 than I've been deposed.

13 Q. Are you retained as an expert usually every
14 year of your practice?

15 A. Yes.

16 Q. And on average how many cases a year are
17 you an expert, and I know this is an
18 estimation?

19 A. Maybe half a dozen.

20 Q. Okay. And I understand your were an
21 adjunct professor currently?

22 A. Yes. For the time -- the years I've been
23 here in Cincinnati I've served as an
24 adjunct professor at the University of

1 Cincinnati College of Law, that's correct.

2 Q. What percentage, roughly, of your income is
3 derived from being a professor?

4 A. Zero.

5 Q. I suspected. As an expert, when you are
6 paid as an expert are you paid personally
7 or does that go to the firm Thompson Hine?

8 A. To Thomson Hine.

9 Q. So would you -- does your income vary
10 depending on whether you are practicing as
11 an lawyer versus serving as an expert
12 witness?

13 A. My income does not vary, but my rate
14 varies.

15 Q. Okay. Isn't it true that you advertise
16 your expert services?

17 A. Yes.

18 Q. For instance, doesn't it appear on your
19 website?

20 A. Yeah. I think it does.

21 Q. How many expert reports do you think you've
22 prepared in your state as a lawyer, more
23 than 100?

24 A. I doubt it's more than 100.

1 Q. Okay.

2 A. Probably between 50 and 100. I've been
3 doing expert work for at least 20 years,
4 probably more like 25. And I just don't
5 have any -- I don't have a recollection of
6 how many now.

7 Q. Could you tell us how you happen to know
8 Brian Banner, the counsel for Barilla?

9 A. I knew his father Don. I spent one year in
10 Washington, D.C. as Counsel to what is now
11 Banner & Witcoff. Don was already there at
12 the time. I had met his father as early as
13 1978 when I gave one of my early lectures.
14 His father was commissioner of patents, and
15 I'd seen him here and there at
16 organizations through the years. I can't
17 really tell you the first time I met Brian
18 Banner. I have met him, his brother Mark,
19 his sister Pam. I've lectured with Pam.
20 Mark was here on my program a couple years
21 ago. It's just hither and thither and
22 ninta. And that's where it is.

23 Q. Have you ever served as co-counsel with
24 Mr. Banner?

1 A. No.

2 Q. Have you ever been retained by Mr. Banner
3 as an expert in any other lawsuit or
4 opposition?

5 A. No.

6 Q. You testified earlier, I believe, and
7 correct me if I'm wrong that you have never
8 been the director of branding or marketing
9 in a company?

10 A. That's correct.

11 Q. Is it true that you have never worked for a
12 company in a case of brand government?

13 A. That's correct.

14 Q. Would the same be true for marketing
15 services?

16 A. Right.

17 Q. You have not received any awards or
18 recognition in the advertising or brand
19 industry have you?

20 A. No.

21 Q. Are you familiar with and organization that
22 uses the acronym AIGA?

23 A. No.

24 Q. Okay. Are you a member of any advertising

1 or brand name organizations?

2 A. Advertising or branding. I'm active in the
3 National Trademark Association which has a
4 component of that stock.

5 Q. Sure.

6 A. Other than that, no.

7 Q. Okay. Can you explain how you came to be
8 involved in this lawsuit or in this
9 opposition proceeding?

10 A. Mr. Banner either called me or e-mailed,
11 probably called me, but I'm not sure, not
12 all that long ago, a month or two. And
13 told me a little about this opposition, and
14 asked me if I would be interested in
15 serving as an expert on behalf of his
16 client.

17 Q. And what did he tell you about the
18 opposition proceeding?

19 A. It was between, I guess, he gave me the
20 names of the companies. He certainly had
21 to do it early enough so I could run a
22 conflicts check. He told me the phrase
23 involved was America's Favorite Pasta for
24 pasta products. He may have told me this

1 followed the false advertising lawsuit that
2 New World Pasta case. I think he told me
3 that we had to get on the stick. That
4 there was not a whole lot of time to get
5 the testimony reports and the testimony
6 taken. That kind of stuff.

7 Q. You said was the about a month or two ago?

8 A. I think it was in November. I doubt it was
9 as early as October.

10 Q. Have you had any other conversations with
11 Mr. Banner since that time?

12 A. Oh, yeah. I've talked to him a few times
13 on the phone.

14 Q. And what have those conversations been
15 about?

16 A. Sometimes it was asking for documents if I
17 didn't already have them. We talked at one
18 point about scheduling this deposition.
19 Told him my views at one point. I think I
20 may have read him a draft of at least one
21 of the reports at one point.

22 Q. And did any of those views change when you
23 completed your report or I should say
24 reports?

1 A. Not really.

2 Q. Okay.

3 A. Those views became more and more buttressed
4 by other people as testimony, declarations,
5 etc.

6 Q. So in preparing for this case, did you work
7 alone?

8 A. Fundamentally, I may have had -- there's an
9 Associate in our Dayton office who is a
10 former trademark examiner. In fact, I may
11 have had her do a little research type
12 thing, but I virtually did it all myself.

13 Q. What is her name?

14 A. Renee LaForte, L-A, capital F-O-R-T-E.

15 Q. Was her work done under your supervision?

16 A. Well, yeah. I mean she is a big girl. She
17 doesn't need me to stand behind her. I
18 told her what I wanted. I'm not even sure
19 I did. But if I did I would tell her what
20 I'm looking for, and she would go find it,
21 and give it to me.

22 Q. I understand. How many hours have you
23 spent working on this proceeding as a
24 retained expert?

1 A. I bet it's 30 to 40.

2 Q. Have you conducted any surveys for the
3 purposes of this proceeding?

4 A. No.

5 Q. Or done any factual research for purposes
6 of this proceeding?

7 A. Factual research?

8 Q. Let me be more specific. Have you done any
9 consumer research for the purpose of this
10 proceeding?

11 A. No.

12 Q. Have you asked any questions of consumers
13 regarding any of the marks involved in the
14 proceeding?

15 A. No.

16 Q. What did you do to prepare for your
17 reports, and your for your deposition
18 today?

19 A. Well, I read and studied all of the items
20 listed in my Exhibit 3. I read some cases,
21 some of which appear in my legal appendix
22 to one of my reports. I read some number
23 of chapters or sections of chapters in
24 McCarthy's Treatise. I went on the web and

1 looked up a couple of things like the BMW
2 The Ultimate Driving Machine, the AIPC's
3 website. I think that's it.

4 Q. You said that Mr. Banner had asked you if
5 you were interested in being an expert in
6 this case; what did he, specifically, ask
7 you to do?

8 A. I don't remember. I mean the gist of it
9 was, would I read the relevant documents,
10 and give him my thoughts based on this
11 opposition. He didn't give me specific
12 instructions.

13 Q. So how did you know or select what to opine
14 about then?

15 A. I think it was pretty obvious that the
16 issue here is whether, I mean your client
17 apparently had first use. The phrases are
18 very similar. The phrases are identical.
19 The only difference between the two parties
20 marks is that the applicant's mark has
21 Barilla at the front end. America's
22 Favorite Pasta is the same. And they are
23 both Pasta. So we have largely the same
24 mark, same goods, and you're first. So

1 what is to argue? Well, what is to argue
2 is, does your client have a mark, does it
3 have something that is distinctive which
4 under the Auto Roth CCPA 1981 case gives it
5 position to object? So that looked like
6 the issue.

7 Q. Okay. When did you receive all the
8 materials that you reviewed for this
9 proceeding?

10 A. Again --

11 Q. Were they piece meal or?

12 A. Yeah. One of them just came in very
13 recently, shortly before my report had to
14 be filed. It was filed, because I think it
15 was Webster's deposition that was taken
16 just recently. Yeah. Mr. Banner would
17 e-mail the stuff to me, and I would have my
18 secretary print it, and I would read it.

19 Q. Are there any other materials that you
20 reviewed that were not identified in your
21 Expert Report?

22 A. Might have been some legal research
23 materials but there were no other factual
24 materials. I never feel it's required for

1 me to list all the research materials.

2 Q. Are those legal research materials listed
3 in, I think, it's attached to your Rebuttal
4 Report?

5 A. Legal appendix.

6 Q. Yes.

7 A. Fundamentally. But, for example, there
8 were probably a few section of McCarthy's
9 Treatise that I read, which I didn't find I
10 needed for this purpose. So I didn't list
11 them.

12 Q. Okay. Sure. Have there been any materials
13 reviewed since you submitted your reports?

14 A. Actually, I think I looked up The Ultimate
15 Driving Machine, and the Hallmark slogan
16 more recently. Because I had done it
17 intuitively, and sort of judicial notice
18 kind of approach earlier. And then I got
19 to thinking gee, I better make sure that I
20 said this right. So I looked them up, the
21 Ultimate Driving Machine 30 years, and the
22 Hallmark slogan 60 years.

23 Q. And when you say looked them up, what do
24 you mean by that?

1 A. Just went on the web and used Google or
2 another search engine to find. They are
3 easy to find and interestingly the BMW
4 slogan, they just decided to dump.

5 Q. Really. I did not know that.

6 A. It's causing cataclysms like Blue Coke.
7 People are writing in, what do you mean
8 this is no longer your slogan. They are
9 going to something like, we like new ideas.

10 Q. With regards to your opinions in this case,
11 have you spoken to anyone employed by
12 Barilla?

13 A. No.

14 Q. Have you spoken then with anyone at Barilla
15 about their marketing programs?

16 A. No.

17 Q. Have you spoken to any advertising agency
18 or marketing firm or anyone else on behalf
19 of Barilla who created or intended to
20 create their marketing programs?

21 A. No.

22 Q. Okay. Do you personally know Anne
23 Willoughby?

24 A. No.

1 Q. Did you know of her before this proceeding?

2 A. No.

3 Q. You were not present at her deposition were
4 you?

5 A. No. I was not.

6 Q. Do you personally know Tim Webster?

7 A. No.

8 Q. Did you know of him before this lawsuit?

9 A. No.

10 Q. I'd ask you the same questions about Mr.
11 Drew Lericos. Have you met him personally
12 or know him personally?

13 A. Neither.

14 Q. Okay. On BMW, The Ultimate Driving
15 Machine, that you brought up a couple
16 times, I understand you looked at their
17 website. Did you perform any research
18 about the effect of their brand on
19 consumers?

20 A. No.

21 Q. Did you speak with anyone at the company
22 about that brand name?

23 A. No.

24 Q. Did you speak with anybody in the marketing

1 or advertising industry about that slogan?

2 A. No.

3 Q. Would your answer change for any of those
4 questions with regard to Hallmark as, When
5 You Care Enough to Send the Very Best
6 trademark?

7 A. No. Same answer. Same answers.

8 Q. Okay. Is use on a package of a trademark
9 sufficient, can it be sufficient to
10 establish trademark use?

11 A. Yes.

12 Q. In fact isn't it required for goods to put
13 your trademark on goods whenever
14 practically possible?

15 A. Yeah. On the goods, on the package, on the
16 point of sale displays, yes.

17 Q. Are you familiar with the term use
18 analogous to trademark use?

19 A. Yes.

20 Q. What does that mean?

21 A. Sometimes it's a trade name use. It's a
22 use similar to analogous to but not the
23 same as trademark use. And sometimes it
24 allows a party to get a leg up in terms of

1 priority on another party.

2 Q. Could you provide an example of when that
3 might occur?

4 A. Another example would be a use in
5 advertising of a good were, for purposes of
6 USPTO registration, there's no specimen.
7 But the advertising use, like on a bill
8 board, might qualify as using commerce for
9 purposes of set a priority date. Then
10 later specimen would be in effect tacked
11 with the use analogous.

12 Q. So, is it correct to say, that one who
13 attempts to obtain trademark rights might
14 benefit or obtain those rights through use
15 on something other than the goods
16 themselves?

17 A. Benefit, in a loose sense, yes.

18 Q. What effect would such use have on a
19 trademark owner if they used it in
20 advertising perhaps before they actually
21 placed the trademark on goods?

22 A. A few effects, possible effects come to
23 mind. One is it can provide priority if
24 that's what the battle is. Visa V another

1 party. And another effect is, I think that
2 advertising, that nontechnical trademark
3 use in a form of advertising can sensitize
4 the relevant market and help to establish
5 secondary meaning.

6 Q. Are you familiar with the supplemental
7 register at the Patent and Trademark
8 Office?

9 A. I am.

10 Q. Can you explain what that is?

11 A. It's sections 23 and the next couple of the
12 Lanham Act. It's a second class register.
13 Really was created for the purpose of
14 allowing American companies that had
15 descriptive marks to get domestic i.e. US
16 registrations which they can parlay to
17 foreign registrations. Because a lot of
18 foreign company countries said if you don't
19 have a home registration you are out to
20 lunch here. It has very little impact in
21 the United States. And it's sort of a
22 parking place for marks that have not -- or
23 terms that haven't grown up yet to become
24 marks, typically, descriptive terms.

1 Q. What benefits are obtained from being on
2 the supplemental registry?

3 A. Not a whole lot. You do get -- you don't
4 get constructive notice ala section 22, but
5 you do get practical notice when the search
6 report is done. A supplemental
7 registration will show up if a federal
8 search is done. So it serves as notice, in
9 fact, to someone who sees it. Also you
10 can -- a party owning a supplemental
11 registration can rely on it in a section 2D
12 likelihood of confusion proceeding,
13 opposition, cancellation. And the examiner
14 can rely on it ex parte, however it had
15 better be, kind of an all four situation.
16 Because they give supplemental
17 registrations virtually no breadth.

18 Q. What do you mean by all four?

19 A. Same mark. All fours. It's an old law
20 school phrase. Two cases are on all fours.

21 Q. Gotcha.

22 A. I'm tuning up.

23 Q. Have you done any research to see what
24 trademark Barilla owns?

1 A. I think I did get on the USPTO.gov website
2 at one point. And I think I did -- further
3 more at least one of the exhibits has a
4 list of marks that -- oh, Barilla. Yeah.
5 I might have looked, yeah, I did look at
6 Barilla too. I did.

7 Q. In the application we were just visiting
8 with Mr. Banner, Exhibit 28, are you aware
9 that when the application was filed it did
10 not include a disclaimer for America's
11 Favorite Pasta?

12 A. Right. I knew that.

13 Q. Okay. And isn't it also your understanding
14 that an Office Action issued requiring a
15 disclaimer initially?

16 A. Right.

17 Q. Is it also your understanding that Barilla
18 attempted to overcome that refusal with
19 arguments trying to avoid the disclaimer of
20 America's Favorite Pasta?

21 A. Yes.

22 Q. And is it also your understanding that the
23 examiner ultimately made the refusal final
24 and required the disclaimer?

1 A. Right.

2 Q. Are you aware that Barilla owns a
3 registration for the trademark, Italy's
4 Number One Pasta?

5 A. I think I saw that.

6 Q. What does that Italy's Number One Pasta
7 mean to you? Do you consider Italy's
8 Number One Pasta to be a laudatory or
9 puffery?

10 A. Number One may be a bit more specific than
11 Favorite. These are judgment calls. So
12 whether that would considered self
13 laudatory like America's Favorite Pasta I'm
14 not sure. The PTO attitude toward words
15 like favorite and number one tends to be
16 that they are merely descriptive and
17 capable of acquiring distinctiveness, but
18 you really have to prove it.

19 Q. Do you know whether Barilla's registration
20 was granted under section 1A or section 2F
21 of the Lanham Act, for the mark Italy's
22 Number One Pasta?

23 A. I don't remember.

24 Q. Do you know that that mark, Italy's Number

1 One Pasta appears on Barilla's packaging
2 for it's pasta products?

3 A. I assume it did.

4 Q. Do you know whether that trademark appears
5 with the registration symbol following it
6 or a TM symbol following it?

7 A. No. I don't. I don't remember.

8 Q. With regard to the application for the mark
9 at issue, Barilla America's Favorite Pasta,
10 was that filed as an intent to use
11 application?

12 A. I think so. I think it might still be in
13 that form.

14 Q. And if so, isn't it true, that they would,
15 Barilla would not be entitled to a register
16 under 2F unless they could show that they
17 actually used the mark and acquired
18 distinctiveness as you spoke about earlier?

19 A. They don't need to get under 2F, because
20 the Barilla part -- well, if they get it on
21 2F as to the Barilla part, and the rest of
22 it has been disclaimed. So I don't think
23 they are going to have that problem.

24 Q. Isn't it true that the patent and trademark

1 office has issued many trademark
2 registrations or allowed trademark
3 applications that were for the mark,
4 America's Favorite, you fill in the blank,
5 for the goods that were identified in that
6 blank?

7 A. Yes. It is true.

8 Q. And what is your basis of understanding of
9 how they were deemed registrable?

10 A. They were all second class in one respect
11 or another. Some were on the supplemental
12 register which by very definition is second
13 class. Some disclaimed America's Favorite,
14 and some went 2F, secondary meaning. Those
15 are the strategies that are available. And
16 those are the strategies that have been
17 used.

18 Q. Have you ever filed trademark applications
19 on behalf of your clients that were made up
20 of merely puffery or laudatory words?

21 A. You're asking me to admit sin on the
22 record?

23 Q. Sorry.

24 MR. BANNER: I'm going to object to that then. Protect

1 my witness.

2 A. Probably. I can't think of any right now,
3 but probably.

4 Q. Do you recall if you filed an application
5 on behalf of your clients for the mark
6 Famous Recipe Fried Chicken and Design?

7 A. No. I don't remember it. How many eons
8 ago was it?

9 Q. I believe it was in the 70s, actually.
10 Filed on behalf of Schoneys in 1979?

11 A. I don't remember it.

12 Q. That's fine. Are you aware that you filed
13 a trademark application on behalf of Matrix
14 Telephone Marketing Solutions for market
15 research services telemarketing services?

16 A. No. I'm not denying it. It sounds vaguely
17 familiar. Do I remember to, no. When was
18 that?

19 Q. That was 1997, 10 years ago. Are you aware
20 that you filed an application for the mark,
21 the Worlds First Beautiful Network for
22 Broadwing Communications?

23 A. I know who Broadwing is or used to be. It
24 doesn't exist anymore.

1 Q. Filed in 2001 by the way?

2 A. We are getting there.

3 Q. Let's see here. Exhibit 24 is an exhibit
4 you were looking at earlier for America's
5 Favorite Truck Camper; do you recall that?

6 A. Yes, I do.

7 Q. Do you happen to know what specific
8 evidence that applicant provided to prove
9 secondary meaning?

10 A. No.

11 Q. Do you know how the applicant or the
12 registered, I should say, used the mark in
13 connection with its goods?

14 A. No.

15 Q. Okay. With regard to your Rebuttal Report
16 and your Expert Report, at the end of each
17 one I note there's a paragraph that states,
18 quote, this report is premised on the
19 information and legal authorities that I
20 have been able to review as of today's
21 date. Thus, I hereby reserve the right to
22 supplement this report as appropriate to
23 account for later available information
24 and/or legal authorities. Also, all

1 though, I have not referred to all of the
2 items listed in Exhibit 3 in this report,
3 the unreferenced items may have informed my
4 understanding of the facts and issues and
5 effected the opinions expressed therein --
6 or herein. Could you explain what the
7 purpose of that provision is?

8 A. It's an attempt to say that you can hold me
9 to what I have written here with the
10 exception that what I wrote here may change
11 based on new facts, new facts, changes in
12 the law, things of that sort.

13 Q. Are you aware of any changes in the law
14 since you submitted your reports that would
15 effect your opinions in them?

16 A. No. That's a standard paragraph that I use
17 at the end of every Expert Report.

18 Q. Attached to your Rebuttal Expert Report is
19 the legal appendix that we referred to
20 earlier; can you explain what that document
21 is?

22 A. Well, it's designed to sketch in the legal
23 background against which I measured some of
24 the comments or positions taken by

1 Ms. Willoughby.

2 Q. Did you create this document?

3 A. Oh, yes.

4 Q. And when did you create that document?

5 A. Before I signed the report. I don't know
6 specifically.

7 Q. I guess a better way of asking this is, did
8 you create this document for purposes of
9 the dispute?

10 A. Oh, yes.

11 Q. Does any of this come from another source
12 such as a legal memo that you did for
13 another client or anything like that or
14 another brief you've written, perhaps?

15 A. I do that sometimes, but I didn't do it
16 this time.

17 Q. Would this reference some of the research,
18 if you had your associate do it, in here?

19 A. I think I did this myself.

20 Q. Okay.

21 A. Including the -- oh, I may have had -- she
22 is much better with the computer than I am.
23 So sometimes and we don't have USPQ in this
24 office. So sometimes I will e-mail her or

1 call her, and ask her to send me some
2 cases. Sometimes I get it from, we have a
3 librarian here, I do that. I think I did
4 this all myself, but they may have helped a
5 little.

6 Q. Have you been asked to perform any
7 additional responsibilities or participate
8 in any other way in this proceeding?

9 A. No.

10 Q. Do you intend to undertake any other
11 responsibilities -- I mean are you aware of
12 any other requests that, perhaps, Barilla
13 has asked you to perform?

14 A. No. I assume that I will be asked to read,
15 and correct, approve my deposition
16 transcript, but other than that I think I'm
17 done.

18 MS. BURBACH: I think I'm done with my questions, but
19 before I conclude I would like a quick
20 second to kind of make sure I haven't
21 forgotten anything.

22 THE WITNESS: Sure.

23 MR. BANNER: Sure. I'm going to do a little rebuttal.

24 MS. BURBACH: That's fine. You can go ahead and do it

1 now if you want.

2 MR. BANNER: I'll wait for you.

3 MS. BURBACH: I have no further questions.

4 FURTHER DIRECT EXAM

5 BY MR. BANNER:

6 Q. I just have a couple questions to clarify
7 some stuff. In looking at the application
8 for Barilla, Americas Favorite Pasta, which
9 I think is in that stack there. There it
10 is yeah. What Exhibit Number is it?

11 A. Twenty-eight.

12 Q. Twenty-eight. Is it -- as an expert
13 witness how would you characterize the
14 brand Barilla standing alone for food
15 products in general?

16 A. I'm guessing it's a surname to start with.
17 That it obtained secondary meaning in
18 connection with pasta products some years
19 ago. I didn't pay much attention to it.

20 Q. I have no idea if it's a surname or not.
21 I've never met anybody by the name of
22 Barilla?

23 A. It could be an Italian word for something
24 entirely different. I don't know.

1 Q. If it were a surname like McKee, would work
2 to bring it into registration, because
3 McKee doesn't have any other meaning?

4 A. Right. It would have -- it would be
5 primarily merely a surname, and under a
6 subsection of 2E, and it would have to earn
7 it's way to registration through 2F.

8 Q. It wouldn't apply if it were like the name
9 Banner and it had a meaning, it was also
10 the piece of cloth on a stick that people
11 carry around?

12 A. Good example.

13 Q. Okay. Painful. Are you aware that
14 sometimes applicants abandon applications
15 specifically to get different examiners,
16 and refile the same application a few
17 months or years later so as to avoid a
18 particular examiner's opinion on a case?

19 A. I've heard of that.

20 Q. Do you have any idea how many examiners
21 that the US Patent and Trade Mark Office
22 employs today?

23 A. It's hundreds and hundreds, and it's
24 largely a revolving door operation.

1 Q. Do all of those examiners think exactly
2 alike?

3 A. No way.

4 Q. So is it a fair conclusion that one
5 examiner may find something acceptable, and
6 another examiner not acceptable for
7 purposes of passing an application to
8 registration or to publication?

9 A. Yes.

10 MR. BANNER: I'm finished.

11

12 DEPOSITION CONCLUDED AT 3:32 P.M.

13

14 * * * * *

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ACKNOWLEDGEMENT

OHIO
STATE OF ~~KENTUCKY~~ :
HAMILTON : SS:
COUNTY OF ~~GRANT~~ :

I, Kenneth B. Germain, have read the transcript of my testimony given under oath on December 20, 2006.

Having had the opportunity to note any necessary corrections of my testimony on the ^{two}errata page^s, I hereby certify that the above-mentioned transcript is a true and complete record of my testimony.



KENNETH B. GERMAIN

1/2/07

(DEPOSITION CONCLUDED AT 3:32 P.M.)

ERRATA SHEET OF THE TRANSCRIPT OF Kenneth B. Germain

American Italian Past v. Barilla, **Opposition** No. 91/161,373

I, Kenneth B. Germain have read the foregoing pages of my deposition given on December 20, 2006 and wish to make the following, if any, amendments, additions, deletions or corrections:

PAGE	LINE	CORRECTION	REASON
8	18	Bachelorette → Baccalaureate	misspelled
13	4	it's → its	no apostrophe
13	8	trademark, → trademark	no comma
15	8	of the certain → of certain	not needed
16	17	for the years → for 4 years	word omitted
16	23	Administration of the Lanham	words omitted
21	5	Massager → Messenger	wrong word
35	5	examined → examined	misspelled
35	8	summary → summaries	plural needed
42	13	begin → beginning	wrong word
47	23	it's → its	no apostrophe
49	14	trademark's → trademarks	" "
51	19	copy writes → copyrights	wrong word
53	8	"	" "
53	9	not → no	" "
53	16	be a → be on	" "
54	20	it's → its	" "
55	4	of 7C of → 7C of	not needed
65	2	director → direct	wrong word

PAGE 1 OF 2

In all other respects the transcript is true and correct.

Kenneth B. Germain
Kenneth B. Germain

Subscribed and sworn to before me this January 2006

TERRI L. SCHAEFER
Notary Public



TERRI L. SCHAEFER
Notary Public, State of Ohio
My Commission Expires
October 19, 2008

ERRATA SHEET OF THE TRANSCRIPT OF Kenneth B. Germain

American Italian Past v. Barilla, **Opposition** No. 91/161,373

I, Kenneth B. Germain have read the foregoing pages of my deposition given on December 20, 2006 and wish to make the following, if any, amendments, additions, deletions or corrections:

PAGE	LINE	CORRECTION	REASON
65	15	in use → in exclusive use	word missing
67	24	serous → series	wrong word
70	15	time → file	" "
71	3	examp → examines	" "
73	14	mark as in → mark in	unnecessary
73	18	asced → accede	misspelled
79	22	ninta → ?	?
81	3	National → International	wrong word
86	4	Auto → Otto	" "
88	6	Blue → New	" "
91	24	Visa V → vis-a-vis	misspelled
93	15	four → fours	not plural
104	8	it's → its	no apostrophe.

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2

In all other respects the transcript is true and correct.

Kenneth B. Germain

Subscribed and sworn to before me this _____ day of _____, 2006.

Notary Public

C E R T I F I C A T E

STATE OF KENTUCKY)

COUNTY OF GRANT)

I, Jennifer Davis, the undersigned, a duly qualified and commissioned Notary Public within and for the State of Kentucky, do hereby certify that before giving of the aforesaid deposition, the said KENNETH B. GERMAIN was by me first duly sworn to depose the truth, the whole truth and nothing but the truth; that the foregoing deposition was given at the said time and place and was taken in all respects pursuant to agreement of counsel hereinbefore set forth; that the deposition was taken in stenotypy by me and transcribed into typewritten form under my supervision; that the transcribed deposition is to be submitted to the witness for his/her examination and for signature, and that signature may be affixed out of the presence of the Notary Public; that I am neither relative, attorney, nor employee of any party or their counsel and have no interest in the result of this pending action.

IN WITNESS WHEREOF, I have hereunto set my hand and official seal of office at Cincinnati, Ohio, this

27th day of December, 2006.

My commission expires:

April 19, 2010

Jennifer Davis
Jennifer Davis, CSR

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA
COMPANY,

Opposer

v.

BARILLA G. E. R. FRATELLI – SOCIETA
PER AZIONI,

Applicant

Opposition No. 91-161,373

NOTICE OF DEPOSITION

PLEASE TAKE NOTICE THAT pursuant to 37 C.F.R. 2.123, Applicant, Barilla G. E. R. Fratelli – Societa Per Azioni, by and through its attorneys, will take the deposition of Ken Germain before a Notary Public, or other officer authorized to administer oaths and will be recorded by stenographic and/or audiovisual means, commencing Wednesday, December 20, 2006, at 12:00 p.m. at 312 Walnut Street, 14th Floor, Cincinnati, OH 45202.

You are invited to attend and cross-examine.

Dated: December 8, 2006

Respectfully submitted,



Brian Banner, Esq.
G. Franklin Rothwell, Esq.
Rothwell, Figg, Ernst & Manbeck
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040

CERTIFICATE OF SERVICE

I certify that on this 8th day of December, 2006, a true copy of the foregoing Notice of Deposition of Mr. Ken Germain was served by first class mail, postage prepaid to:

Thomas H. Van Hoozer, Esq.
Hovey Williams, LLP.
2405 Grand Boulevard
Suite 400
Kansas City, MO64108

Counsel for Opposer



Brian Banner, Esq.

**Issued by the
UNITED STATES DISTRICT COURT**

SOUTHERN

DISTRICT OF

OHIO

American Italian Pasta Company, Opposer

SUBPOENA IN A CIVIL CASE

V.

Barilla G. E R.

Fratelli-Societa, Applicant

Case Number:¹

Opposition No. 91161373

TO: Ken Germain
312 Walnut Street, 14th Floor
Cincinnati, OH 45202

☐ YOU ARE COMMANDED to appear in the United States District court at the place, date, and time specified below testify in the above case.

PLACE OF TESTIMONY	COURTROOM
	DATE AND TIME

☒ YOU ARE COMMANDED to appear at the place, date, and time specified below to testify at the taking of a deposition in the above case.

PLACE OF DEPOSITION 312 Walnut Street, 14 th Floor, Cincinnati, OH 45202	DATE AND TIME December 20, 2006, 12:00 p.m.
--	--

☐ YOU ARE COMMANDED to produce and permit inspection and copying of the following documents or objects at the place, date, and time specified below (list documents or objects):


PLACE	DATE AND TIME
-------	---------------

☐ YOU ARE COMMANDED to permit inspection of the following premises at the date and time specified below.

PREMISES	DATE AND TIME
----------	---------------

Any organization not a party to this suit that is subpoenaed for the taking of a deposition shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify. Federal Rules of Civil Procedure, 30(b)(6).

ISSUING OFFICER'S SIGNATURE AND TITLE (INDICATE IF ATTORNEY FOR PLAINTIFF OR DEFENDANT) Attorney for Applicant	DATE December 8, 2006
---	--------------------------

ISSUING OFFICER'S NAME, ADDRESS AND PHONE NUMBER Brian Banner, Rothwell, Figg, Ernst & Manbeck, 1425 K Street NW, Suite 800, Washington, DC 20005, (202) 783-6040 
--

(See Rule 45, Federal Rules of Civil Procedure, Parts C & D on next page)

¹ If action is pending in district other than district of issuance, state district under case number.

PROOF OF SERVICE

DATE

PLACE

SERVED

SERVED ON (PRINT NAME)

MANNER OF SERVICE

SERVED BY (PRINT NAME)

TITLE

DECLARATION OF SERVER

I declare under penalty of perjury under the laws of the United States of America that the foregoing information contained in the Proof of Service is true and correct.

Executed on

DATE

SIGNATURE OF SERVER

ADDRESS OF SERVER

Rule 45, Federal Rules of Civil Procedure, Parts C & D:

(c) PROTECTION OF PERSONS SUBJECT TO SUBPOENAS.

(1) A party or an attorney responsible for the issuance and service of a subpoena shall take reasonable steps to avoid imposing undue burden or expense on a person subject to that subpoena. The court on behalf of which the subpoena was issued shall enforce this duty and impose upon the party or attorney in breach of this duty an appropriate sanction which may include, but is not limited to, lost earnings and reasonable attorney's fee.

(2) (A) A person commanded to produce and permit inspection and copying of designated books, papers, documents or tangible things, or inspection of premises need not appear in person at the place of production or inspection unless commanded to appear for deposition, hearing or trial.

(B) Subject to paragraph (d) (2) of this rule, a person commanded to produce and permit inspection and copying may, within 14 days after service of subpoena or before the time specified for compliance if such time is less than 14 days after service, serve upon the party or attorney designated in the subpoena written objection to inspection or copying of any or all of the designated materials or of the premises. If objection is made, the party serving the subpoena shall not be entitled to inspect and copy materials or inspect the premises except pursuant to an order of the court by which the subpoena was issued. If objection has been made, the party serving the subpoena may, upon notice to the person commanded to produce, move at any time for an order to compel the production. Such an order to compel production shall protect any person who is not a party or an officer of a party from significant expense resulting from the inspection and copying commanded.

(3) (A) On timely motion, the court by which a subpoena was issued shall quash or modify the subpoena if it

(i) fails to allow reasonable time for compliance,

(ii) requires a person who is not a party or an officer of a party to travel to a place more than 100 miles from the place where that person resides, is employed or regularly transacts business in person, except that, subject to the provisions of clause (c) (3) (B) (iii) of this rule, such a person may in order to attend

trial be commanded to travel from any such place within the state in which the trial is held, or

(iii) requires disclosure of privileged or other protected matter and no exception or waiver applies, or

(iv) subjects a person to undue burden.

(B) If a subpoena

(i) requires disclosure of a trade secret or other confidential research, development, or commercial information, or

(ii) requires disclosure of an unretained expert's opinion or information not describing specific events or occurrences in dispute and resulting from the expert's study made not at the request of any party, or

(iii) requires a person who is not a party or an officer of a party to incur substantial expense to travel more than 100 miles to attend trial, the court may, to protect a person subject to or affected by the subpoena, quash or modify the subpoena, or, if the party in whose behalf the subpoena is issued shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship and assures that the person to whom the subpoena is addressed will be reasonably compensated, the court may order appearance or production only upon specified conditions.

(d) DUTIES IN RESPONDING TO SUBPOENA.

(1) A person responding to a subpoena to produce documents shall produce them as they are kept in the usual course of business or shall organize and label them to correspond with the categories in the demand.

(2) When information subject to a subpoena is withheld on a claim that it is privileged or subject to protection as trial preparation materials, the claim shall be made expressly and shall be supported by a description of the nature of the documents, communications, or things not produced that is sufficient to enable the demanding party to contest the claim.

**ANNUAL REVIEW OF AMERICAN APPELLATE
COURT DECISIONS ON TRADEMARKS,
TRADE DRESS AND UNFAIR COMPETITION***

Kenneth B. Germain**

Thompson Hine LLP

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** Partner: Thompson Hine LLP (Cincinnati, Ohio) (Tel.: 513-352-6527; Fax: 513-241-4771; email: Ken.Germain@ThompsonHine.com); Adjunct Professor of Law: University of Cincinnati College of Law; Member: Advisory Board, BNA's *Patent, Trademark & Copyright Journal*; Member: Board of Advisors, ALI's *Restatement (Third) of Unfair Competition*; Member: Ohio, California, and the District of Columbia Bars. Listed in: *The Best Lawyers in America* (1992-93 and all later editions); *Guide to the World's Leading Experts in Trade Mark Law* (1996 and later editions); Ohio Super Lawyers 2004, 2005, and 2006; Chambers U.S. America's Leading Lawyers (2004 and 2005). Founder/Chairman: All Ohio Annual Institute On Intellectual Property (AOAIOIP); Member: INTA/CPR Panel of Neutrals (for Trademark/Trade Dress ADR); Charter Member: Advisory Council, J. Thomas McCarthy Institute for Intellectual Property and Technology Law; Testimonial Expert Witness in numerous trademark/unfair competition cases; available as a Mediator for trademark/unfair competition disputes.

**ANNUAL REVIEW OF AMERICAN APPELLATE
COURT DECISIONS ON TRADEMARKS,
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By: Kenneth B. Germain

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A. DISTINCTIVENESS OF MARKS

1. **Borinquen Biscuit Corp. v. M.V. Trading Corp.,**
443 F.3d 112, 78 U.S.P.Q.2d 1454 (1st Cir. 2006):

An old, but *not* "incontestable" registered mark, RICA, for semi-sweet cookies, was asserted against newcomer NESTLÉ RICAS, for a salty biscuit. A preliminary injunction was granted – and affirmed on appeal. The First Circuit noted that, as a registered mark, RICA (literally rich/wealthy/tasty) was entitled to a presumption of inherent distinctiveness which only could be overcome by "significantly probative evidence" of mere descriptiveness. (If the latter could be established, the burden of proving acquired distinctiveness would fall upon the trademark owner.) On the merits, the First Circuit had this to say:

[Defendant's failure to present evidence of descriptiveness] is all the more glaring because the first language of the prototypical Puerto Rico consumer is Spanish and, as [Plaintiff] notes, Spanish grammatical rules caution against attributing a purely adjectival meaning to the term "RICA" when viewed in the context of [Plaintiff's] logo: "Galletas RICA Sunland." A particular Spanish-language grammatical rule – the rule of concordance – requires strict relationships of gender and number between adjectives and nouns. . . . Hence, [Plaintiff's] mark would need to use the plural ("RICAS") if it were intended to serve as a grammatically correct descriptor of the noun "Galletas." We think it follows that the average Spanish-speaking consumer would be unlikely to view the non-concordant mark as a mere descriptor for the underlying product.

2. **In re Stereotaxis, Inc.,**
429 F.3d 1039, 77 U.S.P.Q.2d 1087 (Fed. Cir. 2005):

Finding STEREOTAXIS merely descriptive in relation to (literally) a dozen goods and services including "Magnetic Navigation Systems for Medical Applications," and also finding that secondary meaning had *not* been proven, the PTO Examiner refused to approve the word and design mark for publication without a disclaimer of "stereotaxis." The T.T.A.B. affirmed this determination, noting that the subject term "immediately describes . . . significant information concerning the nature, purpose or function of at least some, if not most, of the applicant's goods." On further appeal, the Federal Circuit disposed of the argument that the Examiner and/or T.T.A.B. had a duty to identify the specific "good(s)" as to which the mark was "merely descriptive": "We know of no requirement in the trademark statutes or elsewhere that the Board must make the additional analysis the Applicant seeks in order to determine that a proposed mark is merely descriptive as applied to the Applicant's products and services."

3. **Frosty Treats, Inc. v. Sony Computer Entertainment America, Inc.,**
426 F.3d 1001, 75 U.S.P.Q.2d 1570 (8th Cir. 2005):

FROSTY TREATS was not viewed as inherently distinctive for ice cream truck services; indeed, the Eighth Circuit even implied that it might be "generic" for such services. And secondary meaning was not established, either, the court noting the small-sized, non-prominent, unadvertised display of the alleged mark amidst many graphics on Plaintiff's trucks' sides. But the court reversed a summary determination that Plaintiff's "Safety Clown" name and graphic was "functional" (in that it directed patrons to be careful when crossing the street to get to the truck). The court emphasized that "functional" is a legal term of art, reminding the trial court about a relevant U.S. Supreme Court (*TrafFix* 2001) definition of that term.

4. **Attrezzi, LLC v. Maytag Corp.,**
436 F.3d 32, 77 U.S.P.Q.2d 1641 (1st Cir. 2006):

Is the alleged mark ATTREZZI, translated from the Italian word as "tools," inherently distinctive as applied to a line of kitchen gadgets, appliances, etc.? According to the First Circuit, yes! "Attrezzi" means "tools," but *not* "chef's tools" or some such. Thus, as applied here, it qualifies as "suggestive" since "the term can easily be viewed as suggesting a similarity, not an identity, between ordinary workman's tools and electrical appliances or the like used by a chef." And Plaintiff was hoist by its own petard: it had argued to a PTO Examiner that ATTREZZI was suggestive rather than descriptive!

5. **Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove,**
419 F.3d 925, 75 U.S.P.Q.2d 1758 (9th Cir. 2005):

Senior user of YELLOW CAB -- for taxi services -- lost on summary judgment when it sued junior user of YELLOW CAB -- also for taxi services. However, the Ninth Circuit reversed/remanded, ruling that although the senior user's claim of protection for its unregistered mark required it to carry the burden of proving its protectability as a service mark, there was sufficient evidence in the record to create a triable factual issue. The Ninth Circuit's "who-are-you/what-are-you" test of genericness, from *Filipino Yellow Pages* (1999), was applied at this stage.

As for secondary meaning, record evidence also was sufficient to create a triable issue of fact. Here, the Ninth Circuit's *Levi Strauss/Blue Bell* case (1985) provided this applicable test:

(1) whether actual purchasers of the product bearing the claimed trademark associate the trademark with the producer; (2) the degree and manner of advertising under the claimed trademark; (3) the length and manner of use of the claimed trademark; and (4) whether use of the claimed trademark has been exclusive.

B. LIKELIHOOD OF CONFUSION/INFRINGEMENT

6. **Freedom Card, Inc. v. JPMorgan Chase & Co.,** 432 F.3d 463, 77 U.S.P.Q.2d 1515 (3d Cir. 2005):

FREEDOM (CARD) for a sub-prime (or sub-sub-prime) credit card marketed to bad-credit people versus CHASE FREEDOM for a gasoline rebate-related, major brand (MASTERCARD) credit card marketed to regular-risk people. Summary judgment for the junior user (CHASE FREEDOM proprietor) – affirmed. Evidence that the junior party had stopped its marketing almost immediately after receiving the senior party's objection certainly improved the junior party's position. That the senior party had stopped actively marketing (and issuing) a year earlier also favored the junior party. The facts that the proprietor of FREEDOM (CARD) had actively advocated the dilute nature of "freedom" in the financial services arena to the PTO and that it had entered into a consent agreement with the owner of the registration for FUEL FREEDOM CARD were very damaging to the senior user. When the district court deemed this situation worthy of "judicial estoppel," the appellate court sympathetically sidestepped:

Whether we view the district court's treatment of [senior party's] prior representations about the commercial availability of marks containing the word "freedom" as judicial estoppel, an admission, waiver, or simply hoisting [senior party] by its own petard, we agree with the district court's conclusion about the commercial impact of "freedom" in the two marks at issue here. Thus, [senior party's] own statements and actions, together with Chase's undisputed evidence of the widespread and common use of "freedom," undermine [senior party's] belated attempt to establish likelihood of confusion from the juxtaposition of "FREEDOM" and Chase's housemark.

The senior party castigated the junior party for running a trademark search and then going forward with CHASE FREEDOM anyway, but the Third Circuit was not persuaded that this was inappropriate or that it showed bad faith. Even the claim of attorney-client privilege with regard to the trademark search was not considered evidence of bad faith. Rather:

We are similarly unimpressed by evidence that Chase conducted a trademark search and presumably learned of [senior party's] registration of FREEDOM CARD. Absent [senior party's] own filings with the USPTO, it might be possible to claim that Chase's search and subsequent use of "FREEDOM" constituted carelessness at best. However, we have not yet adopted that standard for such an analysis, and we are certainly not willing to adopt it on this record. . . . However, given the undisputed evidence of how common the use of "freedom" has become in the relevant marketplace, even that requires an analytical stretch beyond the reach of a reasonable finder.

The tricky nature of "reverse confusion" was highlighted by the court:

We agree that the weakness of the senior user's mark can, in theory, advance a claim of reverse confusion rather than undermine it. The "lack of commercial strength of the smaller senior user's mark is to be given less weight in the analysis because it is the strength of the larger, junior user's mark which results in reverse confusion." . . . Nonetheless, "analysis of the strength of the senior user's mark is relevant" in a reverse confusion case.

7. **CareFirst of Maryland, Inc. v. First Care, P.C.,**
434 F.3d 263, 77 U.S.P.Q.2d 1577 (4th Cir. 2006):

An HMO associated with BlueCross BlueShield – and often touting its "incontestable" registered CAREFIRST services in direct connection with that famous word-mark duo – sued a small family practice medical group using FIRST CARE as its service mark. Summary judgment was granted for Defendant, and the Fourth Circuit affirmed, after *de novo* review. The appellate opinion contains these interesting comments on (a) collective membership marks, (b) incontestability, (c) strength of the plaintiff's mark, and (d) similarity of the parties' marks and goods/services:

- (a) [Plaintiff] argues that infringement of its collective membership mark only requires likelihood of confusion among its members. This suggestion is contrary to the rule that "[l]ikelihood of confusion of collective marks with other types of marks is determined according to the standard rules of trademark law." [McCarthy]. The cases cited by [Plaintiff] do not hold to the contrary. For example, [one case] merely states that the likelihood-of-confusion analysis for collective membership marks should not be limited to purchasers; it nowhere suggests that this analysis should be limited to members instead. Indeed, the decision notes that "relevant persons' would encompass all who might know of their services."
- (b) [Plaintiff] argues that its incontestable registration conclusively establishes the strength of its mark. That contention "confuses the issue of a trademark's validity with the separate inquiry into a mark's strength for purposes of the likelihood of confusion determination." . . . "[I]ncontestability alone does not establish that the trademark is strong and therefore likely to cause the consumer confusion necessary for a finding of trademark infringement." . . . Moreover, although the inquiry into whether a mark has secondary meaning sufficient to be protectible under the Lanham Act is similar to the commercial-strength inquiry . . . the two are analytically independent. Thus, like the plaintiff in *Petro* . . . although [Plaintiff] need not show secondary meaning, it still must demonstrate commercial strength. . . . ("Even where a trademark

is incontestable . . . the significance of its presumed strength will depend upon its recognition among members of the public.").

- (c) The designation of "CareFirst" as "suggestive" may or may not be correct, but this designation does not resolve the mark's conceptual strength. This is so because many third parties in the health care field have previously used in their own marks the text of the CareFirst mark. "[T]he frequency of prior use of [a mark's text] in other marks, particularly in the same field of merchandise or service," illustrates the mark's lack of conceptual strength.
- (d) In considering the appearance of a mark for purposes of the likelihood-of-confusion analysis, we must weigh more heavily the *predominant* manner in which the contemporary public perceives the mark:

The two marks at issue in this case are mirror images of one another; thus, the bare text of the two is similar. But because the likelihood-of-confusion analysis looks to the actual use of competing marks, a comparison of the texts of the two marks alone is insufficient if the marks have different appearances in the marketplace. . . . If one of two similar marks is commonly paired with other material, that pairing will serve to lessen any confusion that might otherwise be caused by the textual similarity between the two marks.

Because the marketplace provides the relevant forum for comparing services, there is no merit to CareFirst's claim that we should conduct this analysis using the services enumerated in CareFirst's federal registration.

8. **Malletier v. Burlington Coat Factory Warehouse Corp.,**
426 F.3d 532, 76 U.S.P.Q.2d 1852 (2d Cir. 2005):

Product design trade dress (and trademark logo) case involving handbags: Malletier's (i.e. Vuitton's) many hundreds to many thousands of dollars "originals" v. Burlington Coat Factory's \$29.98 "call-to-mind" products. Per the Second Circuit:

While a district court's simultaneous comparison of two products is not an inappropriate heuristic means of investigating similarities and differences in their respective designs on the way to an ultimate conclusion as to whether the products are likely to have similar impressions on consumers, district courts must be careful to maintain a focus on the ultimate issue of the likelihood of consumer confusion. As a result, the Lanham Act requires a court to analyze the similarity of the products in light of the way in which the marks are actually displayed in their purchasing context.

Whether simultaneous viewing by consumers is likely to result in confusion is not relevant when it is serial viewing that is at issue given the market context or the type of confusion claimed. In such a case, a district court must ask not whether differences are easily discernable on simultaneous viewing, but whether they are likely to be memorable enough to dispel confusion on serial viewing.

9. **Davis v. Walt Disney Co.,**
430 F.3d 901, 77 U.S.P.Q.2d 1309 (8th Cir. 2005):

EARTH PROTECTOR, registered for books, pamphlets, etc., about environmental protection and also used for television advocacy programs on that topic, was not infringed by the use of "Earth Protectors" as the name of a fictional company trying to take over the world in a Disney Channel movie. As to the unrelatedness of the parties' products, this was said:

We find that a movie designed for children's entertainment that airs on a national children's network is not so similar to an infrequently broadcast cable-access environmental advocacy television program that consumers are likely to believe the two products came from the same source.

Because the movie's depiction of the company using the mark is resoundingly negative, it is unlikely that viewers will assume that the real Earth Protector, Inc. was a sponsor of the movie or that Earth Protector, Inc. and Disney are otherwise affiliated.

10. **Attrezzi, LLC v. Maytag Corp.,**
436 F.3d 32, 77 U.S.P.Q.2d 1641 (1st. Cir. 2006):

In the ATTREZZI case, discussed earlier, the alleged confusion was only of the reverse variety. And Plaintiff already had experienced complaints aimed at Defendant's new ATTREZZI product, and feared that these would be held against Plaintiff. The court explained the relevant dangers this way:

[D]amage can result either because current or prospective customers of the claimant associate the claimant's product with an inferior product offered by the infringer, or because the latter's use of the mark "saturates the market and 'overwhelms the senior user,'" such that "the senior user loses the value of the trademark, its product identity, corporate identity, control over its goodwill and reputation, and ability to move into new markets." (quoting from Professor McCarthy's treatise).

And the court carefully considered the "good faith" (vel non) of the Defendant:

[A]lthough [Defendant] offered an innocent explanation for disregarding the initial advice of its in-house counsel, the jury seemingly concluded in its willfulness finding that [Defendant] was well aware of a substantial risk of confusion and nonetheless decided to gamble. On the other hand, there is some distance in a case like this one between a company's knowing decision to risk a law suit and a factual inference that customer confusion is likely.

Ultimately, the jury's pro-Plaintiff verdict was not seen as "irrational," the court adding: "Civil juries have their benefits and their risks. . . . [Defendant] will simply have to find another word than Attrezzi to couple to its Jenn-Air brand."

11. **M2 Software, Inc. v. M2 Communications, Inc.,**
450 F.3d 1378, 78 U.S.P.Q.2d 1944 (Fed. Cir. 2006):

The Federal Circuit completely agreed with the Board's determination that an opposition to M2 COMMUNICATIONS (latter word disclaimed), for CD-ROMs concerning pharmaceutical and/or medical matters, based on a registration of M2, for CD-ROMs concerning music and/or entertainment, warranted dismissal. While the parties' marks were "very similar," their goods were unrelated – regardless of the fact that they both took the form of CD-ROMs – and their channels of trade and purchasers were complete different. Specifically: "given the pervasiveness of software and software-related goods in society, it would be inappropriate to presume relatedness on the mere basis of goods being delivered in the same media format, especially where, as here, the goods described in both the application and registration are defined narrowly, along distinct industry lines."

C. **PERMISSIBLE USE OF ANOTHER'S MARK**

12. **Century 21 Real Estate Corp. v. LendingTree, Inc.,**
425 F.3d 211, 76 U.S.P.Q.2d 1769 (3d Cir. 2005):

In this hard-fought case – perhaps as hard-fought by the warring judges, two of whom ("the Majority") used about 17 pages to express their views, and one of whom ("the Dissenter") responded with about 19 pages of his own – the critical question, broadly stated, was what are the parameters, analytical approaches, and burdens of proof applicable to "nominative fair use" after the Supreme Court's opinion in *KP Permanent*? As the case was to be remanded for renewed proceedings – under the Majority's extremely long, and complex instructions – the facts are not worth detailing here. Suffice it to say that Defendant Internet-based financial institution used, without authorization, Plaintiff real estate broker franchisor's registered marks (such as CENTURY 21) in some of its advertisements, and Plaintiff strongly sought to stop such usage.

The Majority opinion commenced with references to "the fair use defense" and "the affirmative defense of fair use," the latter expressly based on *KP Permanent*. This opinion reads *KP Permanent* as signifying that "consumer confusion and fair use are not mutually exclusive. The latter will in essence rebut or excuse the former so that the use is permissible." This opinion proceeded to summarize, interpret, and heavily rely upon *New Kids on the Block* (9th Cir. 1992), in which the Ninth Circuit set forth a three-pronged test designed to replace that Circuit's standard likelihood of confusion ("*Sleekcraft*") analysis. However, the Majority rejected this replacement approach, because it "[did] not see nominative fair use as so different from classic fair use as to warrant such different treatment." Thus, the Majority insisted that likelihood of confusion be proven by a plaintiff, after which a defendant could try to prove a nominative fair use affirmative defense. Then it fashioned this standard for the latter:

Under our fairness test, a defendant must show: (1) that the use of plaintiff's mark is necessary to describe both the plaintiff's product or service and the defendant's product or service; (2) that the defendant uses only so much of the plaintiff's mark as is necessary to describe plaintiff's product; and (3) that the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products or services.

Trying to conform its analytic approach to its understanding of *KP Permanent*, the Majority espoused a reformulated likelihood of confusion (*Lapp* – 3d Cir. 1983) analysis retaining only four of the original 10 *Lapp* factors, and explained that this must be followed by its specially-formulated defense analysis, described, in part, this way:

Under our approach, the defendant has no duty to negate confusion as such, but rather must merely show that its use of the plaintiff's mark is fair, a burden which, by contrast, is not cumbersome. Thus, it is our view that the bifurcated approach is ultimately less burdensome to a nominative use defendant than the analysis the concurrence proposes.

The Dissenter, initially agreeing that likelihood of confusion must be proven by a plaintiff using relevant *Lapp* factors, agreed with little else in the Majority opinion. Then he launched an aggressive offensive, signaled by this strong statement:

Despite professing a "firm conviction" that the burden of proving likely confusion remains on plaintiffs, the majority formulates an affirmative defense that shifts to defendant the burden of negating confusion. In so doing, the majority flouts binding caselaw holding that proper nominative use is use that is not likely to confuse, and that a plaintiff alone bears the burden of establishing likely confusion. Moreover, to the extent the majority places any burden on plaintiffs at all, it is so watered-down that plaintiffs might prove likely confusion on one *Lapp* factor alone.

The majority's bifurcated test is also judicially unmanageable because it requires courts to address identical factors on both sides of the equation.

The mainstay of the Dissenter's argument is recognition that the two types of fair use – "classic" and "nominative" – have little in common, and, thus, that the Supreme Court's *KP Permanent* opinion, which dealt with a "classic" situation, applies only in part to "nominative" situations, such as the current case. Also, the Dissenter believes that the "collateral use" doctrine – espoused by the Supreme Court in the 1924 *Prestonettes* case and adopted by the Third Circuit in its 1983 *G.D. Searle* case – are the true talismans for the current case. Thus, in the Dissenter's view, these words from *G.D. Searle* still ring true today: [C]ollateral and truthful references to the trademark are permissible as long as the 'unauthorized' reference does *not cause confusion* as to the source of the product advertised." Specifically:

Like *Prestonettes*, *Searle* is a paradigm nominative use case. The mere fact that these decisions did not use the term "nominative use" when they were decided does not make them any less binding. Both cases make it clear that nominative use is nothing more than a likelihood of confusion inquiry, and neither places upon a defendant the burden of negating confusion or of putting forth an affirmative defense.

In short(!) the Dissenter believes that "nominative fair use" merely is part of a somewhat reformulated (8-factor) *Lapp* likelihood of confusion analysis: it is *not* an affirmative defense at all!

13. **International Stamp Art, Inc. v. U.S. Postal Service**,
72 P.T.C.J. 341, ___ F.3d ___, ___ U.S.P.Q.2d ___ (11th Cir. 2006):

Pursuant to a license from the U.S. Postal Service, Plaintiff reproduced many stamp designs in the form of greeting cards, etc. Plaintiff also obtained an "incontestable" registration for the perforated border design itself. When the license lapsed, the Postal Service started making/marketing some of its own stamp-design greeting cards. Where the Postal Service did not own the copyright in the underlying design, the Postal Service reproduced the entire stamp on the card – including the perforated border. The Postal Service also included its Eagle design trademark and other indicia of source on the backs of its cards.

When legal war broke out, the Postal Service mustered the "fair use" defense. The district court granted summary judgment for the Postal Service based on this defense, and the Eleventh Circuit, upon *de novo* review, agreed. In an opinion (remarkably) failing to mention – let alone cite – the statutory basis for federal "fair use" [Lanham Act § 33(b)(4)] the Eleventh Circuit, consistent with the sole point actually appealed, focused on the "good faith" element of this (affirmative) defense. Thus:

We have not yet established a legal standard for good faith for purposes of a fair-use defense in the context of trademark infringement. In addressing this question, other circuits have concluded that the standard for good faith for fair use is the same as the legal standard for good faith in any other trademark infringement context and that that standard asks whether the alleged infringer intended to trade on the good will of the trademark owner by creating confusion as to the source of the goods or services. ("In analyzing the proper scope of fair use good faith, precedents discussing good faith [as part of the standard trademark] likelihood of confusion analysis are relevant because the focus of the inquiry is the same, namely, whether defendant in adopting its mark intended to capitalize on plaintiff's good will.")

As to the burden of proof, this was stated:

[Plaintiff] argues that the burden ought to be on the Postal Service to show that it used the mark in good faith rather than upon [Plaintiff] to show bad faith. In the context of moving for summary judgment, the Postal Service must show that there is no genuine issue of material fact as to any element of the fair-use defense, including whether it used the perforated borders in its card designs in good faith. Accordingly, at this stage, the Postal Service already bears the burden, and we need venture no further into the burden analysis.

Finally, regarding the Postal Service's apparent failure to consult legal counsel:

[Plaintiff] also argues that the Postal Service failed to consult counsel prior to producing cards depicting its stamps. Although this factor may constitute evidence of bad faith under certain circumstances, in this case, because the Postal Service was entitled to use the perforated border descriptively, as part of the image of its products, that it might have done so "without consulting counsel has no tendency to show bad faith." [quoting *Car Freshener v. S.C. Johnson* (2d Cir. 1995), which also included this: "As [defendant] was fully entitled to use a pine-tree shape descriptively notwithstanding [plaintiff's] use of a tree shape as a mark, the fact that it did so without consulting counsel has no tendency to show bad faith.".] Accordingly, we conclude that this evidence, even taken in the light most favorable to [Plaintiff], does not weigh in its favor.

14. **Weight Watchers Int'l, Inc. v. Luigino's, Inc.**,
423 F.3d 137, 76 U.S.P.Q.2d 1361 (2d Cir. 2005):

Without mentioning "fair use" (or "nominative fair use" – or its previous appellation "collateral use"), the Second Circuit analyzed the appropriateness of Defendant's use of POINTS – Plaintiff's registered mark for a specially-calculated measure of fat and calories in a type/size of a particular food – in Defendant's unlicensed food product. The issue arose in the context of a request to modify an existing preliminary injunction, after Defendant had added the language "Points* As Calculated by Michelina's" loosely accompanied by a fine-print explanation acknowledging that the calculation had been done by Michelina's, and *not* by Plaintiff, the registered trademark owner of POINTS.

The Second Circuit took the district court to task for treating this scenario as a request for a new preliminary injunction, saying "Where, as here, an infringer attempts to avoid a substantial likelihood of consumer confusion by adding a disclaimer, it must establish the disclaimer's effectiveness." The court rejected Defendant's plea that the additional phrase did not amount to a disclaimer, just because it was positive in form – unlike typical disclaimers; rather, the court explained as follows: "This statement therefore acts, and is intended to act, as a disclaimer – a repudiation or denial that [Plaintiff] has calculated the point value on the package." And the court was circumspect in its appraisal of the additional phrase: "And while the disclaimer on the new packaging arguably dealt with the implicit claim that [Plaintiff] had calculated the point values, it did not address the issue of implicit endorsement."

D. TRADE DRESS

15. **In re Slokevage**,
441 F.3d 957, 78 U.S.P.Q.2d 1395 (Fed. Cir. 2006):

A composite trade dress mark, described by Applicant as a "configuration" and a "cut-away flap design" comprised of a label emblazoned with FLASH DARE! on a v-shaped background flanked by two connected cut-out areas (holes with flaps attached by closure devices) and shown positioned on the buttocks portion of various clothing items, was rejected by the Examiner and later by the T.T.A.B. as *non-inherently* distinctive "product design/configuration," lacking proof of secondary meaning. Indeed, Applicant, which previously had received a design patent for the cut-out area design, a Principal Registration for FLASH DARE!, and a Supplemental Registration for the cut-out area, declined to disclaim two unregistrable elements and declined to submit evidence of acquired distinctiveness. The Examiner (and later the T.T.A.B.) also determined that the "mark" in issue was *not* "unitary." Held, affirmed in full.

Preliminarily, the Federal Circuit decided, as "an issue of first impression," that the determination of whether a subject trade dress is "product design" or "package design" – critical under the Supreme Court's 2001 *Wal-Mart* case – is "factual" in nature, "akin to determining whether a trademark is inherently distinctive or whether a mark is descriptive, which are questions of fact . . . determined based on testimony, surveys, and other evidence as questions of fact." Thus, the court would "defer" to the Board's decision – provided that it was supported by "substantial evidence." Similarly, the court deemed whether a mark is "unitary" to be a factual question, suitable for Board determination.

On the merits, the Federal Circuit "agree[d] with the Board that [Applicant's] trade dress constitutes product design and therefore cannot be inherently distinctive." *Wal-Mart* was seen as instructive, not because it set standards for the two types of trade dress – which it did not do – but because it provided useful examples of product design trade dress – especially the penguin-shaped cocktail shaker said to be "product design." Accordingly, "[t]he holes and flaps portion are part of the design of the clothing – the cut-out area is not merely a design placed on top of the garment, but it is a design incorporated into the garment itself." Moreover: "The design at issue here can serve . . . utilitarian and aesthetic functions." The tie-breaker rule in *Wal-Mart*, i.e., that close cases are categorized as "product design," also was mentioned.

As for the "unitary" issue, the court concluded:

The display of elements in the drawing of the trade dress, the applicant's earlier registration of the words "FLASH DARE!" and the applicant's design patent on the cut-out area are evidence that [Applicant's] trade dress is not unitary.

16. **Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP**,
423 F.3d 539, 76 U.S.P.Q.2d 1372 (6th Cir. 2005),
cert. denied, 72 P.T.C.J. 160 (6/5/06):

Majority Opinion by Judge K.N. Moore (with Martin, J. on board):

Plaintiff (Gibson) has an incontestable status registration of a single-cut guitar shape, specifically, "a uniquely shaped configuration for the body portion of the guitar as illustrated in the drawing by the solid lines." [The drawing is very hard to decipher.] Defendant (PRS) recently brought its own single-cut guitar to market, and a combination trademark/trade dress case was filed – but the trade dress claims were "voluntarily dismissed by the parties." PRS now appeals from summary judgment for Gibson. *Held* (2-1), reversed for PRS, for whom summary judgment is to be entered.

The majority noted that PRS' guitar design "includes numerous source-indicating features" [specifying]. Then, in a section entitled "The Scope of the [Gibson] Trademark," the majority took "this opportunity to clarify a fundamental issue":

The district court appears to have confused *trademark law* and *trade-dress law* when it concluded that the [Gibson] Trademark covered the entire guitar, rather than the two-dimensional silhouette included in the registration papers . . . This affected the remainder of the district court's reasoning and prevented proper analysis of the parties' claims. [W]e do not believe that the two-dimensional drawing included in the [Gibson] Trademark should be construed to create a trademark on the entire guitar as depicted in photographs accompanying the trademark application (including the location and style of knobs, switches, and other hardware).

The majority noted that the district court's *Frisch's* (6th Cir. 1982) factor analysis had found that all factors other than "actual confusion" favored Gibson; the district court went on to note that while the total lack of point-of-sale confusion evidence favored PRS, the "instant market recognition" of Gibson's shape and the "striking similarity" of the parties' two shapes created "initial confusion" that made this factor favor Gibson. The Sixth Circuit majority, however, completely rejected this approach, finding no viable basis for "confusion": Gibson had conceded that no point-of-sale confusion existed, and the majority rejected the applicability of initial interest confusion. The latter required the majority to revisit the Sixth Circuit's 2003 *PACCAR* decision, in which the court apparently had embraced "initial interest confusion." Now saying that *PACCAR* "did not rest on initial-interest confusion," the majority prefers to rely on more traditional principles of consumer confusion. This despite quoting some rather direct *PACCAR* language expressly embracing initial interest confusion. Now, the majority seeks to limit its *PACCAR* language/holding to Internet domain name situations, specifically treating applications of that doctrine extra-Internet as "an issue of first impression in our circuit," especially as applied to "a trademark on a product's shape." As to this possible application, the majority explained:

The potential ramifications of applying this judicially created doctrine to product-shape trademarks are different from the ramifications of applying the doctrine to trademarks on a product's name, a company's name, or a company's logo. . . . Specifically, there are only a limited number of shapes in which many products can be made. A product may have a shape which is neither functional nor generic (and hence which can be trademarked) but nonetheless is still likely to resemble a competing product when viewed from the far end of a store aisle. Thus, many legitimately competing product shapes are likely to create some initial interest in the competing product due to the competing product's resemblance to the better-known product when viewed from afar. In other words, application of the initial-interest-confusion doctrine to product shapes would allow trademark holders to protect not only the actual product shapes they have trademarked, but also a "penumbra" of more or less similar shapes that would not otherwise qualify for trademark protection.

The majority then explained its concern from a practical, *procedural* perspective:

[O]ur concerns about the effect of extending the initial-interest-confusion doctrine to product-shape trademarks are particularly relevant in the summary-judgment context. To the extent we allow it to do so, evidence of initial-interest-confusion comes into the eight-factor *Frisch* test as a substitute for evidence of actual confusion. If our belief that *nearly all* product-shape trademark-holders will be able to show an issue of fact as to whether a competing product creates initial-interest confusion is correct, application of the initial-interest-confusion doctrine in the product-shape context would make it substantially easier for product-shape trademark-holders to survive a defendant's summary-judgment motion than for plaintiffs alleging any other type of trademark infringement. . . . Given severe anti-competitive effects such a decision could have, we do not believe it is appropriate to extend the initial-interest-confusion doctrine in this manner.

But then the majority left the proverbial door slightly ajar: "Given the limited fact situation we have before us, we do *not* go so far as to hold that there is *never* a circumstance in which it would be appropriate to apply the initial-interest-confusion doctrine to a product-shape trademark."

Finally, the majority expressly reiterated its rejection of confusing similarity based on how a product might look on a far wall in a retail store: "Where product shapes are trademarked, such a theory would prevent competitors from producing even *dissimilar* products which might appear . . . somewhat similar to a trademarked shape."

Concurring/Dissenting Opinion (by Kennedy, J.):

Judge Kennedy concurred with the majority as to its reversal of summary judgment for Gibson, as to point-of-sale confusion (and as to post-sale confusion). However, she dissented with regard to initial interest confusion, as to which she believes that it is appropriate to remand the case to allow Gibson to try to prove its case factually. Her opinion explains the following things:

1. *PACCAR* "recognized initial-interest confusion as an infringement under the Lanham Act." There was nothing in *PACCAR* that limited its holding to Internet domain name disputes. The majority is wrong in excluding its application to product shape trademarks:

Since a product shape can serve as a trademark, and since initial interest confusion is a recognized theory of relief generally for trademark infringements, I believe that a product shape trademark holder whose product shape does in fact identify the product's source should not be precluded from presenting evidence that a competitor's product shape causes consumers to be attracted to it because of its similarity to a trademark holder's mark.

2. If the initial interest confusion doctrine were not applicable to product shape trademarks, I believe that product shape trademark holders would be put to a significant disadvantage compared to non-product shape trademark holders since this type of confusion is likely the only type of confusion that could arise with product shapes. It will be the rare case for there to exist a likelihood of confusion with respect to product shape trademarks at the point of sale since any confusion created by a product's similar shape will be dispelled at the point of sale, as most products will have a distinguishing feature that is identifiable from this vantage point, such as its producer's name. Thus, if initial interest confusion were not a viable theory upon which a product shape trademark holder could proceed, a product shape trademark holder may be quite limited, if not foreclosed, from successfully prosecuting a trademark infringement claim.

17. **General Motors Corp. v. Keystone Automotive Indus., Inc,**
453 F.3d 351, 79 U.S.P.Q.2d 1456 (6th Cir. 2006):

Mentioning the term "knockoff(s)" no fewer than 11 times in its 8-page slip opinion, the Sixth Circuit provided a detailed second look (after its classic 1991 "Ferrari Daytona Spyder" case) at post-sale (now dubbed "downstream") confusion in the context of product design trade dress – here (but not in the *Ferrari* case) combined with "genuine" trademark logos. In short, Defendant made virtually identical copies of authentic Chevrolet "Bow-Tie" and GMC grilles, with appropriately shaped "placeholders" (shaped to receive plastic logos) to which genuine GM plastic logos ultimately were actually affixed. These products were sold to repair shops and individuals in ways expressly and clearly indicating their actual origin (Defendants) and denying any connection to Plaintiff. As in *Ferrari*, no point-of-sale purchaser with any brain cells at all could have been "confused." ("[T]he transparent and conspicuous indications that [Defendant] manufactured its grilles make confusion at the point of sale all but impossible.") So, the whole case came down to likelihood of post-sale ("downstream") confusion regarding the visibility of the "allegedly infringing portions of the grilles," i.e., of the placeholders.*

Defendant prevailed on summary judgment below, but the Sixth Circuit, reviewing *de novo* and according all reasonable inferences to the non-moving party, reversed and remanded. After quickly disposing of the point-of-sale claim – noting along the way that "customers knowing they are purchasing a knockoff designer purse or Rolex watch simply do not confuse the counterfeit with the original" – the court broached the post-sale claim from this premise: "The injection of knockoffs into the stream of commerce may lead to a likelihood of confusion among the general public."

* The court noted that Defendant had stopped using logo-shaped placeholders after the suit was filed and that these changes apparently decreased demand for Defendant's grilles. But the court did not say whether these changes had any effect on its analysis.

The classic *Frisch's Restaurant* (6th Cir. 1982) factor analysis was employed. The great strength of the Bow-Tie and GMC marks gave Plaintiff a quick start. The parties' goods were considered "at least somewhat closely related . . . identical . . . [but] generally not directly competitive because . . . 'the parties generally sell their goods to different buyers'." So, this, too, favored Plaintiff. And: "The trademarks at issue are virtually identical apparently with only trivial differences." Again, pro-Plaintiff.

Evidence of actual confusion – "the most important factor in assessing likelihood of confusion" but hard to adduce – was not adduced here. The court gave no indication as to how this affected the overall calculus. Marketing channels and degree of purchaser care were set aside as basically irrelevant to post-sale situations of this type. Defendant's intent, here characterized as "intentional copying" – not affected in any way by Defendant's post-Complaint deletion of the Bow-Tie and GMC shaped placeholder portions – was viewed as favoring Plaintiff. Likelihood of product line expansion was found to favor Defendants, because "neither party plans to expand its grille manufacturing business."

All this said, the court, expressly recognizing that the *Frisch's* analysis "is arguably less important in assessing downstream confusion than point-of-sale confusion since two of the factors . . . focus on point of sale," concluded that Plaintiff was in the preferred position here because four factors favored it and only two favored Defendant. The Sixth Circuit's philosophy can be inferred from its explanation of "cases discussing the harm of injecting knockoffs into the stream of commerce [which] further signals the likelihood of downstream confusion in this case":

Even without point-of-sale confusion, knockoffs can harm the public and the original manufacturer in a number of ways, including: (1) the viewing public, as well as subsequent purchasers, may be deceived if expertise is required to distinguish the original from the counterfeit . . . (2) the purchaser of an original may be harmed if the widespread existence of knockoffs decreases the original's value by making the previously scarce commonplace . . . (3) consumers desiring high quality products may be harmed if the original manufacturer decreases its investment in quality in order to compete more economically with less expensive knockoffs . . . (4) the original manufacturer's reputation for quality may be damaged if individuals mistake an inferior counterfeit for the original . . . (5) the original manufacturer's reputation for rarity may be harmed by the influx of knockoffs onto the market . . . and (6) the original manufacturer may be harmed if sales decline due to the public's fear that what they are purchasing may not be the original . . . On the other hand, courts should be wary of overprotecting public domain ideas and works whose exploitation can lead to economic efficiency, greater competition, and lower costs for consumers.

Factually, the current case came down to the visibility – hotly disputed by the Plaintiff and both Defendants (manufacturer, distributor) of the placeholder shapes by the public after the (authentic) Bow-Tie and GMC logos had been installed and the vehicles had been driven in public places. In the court's own words, "If the placeholders cannot be seen after the Chevrolet 'bow-tie' or 'GMC' emblem is affixed, the wholly hidden placeholder cannot cause downstream confusion as to origin or sponsorship. After all, that which defies perception cannot confuse."

18. **Woodland Furniture v. Larsen**,
2005 Ida LEXIS 167, 124 P.3d 1016 (Idaho 2005):

In an infrequent state-court handling of a Section 43(a) product design trade dress case, the Idaho Supreme Court refused to stop close copying of old-look but actually new furniture (arguably aggravated by catalog picture copying, occasional uses of Plaintiff's products' names and/or catalog numbers). The main shortcomings of Plaintiff's case were lack of adequate identification of the specific design elements comprising its claimed trade dress and the functionality of its design elements. As to the former, the court relied on *Yurman Design* (2d Cir. 2001), concluding that Plaintiff's claims were "overbroad as a matter of law." As to the latter, the court found that the "overall effect of [Plaintiff's] claimed trade dress is functional."

E. MONETARY REMEDIES

19. **Western Diversified Services, Inc. v. Hyundai Motor America, Inc.**,
427 F.3d 1269, 77 U.S.P.Q.2d 1132 (10th Cir. 2005):

With quite a bit of careful contemplation, the Tenth Circuit took the following fairly circumscribed position on the award of profits and attorney fees:

We hold that the willfulness required to support an award of profits under the Lanham Act typically requires an intent to appropriate the goodwill of another's mark. For the willful component of an award of attorney fees, we adopt the same definition of willful.

Along the way, the court explained:

An award of profits in the absence of actual damages is usually predicated on one of two theories: (1) unjust enrichment; or (2) deterrence. . . . The unjust enrichment theory is based on the idea that trademarks are protected property rights. . . . The misappropriation of that right, thus, results in an unjust enrichment even if the two parties are not in direct competition with each other. . . . Similarly the deterrence theory recognizes that an award of profits may be proper as a means to prevent willful trademark infringement.

Expressly acknowledging that the existence of actual damages, while not essential to the award of profits, still is "relevant to our inquiry," the court cautioned:

Given the punitive nature of the remedy and the possible windfall to the plaintiff, the potential for inequity is necessarily heightened when a party seeks a profit award in the absence of actual damages. To that end, we require a showing that Defendant's actions were willful to support an award of profits under 15 U.S.C. § 1117(a).

The court emphasized the discretionary nature of profits ascertainment (yes/no; amount) and explained that a two-step process – determination of willfulness or bad faith, followed by "a weighing of the equities" – was called for. (At the summary judgment stage, however, only the first step was appropriate.) Defining "willfulness" is critical, and the court set forth this standard:

We . . . hold that to support an award of profits under the Lanham Act in the absence of actual damages, a plaintiff must ordinarily show that the defendant intended to benefit from the goodwill or reputation of the trademark holder. Our decision is rooted in a recognition that an award of profits under the Lanham Act is truly an extraordinary remedy and should be tightly cabined by principles of equity. It is also for this reason that we do not adopt the more lenient approaches taken by some of our sister circuits.

But, by dicta, the door was left open to other possibilities!

20. **Gnesys, Inc. v. Greene,**
437 F.3d 482, 77 U.S.P.Q.2d 1299 (6th Cir. 2005):

The Sixth Circuit showed no reluctance in applying the "exceptional circumstances [*sic*: cases]" provision in Lanham Act § 35(a) as the basis for an attorney's fee award for conduct viewed as violative of that part of Lanham Act § 43(a) that (somewhat inaccurately) proscribes a "false description or representation." Direct reliance was placed on the Supreme Court's 2003 *Dastar* decision, which stated, *inter alia*, that § 43(a) "is one of the few provisions [of the Lanham Act] that goes beyond trademark protection."

21. **State of Idaho Potato Comm. v. G & T Terminal Pkg.,**
425 F.3d 708, 76 U.S.P.Q.2d 1835 (9th Cir. 2005):

A second issue in the IDAHO POTATO case, earlier summarized, was whether the former licensee's purchase, filling, and use of bags displaying the licensor's certification mark constituted not just "infringement" but actually "counterfeiting" – compensable as "statutory damages" under Lanham Act § 35(c). With careful factual analysis, the court concluded that this conduct did, indeed, qualify as "counterfeiting," and that "statutory damages" were, indeed, appropriate.

F. PROCEDURAL ISSUES

22. **Test Masters Educational Services, Inc. v. Singh,** 428 F.3d 559, 76 U.S.P.Q.2d 1865 (5th Cir. 2005):

It took over 15 pages of text in the *Federal Reporter* for the Fifth Circuit to state, untangle, and explicate a number of tough procedural issues. This occurred in a long-running case that an earlier court had dubbed "the second coming of the Hatfields versus the McCoys"! [My] life is too short to summarize the entire opinion, but here are *some* of its salient parts. First, generally:

The rule of res judicata encompasses two separate but linked preclusive doctrines: (1) true res judicata or claim preclusion and (2) collateral estoppel or issue preclusion.

If a party can only win the suit by convincing the court that the prior judgment was in error, the second suit is barred.

And now specifically:

The issue of whether res judicata bars re-litigating the issue of secondary meaning here is a difficult one. There are no cases which expressly demarcate a minimum time that must elapse before a defendant can re-litigate the issue of secondary meaning. . . . [W]e sympathize with the district court's assertion that public policy should counsel in favor of barring further litigation related to the . . . mark because of the onerous burden placed on the court and the parties in constantly re-litigating this matter.

We are not holding that a number of decades must pass before the issue of secondary meaning for a particular mark may be re-litigated or that the intervening factual change has to be something as significant as the proliferation of commercial flight. The case law has not developed, and we do not today decide, precise time contours for the re-litigation of secondary meaning. The determination of whether a mark has secondary meaning depends on dynamic factual scenarios that will necessarily vary from case to case. The thrust of our holding is that [Plaintiff] has not alleged in his pleadings any significant intervening factual change. [Plaintiff's] evidence of "dramatic" growth in his business and "skyrocket[ing]" revenues is not sufficient to justify re-litigation of the issue of secondary meaning in his mark.

23. **Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.,**
424 F.3d 1229, 76 U.S.P.Q.2d 1310 (Fed. Cir. 2005):

The Federal Circuit court carefully considered whether the summary judgment dismissal of an Opposition on the basis of res judicata (claim preclusion) and collateral-estoppel (issue preclusion) based on a 5-year earlier civil infringement judgment regarding use of the same mark by the same parties was justified. Distinguishing "registration" issues from "use" issues, and noting that the likelihood of confusion analysis in those two contexts only "presents a 'superficial similarity'," the court reversed the dismissal, explaining and concluding:

In a trademark infringement action, the owner of a registered mark sues for relief from the injury caused by the defendant's actual sale, offering for sale, or advertising of goods or services bearing the challenged mark, whereas an opposition to registration is based on the content of the registration application. Although to succeed in an opposition proceeding the opposer must show that "he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c) ...", 15 U.S.C. § 1063, the opposer need not show actual injury, and is benefitted by prior registration and prior use. These different causes of action may involve different sets of transactional facts, different proofs, different burdens, and different public policies. Registrability is not at issue in infringement litigation, and although the likelihood of confusion analysis presents a "superficial similarity," differences in transactional facts will generally avoid preclusion.

Caution is warranted in the application of preclusion by the PTO, for the purposes of administrative trademark procedures include protecting both the consuming public and the purveyors. Thus the party objecting to a registration may raise grounds not only of commercial injury to itself, but of confusion or deception or mistake to the consumer. The public policy underlying the principles of preclusion, whereby potentially meritorious claims may be barred from judicial scrutiny, has led courts to hold that the circumstances for preclusion "must be certain to every intent."

24. **Natural Organics, Inc. v. Nutraceutical Corp.,**
426 F.3d 576, ____ U.S.P.Q.2d ____ (2d Cir. 2005):

In the course of comparing the confusability of two packaging trade dresses (for competing products branded SPIRU-TEIN and SOYTEIN, respectively), the district court did not detail – or even discuss – each and every *Polaroid* factor. This was error, per the Second Circuit. Perhaps of greater interest was the split-bench situation as to whether this problem was reviewable on appeal without having been the subject of an FRCP 52(b) motion for additional factual findings below. One appellate judge commented that allowing the appeal without the possibly preceding motion made it "very probable that the appellant in this case has enlisted the help of this Court in pushing an open door." This judge then

noted: "Timely Rule 52(b) motions would reduce the risk that district courts are unnecessarily required on remand to remember their assessments of *Polaroid* factors months or years after the record was made." But the other *two* judges thought otherwise: "To the extent . . . that parties have actually litigated a factual dispute and a party submitted a request for the factual finding, the omission of the finding is likely a conscious decision by the district judge that the finding is not necessary to the outcome."

25. **Alpha Kappa Alpha Sorority Inc. v. Converse Inc.,**
___ F.3d ___, ___ U.S.P.Q.2d ___ (5th Cir. 2006):

Converse, of sneaker/shoe fame, designed and sold a line of "Greekpak Weapon" basketball shoes featuring six sets of two-color combinations accompanied by the "founding" dates of certain African-American sororities and fraternities. Relevant advertising encouraged prospective buyers to seek "Greek affiliation" for the purpose of "representation." The trial court granted Converse's § 12(b)(6) motion to dismiss, but the appellate court reversed, explaining:

As is evident from . . . the plaintiffs' complaint, the plaintiffs have, indeed, identified the elements (the color and year combinations) comprising their trademarks or trade dress; they have claimed that the color and year combinations are trademarks or trade dress; and they have asserted that Converse infringed upon their trademarks or trade dress in promoting and selling its GREEKPAK shoes. Thus, under the liberal notice pleading standards articulated in Federal Rule of Civil Procedure 8, we conclude that the complaint adequately apprised Converse of the cause of action under section 43(a) of the Lanham Act.

26. **Weight Watchers Int'l, Inc. v. Luigino's, Inc.,**
423 F.3d 137, 76 U.S.P.Q.2d 1361 (2d Cir. 2005):

In the POINTS case, earlier discussed, the Second Circuit – for over a decade known for being very restrictive about how long a plaintiff can wait before moving for preliminary injunctive relief without undercutting its claim of "irreparability" – explained its somewhat softer approach in this case thusly:

We have found delays of as little as ten weeks sufficient to defeat the presumption of irreparable harm that is essential to the issuance of a preliminary injunction. . . . By contrast, we have held that a short delay does not rebut the presumption where there is a good reason for it, as when a plaintiff is not certain of the infringing activity or has taken additional time to examine the infringing product. . . . While [Plaintiff] did not act as promptly as it could have, the delay here, in all the circumstances, does not require denial of the modification it seeks.

G. INTERNET ISSUES

27. **Australian Gold, Inc. v. Hatfield,**
436 F.3d 1228, 77 U.S.P.Q.2d 1968 (10th Cir. 2006):

In a case involving multiple substantive issues plus a significant jurisdictional issue, the Tenth Circuit contemplated alleged trademark infringement resulting from the unauthorized purchase and resale (over the Internet) of Plaintiff's salon-only AUSTRALIAN GOLD and CARIBBEAN GOLD tanning lotion products. Defendants' attempted reliance on the "first sale" doctrine was roundly rejected.

The main thrust of the infringement case was "initial interest confusion," about which this was said:

Even if the consumer eventually becomes aware of the source's actual identity, or where no actual sale results, there is nonetheless damage to the trademark. This damage can manifest itself in three ways: (1) the original diversion of the prospective customer's interest to a source that he or she erroneously believes is authorized; (2) the potential consequent effect of that diversion on the customer's ultimate decision whether to purchase caused by an erroneous impression that two sources of a product may be associated; and (3) the initial credibility that the would-be buyer may accord to the infringer's products—customer consideration that otherwise may be unwarranted and that may be built on the strength of the protected mark, reputation and goodwill.

Defendants' manifold uses of Plaintiffs' trademarks on the formers' websites – and in its metatags and in its sponsored preferred-position placements – "were attempts to direct trade to Defendants' Websites . . . by which Defendants used the goodwill associated with Plaintiffs' trademarks in such a way that consumers might be lured to the lotions from Plaintiffs' competitors." As such, the Lanham Act was violated. And the "first sale" doctrine could not come to Defendants' rescue:

[T]he first sale doctrine does not protect resellers who use other entities' trademarks to give the impression that they are favored or authorized dealers for a product when in fact they are not. . . . Thus, Defendants' actions were indicative of an intent to cause consumer confusion, and are not shielded by the first sale doctrine.

28. **Pebble Beach Co. v. Caddy**,
72 P.T.C.J. 342, ____ F.3d ____, ____ U.S.P.Q.2d ____ (9th Cir. 2006):

Michael Caddy – a British pub owner/operator, not a golfer or a "caddy" – was sued by the proprietor of the famous California PEBBLE BEACH golf course for having a non-interactive website at www.pebblebeach-uk.com. The district court dismissed the case as lacking personal jurisdiction, and the Ninth Circuit affirmed. The "something more" needed to show "purposeful availment" or "purposeful direction" toward California (or the United States generally) was absent. Thus, neither the California long-arm statute nor federal long-arm jurisdiction under F.R.C.P. 4(k)(2) was applicable.

H. LICENSING

29. **State of Idaho Potato Comm. v. G & T Terminal Pkg.**,
425 F.3d 708, 76 U.S.P.Q.2d 1835 (9th Cir. 2005):

A certification mark's license contract, containing a clause prohibiting the licensee from challenging the validity of the licensed mark – both during and after expiration of the license – caused the Ninth Circuit to consider the applicability of the Supreme Court's 1969 *Lear v. Adkins* patent licensee estoppel doctrine to certification mark licenses. The Ninth Circuit first explained some of the critical differences between trademarks *per se* and certification marks:

Trademark owners have a monopoly over their marks, which they can license as they see fit as long as such licensing does not cause public confusion. A certification mark, on the other hand, is a mark used by someone other than its owner to signify that a product or service has a certain characteristic. The certification mark owner is required to license the mark to anyone who meets the certification criteria.

[T]he distinction between certification marks and trademarks reflects different underlying public interests. While certification marks resemble trademarks in that they attempt to prevent consumer confusion by communicating information regarding a product's characteristics, certification marks also have another purpose. [A relevant case] reasoned that certification marks protect "a further public interest in free and open competition among producers and distributors of the certified product." This is achieved by protecting certification mark licenses from the certification mark owner's influence in an attempt to ensure the broadest possible competition in the market for certified goods. . . .

Analyzing the relationship between certification marks and *Lear*-based policies, the court concluded that *Lear* was applicable to certification marks:

The Lanham Act makes clear that certification marks serve other public interests in addition to the prevention of public confusion. Its certification mark cancellation provisions illustrate the legislative intent to protect "a further public interest in free and open competition among producers and distributors of the certified product." . . . By requiring certification mark holders to license all individuals who meet the certification criteria, the Lanham Act ensures that the market will include as many participants as can produce conforming goods. By preventing mark holders from becoming market participants, it removes incentives for mark holders to engage in anti-competitive conduct. The Lanham Act's cancellation provisions thus appear designed to promote free competition in the market for certified products.

30. Miller v. Glenn Miller Productions,
72 P.T.C.J. 345, ___ F.3d ___, ___ U.S.P.Q.2d ___ (9th Cir. 2006):

Adopting almost all of the district judge's lengthy, detailed opinion as its own, the Ninth Circuit emphatically held that trademark licensees are *not* entitled to issue sub-licenses—unless they have received express consent from their licensors. This was a reasoned extension of a similar rule it previously had established for copyright and patent license situations. While expressly acknowledging the "fundamental differences" between patent/copyright laws and trademark laws, the court explained their conflation in the licensing context, as follows:

[D]espite these differences, copyright and trademark licensors share a common retained interest in the ownership of their intellectual property — an interest that would be severely diminished if a licensee were allowed to sub-license without the licensor's express permission. For these reasons, the Court finds that the policies underlying the sub-licensing rule in patent and copyright law apply with equal force to trademark law.

The court carefully laid out the reasons for assuring that trademark licensees were not permitted, without licensors' express consent, to issue sub-licenses:

Licensors who fail to meet this [quality control] obligation may lose their right to enforce the trademark license. Common sense suggests that if a trademark licensee could unilaterally sub-license a mark without notifying or obtaining consent from the licensor, then a trademark licensor would lose his ability to police his mark, thereby becoming estopped from enforcing his ownership rights vis-a-vis the licensee. Such a result is illogical, undesirable, and at odds with the nature of intellectual property rights. Moreover, if a trademark licensor could not control the capacity of a licensee to sublicense its mark, then disputes about the suitability of a potential sub-licensee or about whether a sub-licensee is acting within the scope of the original license would trigger litigation.

I. MISCELLANEOUS

31. **Attrezzi, LLC v. Maytag Corp.**,
436 F.3d 32, 77 U.S.P.Q.2d 1641 (1st. Cir. 2006):

In the *Attrezzi* case, earlier discussed, Defendant major national manufacturer of various appliances – certainly including kitchen appliances – first balked at adopting ATTREZZI for use with its JENN-AIR brand; this was caused by an in-house trademark attorney's concerns about Plaintiff's prior use of ATTREZZI. After being asked to reconsider, the in-house attorney changed his mind and filed an ITU application with the PTO. Shortly thereafter, Defendant began to promote its coming JENN-AIR ATTREZZI line. Some months – and maneuvers – later, the lawsuit was filed, and after a trial, the jury came in with a verdict of willful infringement, damages (doubled by the judge), and attorney's fees. The judge did allow Defendant a 12-month sell-off period. In the post-trial phase, the judge said that he, personally, would not have "found" likelihood of confusion. Whereupon, Defendant pressed its challenge to Plaintiff's right to trial by jury, arguing that the only "damages" claimed by Plaintiff was its cost in "opposing" Defendant's trademark application in the PTO. The First Circuit held that jury trial was, indeed, appropriate:

It is true as a general matter that a patently unnecessary expense would be avoidable damage and so not collectible. . . . [Defendant] argues that the opposition was unnecessary because the district court could have granted injunctive relief. However, fearing the repercussions of a PTO grant for the infringement claim in district court, a competent lawyer could sensibly oppose [Defendant's] PTO application. It is a matter of reasonable judgment whether the precaution was legitimate; nothing indicates that [Plaintiff's] choice was unreasonable.

32. **American Assn. of Orthodontists v. Yellow Book USA, Inc.**,
434 F.3d 1100, ____ U.S.P.Q.2d ____ (8th Cir. 2006):

Does a national association of orthodontists have "standing" under Lanham Act § 43(a) to sue a yellow page directory publisher for (allegedly improperly) listing "general dentists," i.e., those *not* certified as having specific training in orthodontia, under headings such as "Dentists-Orthodontists," and if so; can the complaint withstand an F.R.C.P. § 12(b)(6) attack? Per the Eighth Circuit: no, and no again!

"Standing" was analyzed both as a constitutional (Article 3) and as a "prudential" matter. The court viewed § 43(a)(1)(A) as a "false endorsement" provision, and concluded that an injunction against the yellow pages publisher would not stem (potential) public confusion about whether the orthodontists' association or its members had endorsed the general dentists listed under "Dentists-Orthodontists." Also, under "prudential standing considerations," the court found the Lanham Act § 43(a)(1)(B) "false advertising" claim ineffective because defendant was not a "competitor" of either the orthodontists' association or its members.

In addition, the court preferred to let such matters be handled by a state regulatory agency. This dovetailed with the court's conclusion that the § 12(b)(6) motion had been granted correctly:

Absent a specific state law prohibition against general dentists holding themselves out as orthodontists, the legal determination that any particular dentist is guilty of *false* advertising by requesting inclusion in the Yellow Book listings for orthodontists requires a detailed analysis of that dentist's qualifications and experience. As no general dentist is before the court, the injunctive relief requested by [the orthodontists' association] "in gross" may not be granted.

Query: Would joinder of an individual association member have avoided this defect?

33. Doeblers' Penn. Hybrids, Inc. v. Doeblner, III,
442 F.3d 812, 78 U.S.P.Q.2d 1509 (3d Cir. 2006):

This case is as valuable for its scene-setting and "a word to the wise" prefatory remarks as it is for its treatment of issues of assignment, abandonment, etc. Here are the paragraphs that are especially instructive:

Even the closest of families may battle, but when such a feud occurs against the backdrop of family businesses – here, dueling companies that trace their ancestry to one defendant's grandfather – the stakes include critical business assets.

This case demonstrates what may happen when trademark ownership is not explicitly spelled out between a group of related and apparently closely-held companies that use the same name in concert. When things go well, everyone happily uses the name together, but when things go sour, a dispute may arise over a critical business asset: the name. Indeed, the scenario at hand – a family surname used by family companies with a high degree of overlapping ownership and management – is ripe with potential for this very kind of dispute.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA
COMPANY,

Opposer

v.

BARILLA G. E. R. FRATELLI - SOCIETA
PER AZIONI,

Applicant.

Opposition No. 91-161,373

CERTIFICATE OF KENNETH B. GERMAIN

Pursuant to the stipulated protective agreement between the parties in the above identified proceeding filed February 7, 2005 at the Trademark Trial and Appeal Board, I hereby certify that I have read that protective agreement and the March 3, 2005 order of the Board, I understand its terms and I shall be bound by those terms.

I am a partner in Thompson Hine LLP and lead the firm's Intellectual Property practice in the Cincinnati office. The focus of my practice is on trademark counseling, consulting, and litigation. I am frequently retained as an expert witness on issues relating to trademarks and unfair competition, often working on cases involving cutting-edge issues.

I am an active speaker on trademarks and unfair competition, having delivered over 190 lectures. In addition, I am founder and continuing chairman of the All Ohio Annual Institute On Intellectual Property seminar that recently held its 16th statewide program.

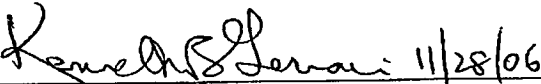
In 2001, I was chosen as a charter member of the Advisory Council for the

prestigious J. Thomas McCarthy Institute for Intellectual Property and Technology Law. The Institute was created to honor Professor McCarthy, who is recognized as the world's leading scholar on U.S. trademark law. I am one of the Institute's 23 council members chosen worldwide from the intellectual property disciplines of patents, copyrights, trademarks and unfair competition.

Prior to joining Thompson Hine, I was a partner at Frost Brown Todd LLC (formerly Frost & Jacobs LLP) from 1989-2002. During 1987-1988, I was Of Counsel to the Washington, D.C. intellectual property firm Banner, Birch, McKie & Beckett (now Banner & Witcoff). Earlier, I was a full time law professor whose major research area was Trademarks and Unfair Competition.

I am admitted to practice in Ohio, California, and the District of Columbia (inactive in California and the District of Columbia). My business address is Thompson Hine LLP, 312 Walnut Street, 14th Floor, Cincinnati, Ohio.

November 28, 2006


Kenneth B. Germain

CERTIFICATE OF SERVICE

I hereby certify that on the 28th day of November, 2006, I served the foregoing
CERTIFICATE OF KENNETH B. GERMAIN by certified mail, postage prepaid and
return receipt requested, to the following:

Thomas H. Van Hoozer, Esq.
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108

American Italian Pasta Company
-vs-
Barilla Alimentare S.P.A.
Opposition No. 91161373
Applicant Exhibit# 13

Opposition No. 91-161,373

American Italian Pasta v. Barilla
Opposition No. 91/161,373
Applicant Deposition Exh. 13 Page 1 of 38

(b) Through the years, I often have served in an expert witness capacity in civil cases involving a wide variety of issues relating to the selection, adoption, use, registration, maintenance, and infringement of trade designations of all kinds. I was the defendant's legal expert witness in the *TrafFix* case that went to the U.S. Supreme Court, but I was not called to testify because the case was resolved on summary judgment at the trial court level. I also have served as a consultant to counsel engaged in cutting-edge issues, including the U.S. Supreme Court's 2003 *Victoria's Secret* case.

(c) My credentials are to some extent detailed in my resume, a copy of which is attached to this Report as **Exhibit 1**. To summarize: I graduated from law school over 30 years ago. After spending two years as a junior faculty member at the Indiana University School of Law (Bloomington, Indiana), I spent the next 15 years as a professor at the University of Kentucky College of Law (Lexington, Kentucky), where I taught at least one intellectual property law course almost every year. The basic course was called "Unfair Trade Practices," and it emphasized trademarks and related unfair competition.

(d) In 1973, I started to publish in the area of trademarks and unfair competition, and, beginning in 1977, I have been called upon to address various continuing legal education groups (many of them involving intellectual property law specialists) on a wide variety of topics concerning trademarks and unfair competition. To date, I have given over 190 such lectures, many of which have been presented at programs of the nation's major trademark and/or patent law associations and over a dozen of which have been presented at the U.S. Patent and Trademark Office, to Trademark Trial and Appeal Board Administrative Trademark Judges and the Trademark Examining Attorneys comprising the entire "Trademark Examining Operation." A few years ago, I presented the Trademark and Unfair Competition developments lecture at the Annual Meeting of the American Intellectual Property Law Association, the largest organization of patent (and to a lesser extent, trademark and copyright) attorneys in the United States. In 2005, I lectured in New York, Cincinnati, and Cleveland. This year, I have lectured in San Antonio, Boston, Cincinnati, Cleveland, and Troy (Detroit-area).

(e) In 1986, I accepted an appointment as Visiting Professor of Law at the George Washington University National Law Center (Washington D.C.), a law school that is nationally renowned for its Intellectual Property program. I was invited to go there because of my reputation in the area of trademarks and unfair competition. After my year at George Washington, I became "Of Counsel" to a substantial Washington, D.C. intellectual property law firm (then known as Banner, Birch, McKie & Beckett) for a year. (From 1982 until 1986 I had served as part-time "Of Counsel" to a small intellectual property law firm in Lexington, Kentucky.)

(f) Since 1988, I have served as a full-time practicing trademark/unfair competition lawyer, first at Frost & Jacobs LLP (which later became Frost Brown Todd LLC), and more recently at Thompson Hine LLP. My practice includes counseling regarding the selection, adoption, use, registration, and protection of domestic trademarks. I have searched/"cleared" and filed/prosecuted hundreds of trademarks during my career. My practice also includes consulting (and, occasionally, litigation) concerning all aspects of trademark infringement and unfair competition.

(g) In 2001, I was named a charter member of the Advisory Council to the newly-created "J. Thomas McCarthy Institute for Intellectual Property and Technology Law." In 2004, I was named to the then-new Ohio Super Lawyers list (Intellectual Property) and to the Chambers USA: America's Leading Lawyers for Business list (top rating). I have been re-named to these lists each successive year.

2. I have been called upon as a potential expert witness on trademark and unfair competition matters on dozens of occasions during the past few decades. I have testified in court on approximately 15 occasions, and I have been deposed as part of the discovery process in many other cases. **Exhibit 2** to this Report identifies all of my in-court and deposition appearances during the 2003-2006 time frame.

3. When I am retained as a potential expert witness in a trademark/unfair competition case, I proceed in the following manner: After preliminary discussions with the retaining attorney(s), I carefully read, study, and analyze the relevant pleadings, reports, discovery documents, physical evidence, etc. Then I further discuss the matter with the retaining attorney(s) and informally present my opinion(s) on the matter(s) at hand. Thereafter, I prepare and execute formal reports, sit for depositions, and sometimes testify in court, as appropriate.

4. I recently was retained as a potential expert witness on various issues in connection with the above-referenced case by Rothwell, Figg, Ernst & Manbeck, P.C. Compensation (payable to my law firm) was set at its usual level for work of this type (\$600/hour for work done in 2006); such compensation is not dependent in any way upon the outcome of the controversy. Neither my law firm nor I have any other financial interest in the outcome of this case.

5. A list of the specific materials I have reviewed in connection with this Expert Report is attached hereto as **Exhibit 3**. With regard to PTO principles, practice and procedure, I have conducted and supervised independent statutory, decisional, administrative, and secondary authority research, and I have drawn upon my own knowledge and experience, both academic and practical.

6. I believe that the educational, experiential, factual, and legal factors related earlier in this Report and its Exhibits give me an adequate and proper basis to comment and opine upon the facts and issues involved in this case, and that my views will be of assistance to the Board, in its role as the trier of fact.

7. (a) Regarding this Opposition, I have been asked to study and opine about the "Declaration of Ann Willoughby" (3/6/06), which Opposer submitted in support of its arguments. Because Ms. Willoughby appended her "Report of Ann Willoughby" (2/21/03), initially submitted in connection with the civil case captioned *American Italian Pasta Co. v. New World Pasta Co.* (W.D. Mo.; No. 4:02-cv-00594-SOW), to her just-referenced "Declaration," I also have considered that "Report." Similarly, I have considered the "Deposition of Ann Willoughby" (11/3/06) taken in connection with the current Opposition.

(b) As explained in detail in ¶¶ 8-10, below, I have reached these conclusions about Ms. Willoughby's Declaration (and related documents):

(i) Although Ms. Willoughby is quite experienced in the design aspects of product packaging and advertising, including what she calls "branding," she lacks a firm understanding of trademark law principles relevant to "branding." For one thing, she was much less buyer/user-centered than appropriate in her appraisal of the effect of the "America's Favorite Pasta" phrase Opposer claims as its trademark.

(ii) Ms. Willoughby does not understand what is necessary for a self-laudatory, descriptive/generic phrase to become a legally cognizable trademark.

(iii) Ms. Willoughby never questions whether "America's Favorite Pasta" (without any express indicator of claimed trademark status – such as a superscript "TM"), a phrase used by Opposer in its packaging, advertising and promotions, made a commercial impression sufficiently separate and distinct from Opposer's overall "trade dress" so as to amount to "use as a trademark"* and, potentially, to qualify for acquired distinctiveness status.

(iv) Ms. Willoughby's reliance upon certain famous slogans – e.g., "BMW--The Ultimate Driving Machine" – slogans that initially/inherently had more "distinctiveness" than "America's Favorite Pasta" and which had been heavily and emphatically advertised/promoted by their proprietors, was badly misplaced.

* "Use as a trademark" involves prominent display of the trademark in close connection with the specified goods, in a manner calculated to apprise the relevant public (and relevant competitors) of the user's claim of trademark proprietorship. While no one single mode of display is determinative of the existence of use as a trademark, typical ways of making such use are the accented display of the intended trademark – as by all-capital letter format, bold or contrasting typeface, varying coloration, and/or greater size – appending of the informal symbol "TM," and/or the conjoining of an obviously generic term. It is crucial that the typical consumer exercising normal care in the ordinary marketing milieu reasonably be put on notice that the subject word, name, etc., is claimed as and functions as a source-identifier, not merely as an element of advertising copy or package decoration, or as a generic designation.

(v) The conclusions stated in ¶¶ 4-5 of Ms. Willoughby's Declaration (and those stated in ¶ 22 of her 2003 Report) are unsubstantiated.

(vi) The contents and conclusions in Ms. Willoughby's Declaration (and in her 2003 Report) do not satisfy Opposer's burden to prove that Opposer's phrase "America's Favorite Pasta" constitutes a "mark" upon which Opposer can base its Opposition to registration of Applicant's BARILLA – AMERICA'S FAVORITE PASTA mark. See Legal Appendix, appended to this Rebuttal Expert Report.

8. Regarding Ms. Willoughby's Declaration ¶ 4:

(a) I do not take exception to her general proposition that "consumers of food products . . . can regard a term or phrase as puffery and still associate and identify that term or phrase as a branding statement" However, highly descriptive/generic self-laudatory phrases (such as "AMERICA'S FAVORITE PASTA") are very hard to promote to trademark status via "secondary meaning" (aka "acquired distinctiveness"), both under common law and under the Lanham Act.

(b) Moreover, I find her reliance by analogy on such phrases as "BMW – The Ultimate Driving Machine" and "When you care to send the very best" as consistent with the general proposition, but quite inapposite in relation to highly descriptive/generic, self-laudatory phrases (such as "America's Favorite Pasta"). The cited phrases were not as bland as "America's Favorite Pasta" at inception, and they have been the subject of focused advertising/promotional campaigns that imbedded them into the psyches of relevant consumers. On the contrary, despite many, many iterations of "America's Favorite Pasta" as one of many elements of Opposer's MUELLER'S packaging, there is *no* information showing similar advertising/promotional focus or even that the packaging presentations effectively drew attention to that phrase in a "branding" sense, let alone in a "use as a trademark" sense. Thus, her conclusion that the MUELLER'S packaging "does associate it [the "America's Favorite Pasta" phrase] with the Mueller's name and that phrase does, in fact, serve as a brand identifier," rings hollow.

9. In ¶ 10 of Ms. Willoughby's Declaration (which reiterates a conclusion from ¶ 22 of her 2003 Report), she re-states "[a]ll of these trade dress features, including the phrase 'America's Favorite Pasta,' serve as a trademark function and help consumers recognize the Mueller's brand'." She says this is because "a number of elements may serve, either individually or collectively, to provide a brand identity." And she adds: "The consumer seeing the Mueller's packaging . . . may draw upon the different elements to identify the brand." Then she concludes: "[L]ike the Mueller's name and the red, white and blue packaging, the phrase 'America's Favorite Pasta' performs a trademark function" I note that Ms. Willoughby said "a number of constituent elements *may* serve, *either* individually or collectively" (emphasis added). There is no stated basis for her assumption/conclusion that the particular "constituent element" now in issue ("America's Favorite Pasta") "individually" serves as a trademark. And there is no reason to believe that the entire phrase ("America's Favorite Pasta"), admittedly a third-level branding element at best, serves as a trademark.

10. The following passages from Ms. Willoughby's Deposition confirm many of the just-stated shortcomings in her Declaration (and appended Report):

(a) When asked whether "America's Favorite Pasta," as it appears on a 1998 Mueller's box, is a trademark, she answered: "Yes, it is a trade – it's part of the trade dress of the Mueller's brand." P. 37, Ls. 1-2. Note that she really doesn't say that the phrase, itself, is a trademark. Also note that what she does say is hard to harmonize with standard trademark law.

(b) She mentions that some companies have conducted "equity tests" to measure "the components [of their brand identities] and the hierarchy and why they're important." P. 37, Ls. 17, 21-22. But she does not say anything about an "equity test" that Opposer might have conducted on "America's Favorite Pasta."

(c) Her discussions of the hierarchy of brand elements make it clear that she views "America's Favorite Pasta" in no better than a third-level position. See P. 37, L. 25 – P. 38, L. 10 (listing in order of importance: color, verbal mark, "all the other elements come together").

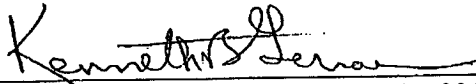
(d) At one point, she discusses the slogan "The best care in the air," calling it a "tag line" and noting the repeated, focused use made of it by its owner: "[T]hey still use [the slogan] on all their advertising. And almost everything – if you open up their magazine . . . everything that they use, they always use that tag line." P. 45, Ls. 15-21. Note that she *never* calls "America's Favorite Pasta" a tag line. Indeed, later on, she ambiguously refers to it as "almost like a tag line." P. 62, Ls. 10-11.

(e) She demonstrates her poor grasp on what constitutes a trademark: "Q.: But you consider that ["Makes a meal" phrase] a trademark? A.: It could be. It could be a trademark and it might just be a promotion. But it might also become part of their brand heritage, but you could trademark it just for a promotion, if you wanted to." P. 64, Ls. 14-19. And also: "Q.: . . . "America's Favorite Pasta," does that appear as a trademark to you? A.: Yes . . . But I would imagine you would tend to use it with the word 'Mueller's,' though." P. 67, Ls. 2-10.

(f) She demonstrates a very peculiar understanding of the legal effect of adding a generic term (Pasta) to a laudatory term (America's Favorite): "it's puffery, but it also could be distinctive if you add the element pasta, car, whatever." P. 81, Ls. 23-25.

* * * * *

This Report is premised on the information and legal authorities that I have been able to review as of today's date. Thus, I hereby reserve the right to supplement this Report, as appropriate, to account for later-available information and/or legal authorities. Also, although I have not referred to all of the items listed in **Exhibit 3** in this Report, the unreferenced items may have informed my understanding of the facts and issues, and affected the opinions expressed herein.


Kenneth B. Germain (December 14, 2006)

614905.1

LEGAL APPENDIX

I. § 2(d) Opposer Must Rely on a "Mark"

- A. In an opposition founded on § 2(d), under the *Otto Roth* rule, opposer must prove that it has proprietary rights in the term it relies upon to prove likelihood of confusion. . . . Restating the rule of the 1981 *Otto Roth* case, the Federal Circuit [*sic*: C.C.P.A.] emphasized that in an opposition or cancellation proceeding, the plaintiff relying on an unregistered term to argue likelihood of confusion under § 2(d) must prove distinctiveness, either by inherent distinctiveness or acquired distinctiveness . . . prior to the date of the registrant's first use . . . through secondary meaning. . . . Thus, it is clear that an opposer must prove secondary meaning in a descriptive term. . . . Similarly, prior use of a descriptive designation in a purely descriptive sense cannot be relied upon by an opposer under § 2(d).

J.T. McCarthy, *Trademarks and Unfair Competition* (4th ed. 2006) ["*McCarthy*"]* § 20:15 at 20-31 to -33, citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317 (C.C.P.A. 1981). *Accord*, *Towers v. Advent Software, Inc.*, 913 F.2d 942 (Fed. Cir. 1990).

II. The Descriptive/Generic Inherent Nature of Self-Laudatory Slogans; The Weak Character of Self-Laudatory Slogan Marks

- B. A slogan or any other combination of words is capable of trademark significance, if used in such a way as to identify and distinguish the seller's goods and services from those of others.

McCarthy § 7:20 at 7-54.

- C. Sometimes, advertising slogans are not in fact used as trademarks. Slogans often appear in such a context that they do not identify and distinguish the source of goods or services. In such cases, they are neither protectable nor registrable as trademarks. While slogans are capable of serving as trademarks, often they serve a subsidiary role to the main marks or house marks.

Id. at 7-55, citing, *inter alia*, *In re Morganroth*, 208 U.S.P.Q. 284 (T.T.A.B. 1980); *In re Remington Prods., Inc.*, 3 U.S.P.Q.2d 1714 (T.T.A.B. 1987).

* In this and most other quotes from *McCarthy*, most footnotes and footnote indicators have been omitted.

- D. A slogan can be put into the "descriptive" category, if it directly points out or refers to a characteristic of the goods, rather than acts as an arbitrary or merely suggestive mark.

Id. § 7:22 at 7-57.

- E. Self-laudatory slogans fall into the descriptive category. Thus, a merely laudatory epithet such as AMERICA'S BEST POPCORN! was held to be a merely descriptive slogan. Some slogans will be so common and highly descriptive that they are unregistrable because they will not be perceived as marks.

Id. at 7-59, citing *In re Wileswood, Inc.*, 201 U.S.P.Q. 400 (T.T.A.B. 1978).

- F. The more commonly used the phrase, the less likely that the public will use it to identify only one seller and the less likely that it can achieve trademark status. . . . The Trademark Board has taken a strong stand against the registration of such common phrases and slogans. The Board, affirmed by the Federal Circuit, denied registration to "The Best Beer in America" as a slogan for beer. The Board said that terms such as "Best Car in America," "Best Hotel in the State," and "Best Restaurant in Town" are mere "trade puffery" used only as self-laudatory messages and "should be freely available to all competitors in any given field to refer to their products or services. . . ." The Board said that such terms, while not "generic names," should not be registered even upon a showing of secondary meaning. The Federal Circuit agreed.

Id. § 7:23 at 7-63, citing *In re Boston Beer Co.*, 47 U.S.P.Q.2d 1914 (T.T.A.B. 1998), *aff'd*, 198 F.3d 1370 (Fed. Cir. 1999).

G. In the "prosecution history" (official file) of Applicant's BARILLA – AMERICA'S FAVORITE PASTA mark, U.S. Trademark Appl. Ser. No. 78/136,703, there are a few places where the PTO Trademark Examining Attorney ["PTO TEA"] demonstrated full agreement with the legal principles set forth in this Legal Appendix. (Moreover, he fully agreed with the factual assessments recited in the main body of my Rebuttal Expert Report, as he repeatedly insisted that the highly descriptive/generic self-laudatory phrase "America's Favorite Pasta" must be disclaimed apart from the mark as a whole, pursuant to Lanham Act § 6(a), 15 U.S.C. § 1056(a).)

(1) In the First Office Action (10/15/02), the PTO TEA demanded a disclaimer of "AMERICA'S FAVORITE PASTA"; this was "because the wording AMERICA'S is a term having geographical significance combined with FAVORITE a laudatory descriptive term, and PASTA a generic term." *Id.* at 2. The PTO TEA then added:

Also, the examining attorney has attached third-party registrations showing the term AMERICA('S) combined with laudatory and generic terms disclaimed. *See* the attached enclosure. Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. *Id.* (citations omitted)

The "attached third-party registrations" (including AMERICA'S FAVORITE PIZZA FEAST; AMERICA'S FAVORITE COOKIE; AMERICA'S FAVORITE SOUR GUM; AMERICA'S FAVORITE; AMERICA'S FAVORITE CANDIES), all of which involve food products, treated "America's Favorite" either by disclaimer of the merely descriptive component, by placement of the entire mark on the Supplemental Register (which, pursuant to Lanham Act § 23(a), 15 U.S.C. § 1091(a), allows for registration of terms "capable of distinguishing applicant's goods . . . and not registrable on the principal register"), or by proof of acquired distinctiveness under Lanham Act § 2(f), 15 U.S.C. § 1052(f).

(2) In the Second Office Action (6/18/03) – a "final" refusal to register the applied-for mark *without* the required disclaimer – the PTO TEA explained that the subject phrase was such that its "wording . . . is informational or common phrases used in business." *Id.* at 2. Then, after quoting T.M.E.P. 1209.03(s) on "Slogans," the PTO TEA wrote the following:

The wording AMERICA'S FAVORITE PASTA in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatory descriptive term (FAVORITE), and a generic term (PASTA). *Id.*

Then the PTO TEA attached a group of LEXIS/NEXIS printouts showing wholly descriptive usages of "America's favorite pasta." Notably, *none* of these references appears to refer to Opposer's alleged mark.

III. "Burden of Proving" Secondary Meaning

- H. Several courts take the sensible position that, for descriptive words, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish secondary meaning. This approach has been taken by the Federal Circuit and the Trademark Office in passing upon applications to register under § 2(f) of the Lanham Act.

McCarthy § 15:33 at 15-51, citing, *inter alia*, *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987); *In re Recorded Books Inc.*, 42 U.S.P.Q.2d 1275 (T.T.A.B. 1997).

Professor McCarthy notes, "The Restatement agrees, observing that more evidence is required to prove secondary meaning for highly descriptive terms." *Id.*, citing *Restatement (Third) of Unfair Competition* § 13, cmt. e (1995), which specifies:

It is the likely effect rather than the effort invested in such activities, however, that is determinative, and the expenditure of substantial sums in advertising does not in itself create protectable rights. Advertisements that emphasize the source significance of the designation through prominent use of the term or symbol or that invite consumers to "look for" the designation when selecting goods, for example, are more likely to generate secondary meaning than are more descriptive advertising uses.

The physical manner in which the designation is used with the goods, services, or business can also affect the likelihood that the designation will acquire secondary meaning. A designation that is relatively inconspicuous or that is used only in conjunction with other trademarks may be less likely to acquire secondary meaning than a more prominently displayed designation.

- I. *In re Wileswood* [cited *supra*] involved AMERICA'S FAVORITE POPCORN! and AMERICA'S BEST POPCORN! for – popcorn! Rejected under § 2(e)(1); affirmed by Board:

We have no doubt that, as used in the manner made of record in the applications, both phrases are intended to be regarded and will be understood by the purchasing public as applicant's own appraisal of the quality and popularity of its popcorn. That the expressions are applicant's own praises of its product is beyond question.

201 U.S.P.Q. at 401.

The net result is that the two expressions in question amount to nothing more than trade puffery or self-laudatory expressions of applicant's product and would be so understood. The use of each expression as a sub-headline on a leaflet under the major headline consisting of the registered trademark "COUNTRY STORE POPCORN" and the appearance on the same page of the tagline "Everyone likes POPCORN!" (for which no trademark claim has been or could be made), in letters at least as prominent in size and weight as the expressions for which registrations are sought, supports our view that applicant is fond of using prominently displayed phrases to help to sell its product without discriminantly emphasizing those phrases which are legitimately of a trademark character.

Id. at 402.

Instead, the phrases in question are only self-awarded laudations of applicant's product, which others might be equally entitled to use, for whatever they are worth, for the same product.

In assessing the meaning and likely commercial impression of the phrases "AMERICA'S BEST POPCORN" and "AMERICA'S FAVORITE POPCORN," we have, of course, focussed on the words "BEST" and "FAVORITE" because those are the key words of the two notations. However, we have, all the while, borne in mind the totalities of the two expressions. In our view, the word "AMERICA" serves merely to reinforce the message being communicated. This is not merely Ohio's best popcorn and Ohio's favorite popcorn. In all of America, according to applicant, this is the best and favorite unpopped popcorn. The geographical name "AMERICA" simply adds to applicant's boastfulness.

When an expression consists of merely laudatory words, it is not entitled to protection as a trademark in the absence of compelling proof that it has acquired a secondary meaning to the general public.

Id. N.B.: The word "compelling" appears 3 more times in this case.

K. A recent Trademark Trial and Appeal Board case reiterates that, when a term has been found to be "merely descriptive" under § 2(e)(1), "applicant has the burden of proving that its mark has acquired distinctiveness." *In re America Online, Inc.*, 77 U.S.P.Q.2d 1618, 1625 (T.T.A.B. 2006). This case also notes, "'Logically that standard becomes more difficult as the mark's descriptiveness increases'." *Id.*, quoting from *Yamaha Int'l Corp. Hoshimo Gakki Co.*, 840 F.2d 1572, 1581 (Fed. Cir. 1988). In *America Online*, the Board concluded that INSTANT MESSENGER, which applicant on-line service provider had used literally a billion times a day for many days, and which was shown to be recognized as a mark by many consumers, licensees and third parties, warranted a positive finding of acquired distinctiveness, thus qualifying for registration under § 2(f). *Id.*

Suffice it to say that the evidence adduced in support of Opposer AIPC's attempt to carry its § 2(f) burden of proof in respect of AMERICA'S FAVORITE PASTA is far, far below the level shown in respect of INSTANT MESSENGER.

EXHIBIT 1

KENNETH B. GERMAIN

Phone: (513) 352-6527 Fax: (513) 241-4771 E-mail: Ken.Germain@ThompsonHine.com

PROFESSIONAL
POSITIONS

Partner: Thompson Hine LLP (Cincinnati, OH) (2002-)
Adjunct Professor: University of Cincinnati College of Law (1988-)

Member: Frost Brown Todd LLC [formerly Frost & Jacobs LLP]
(Cincinnati, OH) (1988-2002)
Of Counsel: Banner, Birch, McKie & Beckett [now Banner & Witcoff]
Washington, DC (1987-88)
Adjunct Professor: American University Washington College of Law
Washington, DC (1987-88)
Visiting Professor: George Washington University National Law Center
Washington, DC (1986-87)
Professor of Law: University of Kentucky College of Law
Lexington, KY (1971-86)
Counsel: King & Schickli (Lexington, KY) (1982-87)
Instructor in Law: Indiana University School of Law
Bloomington, IN (1969-71)

LEGAL
AFFILIATIONS
AND
RECOGNITIONS

State Bar of California (1970-) [inactive]
District of Columbia Bar (1988-) [inactive]
Ohio State Bar (1989-)

Board of Advisors, *Restatement of Unfair Competition* (1987-92)
Advisory Board, *Patent, Trademark and Copyright Journal* (1987-)
Founder/Chair, All Ohio Annual Institute on Intellectual Property (1990-)
Member, Board of Directors, United States Trademark Assn. (1990-92)
Member, Cincinnati Intellectual Property Law Association (1988-)
The Best Lawyers in America (1991-92 and later editions)
Marquis' Who's Who in American Law
Marquis' Who's Who in the World
Guide to the World's Leading Experts in Trade Mark Law (1996 and later)
Who'sWhoLegal, The International Who's Who of Trademark Lawyers (2001-)
Chambers USA, America's Leading Lawyers for Business (2004-)
Ohio Super Lawyers 2005, 2006
Member, CPR/INTA Panel of Neutrals (2000-)
Member, Advisory Council, J. Thomas McCarthy Institute for Intellectual
Property and Technology Law (2001-)

LEGAL
EDUCATION

New York University School of Law, J.D., 1969
N.Y.U. Law Review, Associate Editor
American Jurisprudence Prizes for Excellence (5)

PRE-LEGAL
EDUCATION

Rutgers College, A.B., 1966 (Magna Cum Laude)
Elected to Membership in Phi Beta Kappa (1966)

PUBLICATIONS BY KENNETH B. GERMAIN

- (1) Section 43(a) of the Lanham Act: You've Come a Long Way, Baby - Too Far, Maybe? 49 Indiana L.J. 84 (1973); reprinted in 64 Trademark Rep. 193 (1974); 13 Publishing, Entertainment, Advertising L.Q. 215 (1974); and 6 Patent L. Rev. 323 (1974).
- (2) Legal Writing and Moot Court at Almost No Cost: The Kentucky Experience, 25 J. Legal Ed. 595 (1973).
- (3) Book Review (of E. Kitch and H. Perlman, Legal Regulation of the Competitive Process), 5 Rutgers-Camden L.J. 185 (1973).
- (4) Book Review (of J. T. McCarthy, Trademarks and Unfair Competition), 61 Kentucky L.J. 931 (1973).
- (5) Book Review (of S. Oppenheim and G. Weston, Unfair Trade Practices and Consumer Protection), 49 New York University L. Rev. 1256 (1974).
- (6) Remedies (Kentucky Law Survey), 63 Kentucky L.J. 777 (1975).
- (7) Trademark Registration Under Sections 2(a) and 2(e) of the Lanham Act: The Deception Decision, 44 Fordham L. Rev. 249 (1975), reprinted in 66 Trademark Rep. 97 (1976).
- (8) Remedies (Kentucky Law Survey), 64 Kentucky L.J. 233 (1976).
- (9) Remedies (Kentucky Law Survey), 65 Kentucky L.J. 285 (1976).
- (10) Sears/Compco Revisited: May Products and Packages Be "Simulated" in the Late Seventies? 1978 American Patent L. Assn. Bull. 160.
- (11) Tort Liability of Trademark Licensors in an Era of "Accountability": A Tale of Three Cases, 69 Trademark Rep. 128 (1979).
- (12) Book Review (of E. Kitch & H. Perlman, Legal Regulation of the Competitive Process, 2d ed.), 33 Vanderbilt L. Rev. 259 (1980).
- (13) The Thirty-Fourth Year of Administration of the Lanham Trademark Act of 1946, 71 Trademark Rep. 285 (1981), reprinted as 2 U.S.T.A., 1981-82 Trademark Law Handbook (Clark Boardman Co. 1982).
- (14) Trademark Developments [in Court of Customs and Patent Appeals Cases], 92 Fed. Rules Dec. 245 (1982).

PUBLICATIONS BY KENNETH B. GERMAIN (cont.)

- (15) The Supreme Court's Decision in the Inwood Case: Declination of Duty, 70 Kentucky L.J. 731 (1982).
- (16) The Thirty-Fifth Year of Administration of the Lanham Trademark Act of 1946, 72 Trademark Rep. 559 (1982), reprinted as U.S.T.A., 1982-83 Trademark Law Handbook (Clark Boardman Co. 1983).
- (17) The Thirty-Sixth Year of Administration of the Lanham Trademark Act of 1946, 73 Trademark Rep. 577 (1983) (with Steven M. Weinberg), reprinted as U.S.T.A., 1983-84 Trademark Law Handbook (Clark Boardman Co. 1984).
- (18) Recent Developments in Trademark Law, 1984 American Intellectual Prop. L. Bull. 631.
- (19) The Thirty-Seventh Year of Administration of the Lanham Trademark Act of 1946, 74 Trademark Rep. 469 (1984) (with Steven M. Weinberg), reprinted as U.S.T.A., 1984-85 Trademark Law Handbook (Clark Boardman Co. 1985).
- (20) Book Review (of J. T. McCarthy, Trademarks and Unfair Competition, 2d ed.), 34 Catholic U. L. Rev. 595 (1985).
- (21) The U.S. Supreme Court's Treatment of Trade Designation Cases in the Last Ten Years: From "Declination" to "Duty", appearing as Chapter 2 of the Southwestern Legal Foundation 1986 Patent Law Annual (Matthew Bender 1986).
- (22) Recent Case Law Developments-Trademarks, 1989 American Intellectual Prop. L. Bull. 57.
- (23) The Chameleonic Character of Non-Incontestable Trademark Registrations, www.CorporateIntelligence.com/issues.cfm?Story=60&Author=Germain.
- (24) Lawyers Who Need Lawyers: When to Retain a Legal Expert in a Trademark/Unfair Competition Case, www.CorporateIntelligence.com/issues.cfm?Story=74&Author=Germain.

PROFESSIONAL LECTURES GIVEN BY KENNETH B. GERMAIN

- (1) "Expanding Scope of Section 43(a) of the Lanham Act," United States Trademark Association, 1977 Trademark Basics Forum (Reston, Virginia; October 5, 1977).
- (2) "Introduction: Infringement and Other Unfair Competition Related Causes of Action Including § 43(a) of the Lanham Act as a Basis for Action and Jurisdiction," American Bar Association National Institute on Trademark Litigation (San Francisco, California; March 9, 1978).
- (3) "Section 43(a) of the Lanham Act," Cincinnati Patent Law Association, Monthly Meeting (Cincinnati, Ohio; April 25, 1978).
- (4) "Sears/Compco Revisited" May Products and Packages be 'Simulated' in the Late Seventies?" American Patent Law Association, 1978 Spring Stated Meeting (Rochester, New York; May 4, 1978).
- (5) "Introduction to the Law Regarding Trademark Infringement, Unfair Competition, and Section 43(a) of the Lanham Act," American Bar Association, National Institute on Trademark Litigation (Atlanta, Georgia; March 8, 1979).
- (6) "Tort Liability of the Trademark Licensor: A Developing Trend in an Era of 'Accountability'," United States Trademark Association, 101st Annual Meeting (Palm Beach, Florida; May 18, 1979).
- (7) "Quick Course on the Principal Principles of Trademark Law," Kentucky Bar Association, Annual Convention (Lexington, Kentucky; May 25, 1979).
- (8) "Trademark Owners Beware: Licenses May Beget Liability," San Francisco Patent and Trademark Law Association, Monthly Meeting (San Francisco, California; November 1, 1979).
- (9) "Caveat Franchisor: You May be Held 'Accountable' For the Torts of Your Franchisee," American Bar Association, Forum Committee on Franchising, Second Annual Forum (San Francisco, California; November 2, 1979).
- (10) "Section 43(a) -- The 'Black Hole' of the Lanham Act: How Can It Help the Trademark Owner," Practising Law Institute, Current Developments in Trademark Law and Unfair Competition 1980 (New York, New York; July 10, 1980).
- (11) "Liability of Trademark Licensors for the Torts of Their Licensees: The 'Accountability Principle in Action,'" BNA Education Systems, Trademarks and Unfair Competition: Recent Trends in the Law (Washington, D.C.; October 21, 1980).

- (12) "Review of the 1980-81 Trademark Cases Decided by the United States Court of Customs and Patent Appeals," Eighth Judicial Conference of the United States Court of Customs and Patent Appeals (Washington, D.C.; April 10, 1981).
- (13) "Current Review of U.S. Developments in Trademark Law: The Good, The Bad and The Audacious," United States Trademark Association, 103rd Annual Meeting (San Francisco, California; May 13, 1981).
- (14) "Overview of the Substantive Principles of Trademark Law and Unfair Competition Before and During the Eighties: A Tripartite Analysis," BNA Education Systems, Trademark and Unfair Competition Litigation, Law and Practice (Hilton Head, South Carolina; June 29, 1981).
- (15) "Arbitration of Trademark Disputes as an Alternative to Litigation: An Introduction," BNA Education Systems, Trademark and Unfair Competition Law, Litigation and Practice (Hilton Head, South Carolina; July 3, 1981).
- (16) "Current Review of U.S. Developments in Trademark law: Mixed Bag," United States Trademark Association, 104th Annual Meeting (New Orleans, Louisiana; May 8, 1982).
- (17) "Overview of the Substantive Principles of Trademark and Unfair Competition Law: A Tripartite Analysis," BNA Education Systems, U.S. Trademark and Unfair Competition Law and Practice (Montebello, Quebec, Canada; July 26, 1982).
- (18) "Trademark Law Basics," Fayette County Bar Association, Continuing Legal Education Program (Lexington, Kentucky; November 5, 1982).
- (19) "The Capsule-Color Cases," Cincinnati Patent Law Association (Cincinnati, Ohio; December 9, 1982).
- (20) "1982-83 U.S. Trademark Law Highlights: Mostly For the Good," United States Trademark Association, 105th Annual Meeting (Reno, Nevada; May 9, 1983).
- (21) "What Every Trade Secret Lawyer Should Know About Recent Trademark Cases," Bureau of National Affairs, Trade Secrets - Protecting Vital Corporate Information (Hilton Head, South Carolina; June 29, 1983).
- (22) "Recent Developments in Trademark and Unfair Competition Law," American Bar Association, Section of Patent, Trademark and Copyright Law, Annual Meeting (Atlanta, Georgia; August 2, 1983).
- (23) "The Section 2(a)/2(e) 'Deception Decision' -- Revisited," United States Patent and Trademark Office Examining Operation, Trademark Lecture Series (Arlington, Virginia; October 21, 1983).

- (24) Testimony and Prepared Statement on S.1990 (leading to the Trademark Clarification Act of 1984, P.L. 98-204, 98 Stat. 3335), Subcommittee on Patents, Copyrights and Trademarks, Committee of the Judiciary, United States Senate, 98th Congress, 2d Session (February 1, 1984).
- (25) "Review of Current Developments in U.S. Trademark/Unfair Competition Law in the Courts of General Jurisdiction: Lots of Action," United States Trademark Association, 106th Annual Meeting (Toronto, Ontario, Canada; May 14, 1984).
- (26) "Overview of Developments in Trademark and Unfair Competition Law During the June 1982 - May 1984 Biennium: Much Movement," Bureau of National Affairs, Recent Developments in Trademark and Unfair Competition Law (Hilton Head, South Carolina; June 18, 1984).
- (27) "Highlights of 1983-84 Court Cases in the Areas of Trademark Law and Unfair Competition: Law on the Move," United States Patent and Trademark Office Examining Operation, Trademark Lecture Series (Arlington, Virginia; June 26, 1984).
- (28) "Recent Developments in Trademark law: 1984, A Year of Subtle Distinction(s)," American Intellectual Property Law Association, Annual Meeting (Washington, D.C.; October 26, 1984).
- (29) "1985 Domestic Trademark Law Cases: Hot and Heavy," Association of Corporate Patent Counsel, Mid-Winter Meeting (Tucson, Arizona; January 27, 1985).
- (30) "Judicial and Legislative Developments in Domestic Trademark Infringement and Registration Law," Los Angeles Patent Law Association, Spring Seminar (Santa Barbara, California; May 5, 1985).
- (31) "Obtaining and Maintaining Trademarks: Guidelines for the General Practitioner," Louisville Bar Foundation, Intellectual Property Seminar (Louisville, Kentucky; June 7, 1985).
- (32) "Overview of the Substantive Principles of Trademark and Unfair Competition Law: A Bipartite Analysis," Bureau of National Affairs, Trademark Law, Practice and Litigation (Amelia Island, Florida; June 24, 1985).
- (33) "Developments in Domestic Trademark Infringement Law - With Emphasis Upon Sixth Circuit/Ohio Law," Cincinnati Patent Law Assn./Cincinnati Bar Assn., Corporate Law Committee Joint Meeting (Cincinnati, Ohio; July 15, 1985).
- (34) "National Trends in Trademark Law Infringement Litigation in the Courts of General Jurisdiction," United States Patent and Trademark Office, Trademark Examining Operation (Arlington, Virginia; July 22, 1985).

- (35) "Recent Developments in Trademark Law Domestic Infringement and Registration Matters," Institute of Continuing Legal Education, Eleventh Annual Intellectual Property Law Workshop (Mackinac Island, Michigan; August 2, 1985).
- (36) "The Supreme Court's Handling of Trade Designation Cases, 1975-85: From 'Declination' to 'Duty,'" Dayton Patent Law Association (Dayton, Ohio; October 11, 1985).
- (37) "Trademark Incontestability According to the Supreme Court's Park 'N Fly Decision: Much Ado About Very Little?" Patent Law Association of Pittsburgh (Pittsburgh, Pennsylvania; November 20, 1985).
- (38) "Major Domestic Judicial and Legislative Trademark Law Developments During 1980-85, An Era of Consequence," American Bar Association., Patent, Trademark & Copyright Section, Changes in Intellectual Property Law in the Eighties (Arlington, Virginia; April 10, 1986).
- (39) "Recent Developments in Domestic Trademark Law -- With a Focus on Ninth Circuit Cases," Los Angeles Patent Law Association Spring Seminar (Palm Springs, California; May 17, 1986).
- (40) "The U.S. Supreme Court's Treatment of Trade Designation Cases in the Last Ten Years -- From 'Declination' to 'Duty,'" Southwest Legal Foundation, Twenty-Fourth Annual Institute on Patent Law (Dallas, Texas; June 5, 1986).
- (41) "Recent Developments in Domestic Trademark Infringement and Registration Law," Institute of Continuing Legal Education, Twelfth Annual Intellectual Property Law Workshop (Traverse City, Michigan; July 18, 1986).
- (42) "National Trends in Substantive Trademark Litigation in the Courts of General Jurisdiction," United States Patent and Trademark Office, Trademark Examining Operation, Trademark Law Update Program (Arlington, Virginia; August 21, 1986).
- (43) "Recent Case Law Developments: Trademark Registration Law and Trademark/Unfair Competition Infringement Litigation," Bureau of National Affairs, The Trademark Registration Process and Current Issues (Washington, D.C.; September 16, 1986).
- (44) "Trademark Infringement: Emphasis on Enforcement," American Corporate Counsel Association, Guiding the Corporation into the Future (Arlington, Virginia; November 14, 1986).
- (45) "Trademarks in the Modern Competitive Environment," United States Trademark Association, 109th Annual Meeting (Boston, Massachusetts; April 27, 1987).
- (46) "Trademarks: Policy, Registration, Infringement," Georgetown University Law Center/District of Columbia Bar, Continuing Legal Education Division, Mini-Course (Washington, D.C.; May 18, 1987).

- (47) "More (Still More?) Developments in Domestic Trademark Infringement and Registration Law," Institute of Continuing Legal Education, Thirteenth Annual Intellectual Property Law Workshop (Boyne Highlands, Michigan; July 24, 1987).
- (48) "National Trends in Domestic Trademark Law: Litigation in the Courts of General Jurisdiction, 1986-87," United States Patent and Trademark Office, Trademark Examining Operation, Fourth Annual Trademark Law Update Program (Arlington, Virginia; September 10, 1987).
- (49) "The General/Corporate Practitioner's Role Regarding Trademarks," University of Kentucky Continuing Legal Education "Fall Football Weekend Workshop" (Lexington, Kentucky; September 19, 1987).
- (50) "Trademark Litigation: Policy, Substance, Jurisdiction and Remedies," District of Columbia Bar/Georgetown University Law Center Continuing Legal Education, Litigating Trademark and Copyright Cases (Washington, D.C.; October 20, 1987).
- (51) "Litigation of Civil Actions Under the Trademark Counterfeiting Act of 1984," Bureau of National Affairs, Developments in Trademark Law (Washington, D.C.; February 19, 1988).
- (52) "Remedies for Infringement of Registered and Unregistered Trademarks -- Counterfeiting and Contempt Considered," American Bar Association, Section of Patent, Trademark and Copyright Law, Intellectual Property Law -- Agency, Licensing, Litigation and Corporate Practice (Arlington, Virginia; March 25, 1988).
- (53) "'Unfair Competition' Under Section 43 of the Trademark Law Revision Act of 1988: The Baby Has Come a Long Way - Not Maybe," Cincinnati Patent Law Association monthly meeting (Cincinnati, Ohio; June 24, 1988).
- (54) "1988 - The Year of the Act/Acronym: USTA TRC TLRA S1883 HR4156 VIS", Institute of Continuing Legal Education, Fourteenth Annual Intellectual Property Law Workshop (Mackinac Island, Michigan; July 29, 1988).
- (55) "Recent Developments in Federal Trademark Legislation -- The Trademark Law Revision Act of 1988: Caveat Congress?", United States Patent and Trademark Office, Trademark Examining Operation, Trademark Lecture Series (Arlington, Virginia; September 22, 1988).
- (56) "The New Trademark Act: Law and Lore", Dayton Patent Law Association (Dayton, Ohio; December 9, 1988).
- (57) "Trademark Infringement Cases: Why, What, How and For What?," Fourteenth Oregon Patent Law Association-Washington State Patent Law Association Joint Seminar (Glen Eden Beach, Oregon; February 24, 1989).

- (58) "Domestic Developments in Trademark Law: Of Caselaw and Congress," ABA Patent, Trademark and Copyright Law Section's Fourth Annual Spring Seminar on Intellectual Property Law (Arlington, Virginia; March 29, 1989).
- (59) "Judicial Developments in Domestic Trademark Law: Hitting The High Points," Cincinnati Bar Association/Cincinnati Patent Law Association, 1989 Intellectual Property Law Institute (Cincinnati, Ohio; May 12, 1989).
- (60) "Interesting Issues in Trademark Law Arising Before the Courts of General Jurisdiction and the Federal Circuit," Institute of Continuing Legal Education, Fifteenth Annual Intellectual Property Law Workshop (Traverse City, Michigan; July 21, 1989).
- (61) "The Lanham Act Revised - And Ready to Roll," Cleveland Patent Law Association, Intellectual Property Law Seminar (Akron, Ohio; September 23, 1989).
- (62) "Trademark Review - Bonito Boats, Too," American Intellectual Property Law Association, Annual Meeting (Arlington, Virginia; October 20, 1989).
- (63) "Sentimental Journey: Developments in Domestic Trademark Caselaw During the Almost-Over Eighties," U.S. Patent and Trademark Office, Trademark Examining Operation, Sixth Annual Trademark Law Update Program (Arlington, Virginia; October 26, 1989).
- (64) "Trademark Infringement and Unfair Competition: Exiting the Era of the Eighties," Cincinnati Intellectual Property Law Association (Cincinnati, Ohio; November 30, 1989).
- (65) "Judicial and Legislative Legacies of the Eighties Regarding Trademark and Unfair Competition Law," Philadelphia Patent Law Association (Philadelphia, Pennsylvania; February 15, 1990).
- (66) "Selected Domestic Appellate Cases on Trademark Law and Initial Developments Under the Reborn Trademark Act," ABA Patent, Trademark & Copyright Law Section's Fifth Annual Spring Seminar on Intellectual Property (Arlington, Virginia; April 4, 1990).
- (67) "Judicial Developments in Domestic Trademark and Unfair Competition Law: Lots of Action," All Ohio Annual Institute on Intellectual Property, (Cincinnati, Ohio, June 14, 1990; and Cleveland, Ohio, June 15, 1990).
- (68) "Dilution - A Dangerous Doctrine," Practising Law Institute, Current Developments in Trademark Law and Unfair Competition 1990 (New York, New York; June 22, 1990).
- (69) "Recent Developments in Trademark and Unfair Competition Law: The Meat's In The Miscellany," Sixteenth Annual Intellectual Property Law Workshop, Institute of Continuing Legal Education (Bellaire, Michigan; July 19, 1990).

- (70) "Antipasto of the Day: Current Developments in U.S. Trademark Law," U.S. Trademark Association, 1990 Paralegal Forum (Washington, D.C.; September 26, 1990).
- (71) "Analyses of Interesting Aspects of Domestic Appellate Decisions Involving Trademark Law," Cincinnati Intellectual Property Law Association (Cincinnati, Ohio; November 9, 1990) and Dayton Intellectual Property Law Association (Dayton, Ohio; November 13, 1990).
- (72) "That Was The Year That Was: 1990ish Domestic Appellate Court Decisions Involving Trademark Validity, Infringement, and Licensing Issues," U.S. Patent and Trademark Office, Trademark Examining Operation, Seventh Annual Trademark Law Update Program (Arlington, Virginia; January 10, 1991).
- (73) "Scratching The Surface Of Trademark Law," ALI-ABA Conference Entitled Trademarks, Copyrights, and Unfair Competition for the General Practitioner (Washington, D.C.; April 11, 1991).
- (74) "False Advertising Under Lanham Act § 43(a) - Then and Now," ALI-ABA Conference Entitled Trademarks, Copyrights, and Unfair Competition for the General Practitioner (Washington, D.C.; April 11, 1991).
- (75) "Federal Unfair Competition Under Lanham Act § 43(a) - The Way It Is, The Way It Was," San Francisco Patent and Trademark Law Association, Spring Seminar (Napa, California; May 4, 1991).
- (76) "Summary of Selected Domestic Appellate Trademark and Unfair Competition Cases, 1990-91: Infringement, Licensing and Registration Issues," Cincinnati Bar Association/Cincinnati Intellectual Property Law Association, 1991 Intellectual Property Law Institute (Cincinnati, Ohio; June 6, 1991).
- (77) "Annual Review of Selected Domestic Appellate Court Trademark and Unfair Competition Cases: Isn't It Grand?", Institute of Continuing Legal Education, Seventeenth Annual Intellectual Property Law Workshop (Mackinac Island, Michigan; August 2, 1991).
- (78) "Trademark Licensing - Recent Appellate Cases Concerning Tort Liability of Licensors and Other Aspects of the Licensing Relationship," Fourth Annual Symposium on Intellectual Property and the Corporate Client, Corporate Counsel Center of Northwestern University School of Law (Chicago, Illinois; October 8, 1991).
- (79) "Trademark and Unfair Competition Law According to American Appellate Courts Circa 1991," Annual Meeting, American Intellectual Property Law Association (Arlington, Virginia; October 19, 1991).
- (80) "1991 In Review: Trademarks - Unfair Competition, Too," U.S. Patent and Trademark Office, Eighth Annual Trademark Law Update Program (Arlington, Virginia; January 9, 1992).

- (81) "U.S. Trademark and Unfair Competition Law: The Most Recent Gospel According To The Appellate Courts," American Bar Association Section of Patent, Trademark and Copyright Law, Annual Spring CLE Program (Los Angeles, California; March 31, 1992).
- (82) "Taking Trademark Law From The Top," ALI-ABA Conference on Trademarks, Copyrights, and Unfair Competition for the General Practitioner (Washington, D.C.; April 9, 1992).
- (83) "Trademarks: Sixth Circuit Review, Intent-To-Use, Too," Ohio State Bar Association, Annual Convention, Seminar of the Intellectual Property Law Section (Columbus, Ohio; May 15, 1992).
- (84) "A General Overview of Trademark Matters," Northern Kentucky University College of Law CLE Conference on Overview Of Trademarks, Copyrights And Patents And Related Intellectual Property Matters For The General Attorney (Greater Cincinnati Airport; June 19, 1992).
- (85) "U.S. Appellate Trademark And Unfair Competition Case Law - Fifth Circuit Cases Boldly Briefed," State Bar of Texas, Annual Meeting (Corpus Christi, Texas; June 27, 1992).
- (86) "Trademarks For Traverse: Another Year's Highlights," Eighteenth Annual Intellectual Property Law Workshop sponsored by the Michigan Institute of Continuing Legal Education (Traverse City, Michigan; June 17, 1992).
- (87) "Hot Spots of U.S. Appellate Court Trademark Infringement and Registration Cases: Pig Sandwiches, Kings of Beaches, Mexican Motifs - and More," All Ohio Annual Institute On Intellectual Property program (Cleveland, Ohio, September 24, 1992; and Cincinnati, Ohio, September 25, 1992).
- (88) "Domestic Appellate Court Trademark Infringement Case Law: What's New In '92," U.S. Patent and Trademark Office's Ninth Annual Trademark Law Update Program (Arlington, Virginia; October 13, 1992).
- (89) "Current And Emerging Issues In U.S. Trademark And Unfair Competition Law," Intellectual Property-Trade-Marks Law Seminar sponsored by the National Judicial Institute (Montebello, Quebec, Canada; November 20, 1992).
- (90) "Can Trade Dress Be 'Inherently Distinctive'? Sí, Señor!," Cincinnati Intellectual Property Law Association's monthly meeting (Cincinnati, Ohio; February 10, 1993).
- (91) "Nuts & Bolts of Trademark Law," Cincinnati Bar Association's YLS NO Brown Bag Seminar Series program (Cincinnati, Ohio; February 17, 1993).

- (92) "Protection of Trademarks 'Beyond Confusion' - Dilution, Disparagement & Parody," Trademarks, Copyrights and Unfair Competition For the General Practitioner, sponsored by ALI-ABA (Arlington, Virginia; April 15, 1993).
- (93) "The Extra-Confusion Actions: Dilution, Disparagement & Parody," Patents, Trademarks, Copyrights and Other Intellectual Property Law Matters, sponsored by the Northern Kentucky Bar Association (Fort Mitchell, Kentucky; June 4, 1993).
- (94) "Mid-'93 Report on Domestic Appellate Court Trademark Infringement Case Law," 19th Annual Intellectual Property Law Workshop, sponsored by the Michigan Institute of Continuing Legal Education (Mackinac Island, Michigan; July 9, 1993).
- (95) "Multifarious Issues in Recent Domestic Appellate Court Cases on Trademarks and Unfair Competition," 1993 All Ohio Annual Institute On Intellectual Property (Cleveland, Ohio, September 20, 1993; and Cincinnati, Ohio, September 21, 1993).
- (96) "1993 In Review - Domestic Appellate Court Cases On Trademark Infringement And Unfair Competition," U.S. Patent and Trademark Office's Tenth Annual Trademark Law Update Program (Arlington, Virginia; December 7, 1993).
- (97) "Inside Advice From Outside Counsel About Trademark Policies and Policing," American Corporate Counsel Association, Southwest Ohio Chapter, Monthly Meeting (Cincinnati, Ohio; May 26, 1994).
- (98) "Can - And Should - 'Color Per Se' Be Eligible For Registration and Protection: An Attempt To Color Coordinate The Symbolic Significance Of A Single Color," Cincinnati Intellectual Property Law Association, Monthly Meeting (Cincinnati, Ohio; June 15, 1994).
- (99) "Interesting Issues For ICLE: Domestic Appellate Court Trademark Infringement, Unfair Competition, And Registration Cases," 20th Annual Intellectual Property Law Workshop, Michigan Institute of Continuing Legal Education (Bellaire, Michigan; July 22, 1994).
- (100) "Another Year's Crop Of Domestic Appellate Court Cases On Trademarks And Unfair Competition," 1994 All Ohio Annual Institute On Intellectual Property (Cleveland, Ohio, September 22, 1994; and Cincinnati, Ohio, September 23, 1994).
- (101) "Beyond Confusion" In Three Acts -- Dilution, Disparagement, Parody," Trademarks, Copyrights and Unfair Competition For the General Practitioner, sponsored by ALI-ABA, (Arlington, Virginia; April 4, 1995).
- (102) "Look Out, Licensors - Likely Liability For Licensees' Louse-Ups," 117th Annual Meeting of the International Trademark Association entitled Avoiding Liability: Trademark and Advertising Issues (Orlando, Florida; May 2, 1995).
- (103) "The Supreme Court's Opinion in *Qualitex*: Quality Without Quantity," Cincinnati Intellectual Property Law Association (Cincinnati, Ohio; May 25, 1995).

- (104) "Pressing Problems Pertaining To Trademarks And Unfair Competition: Color Per Se; Product Configurations; Dilution/Disparagement/Parody," 21st Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education (ICLE) (Mackinac Island, Michigan; July 14, 1995).
- (105) "Does Post-*Two Pesos* Protection Against Product Configuration Simulation Amount To A Poor Man's Patent?" Patent Prosecution and Litigation Seminar, National Council of Intellectual Property Law Associations (Akron, Ohio; July 21, 1995).
- (106) "Trademarks/Unfair Competition: *Three To Get Ready* (Color, Configuration, Dilution) *And One To Round It Out* (Miscellany)," 1995 All Ohio Annual Institute On Intellectual Property (Cleveland, Ohio, September 14, 1995; and Cincinnati, Ohio, September 15, 1995).
- (107) "An Unhurried Look At The Protectability/Preemption Of "Trade Dress," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; October 27, 1995).
- (108) "Trademarks/Unfair Competition: The Current Year In Review," 1995 Meeting of the American Intellectual Property Law Association (Washington, D.C.; October 28, 1995).
- (109) "Trademarks: What They Are, And How They Can Be Registered," Cincinnati Paralegal Association (Cincinnati, Ohio; November 8, 1995).
- (110) "Protectability/Preemption of 'Trade Dress' -- Patent Problems Predominate," Columbus Intellectual Property Law Association (Columbus, Ohio; March 21, 1996).
- (111) "Trade Dress As Trademark: What Are The Rules?" Trademarks, Copyrights, and Unfair Competition for the General Practitioner, sponsored by ALI-ABA (Chicago, Illinois; April 19, 1996).
- (112) "Patent Preemption Of Product Simulation: Provocative But Practical," Indiana State Bar Association, Intellectual Property Section (Indianapolis, Indiana; April 20, 1996).
- (113) "Protectability/Preemption Of Trade Dress: A Tricky Topic For The Tri-Cities," Dayton Intellectual Property Law Association, Tri-Cities Meeting (Dayton, Ohio; April 25, 1996).
- (114) "Patent Law And Trademark Law At A Crossroads Called 'Trade Dress': Which Has The Right Of Way?" Association of Corporate Patent Counsel (Hot Springs, Virginia; June 19, 1996).

- (115) "Titleless In Traverse," 22nd Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education (ICLE) (Traverse City, Michigan; July 19, 1996).
- (116) "Domestic Appellate Trademark And Unfair Competition Cases: AOAIOIP, AOAIOIP And Away," 6th All Ohio Annual Institute On Intellectual Property, sponsored by the Cincinnati Bar Association and a Consortium of Intellectual Property Law Associations (Cincinnati, Ohio, September 19, 1996; and Akron, Ohio, September 20, 1996).
- (117) "Does Modern Trade Dress Protection Cause A Constitutional Conflict Between The Copyright-Patent Clause And The Commerce Clause?" Faculty Colloquium given at the University of Kentucky College of Law (Lexington, Kentucky; October 18, 1996).
- (118) "U.S. Appellate Court Decisions On Infringement Issues Involving Trademark And Unfair Competition Law," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; October 25, 1996).
- (119) "Recent Developments In The Law Of Trademarks And Unfair Competition," 1996 Annual Meeting of the American Intellectual Property Law Association (Washington, D.C.; October 26, 1996).
- (120) "Summaries Of Selected Domestic Appellate Trademark And Unfair Competition Cases," 34th Annual Institute on Patent Law (Dallas, Texas; November 21-22, 1996).
- (121) "Modern Trade Dress Protection," Columbus Bar Association's Intellectual Property Seminar (Columbus, Ohio; December 9, 1996).
- (122) "Trade Dress Protection - Past, Present and Future," Seventh Annual Trademark, Copyrights, and Unfair Competition for the General Practitioner, sponsored by ALI-ABA, (Washington, D.C.; April 11, 1997).
- (123) "Anatomy of a Reverse Confusion Case," Cincinnati Intellectual Property Law Association, Monthly Meeting (Cincinnati, Ohio; May 28, 1997).
- (124) "Selected Domestic Appellate Cases On Trademarks And Unfair Competition: Que Buena!" 23rd Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education (ICLE) (Mackinac Island, Michigan; August 1, 1997).
- (125) "Trademarks, Trade Dress, Etc.: Domestic Appellate Caselaw, 1996-97," 7th All Ohio Annual Institute On Intellectual Property, sponsored by the Cincinnati Bar Association and a Consortium of Intellectual Property Law Associations (Cincinnati, Ohio, September 11, 1997; and Akron, Ohio, September 12, 1997).

- (126) "Recent Trademark Decisions," Practising Law Institute, Third Annual Institute for Intellectual Property Law (New York, New York; September 23, 1997).
- (127) "U.S. Appellate Court Decisions on Issues Involving Trademarks, Trade Dress and Unfair Competition," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; October 16, 1997).
- (128) "Trademark, Trade Dress and Unfair Competition: Recent Developments and 100 Years of Change," 1997 Annual Meeting of the American Intellectual Property Law Association (Arlington, Virginia; October 18, 1997).
- (129) "Priming and Preparing Patent Practitioners to Avoid Precarious Pitfalls Pertaining to Product Configuration Protection Posing as 'Trade Dress'," 1998 Washington State/Oregon Patent Law Associations Joint Meeting (Welches, Oregon; April 17, 1998).
- (130) "Trademark Fundamentals For The General Practitioner," 1998 ALI-ABA Seminar entitled "Trademarks, Copyrights, and Unfair Competition For The General Practitioner" (Arlington, Virginia; April 23, 1998).
- (131) "Recent Developments In Trademark Law," ABA Annual Meeting (Williamsburg, Virginia; June 24-28, 1998).
- (132) "Selected Federal Appellate Court Cases on Trademark, Trade Dress and False Advertising Law," ICLE Intellectual Property Law Workshop (Mackinac Island, Michigan; July 23-25, 1998).
- (133) "Recent Developments in Trademark and Unfair Competition Law," 8th All Ohio Annual Institute On Intellectual Property, sponsored by the Cincinnati Bar Association and a Consortium of Intellectual Property Law Associations (Cleveland, Ohio, October 8, 1998; and Cincinnati, Ohio, October 9, 1998).
- (134) "Carefully Chosen Federal Appellate Court Cases on Trademark and Trade Dress Infringement Law," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; January 26, 1999).
- (135) "Trademark and Trade Dress Basics for the General Practitioner," Lorman Seminar: "Understanding Basic Trademark Law Principles" (Cincinnati, Ohio; February 10, 1999).
- (136) "*Resolved*: That U.S. Trademark Law Sometimes is Trumped By Patent and Copyright Law in Regard to Product Configuration Trade Dress," International Trademark Association Advanced Symposium: "Evolution and Revolution in Trademark Law" (New York, New York; March 4-5, 1999).
- (137) "Dilution Doctrine and Decisions -- Then and Now", Annual "Tri-Cities" Meeting of the Dayton, Cincinnati and Columbus Intellectual Property Law Associations (Dayton, Ohio; April 20, 1999).

- (138) "Trademark Law Fundamentals – For GPs and Corporate Counsel", ALI-ABA Seminar: "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Philadelphia, Pennsylvania; April 29, 1999).
- (139) "1998-99 Federal Appellate Court Cases on Trademark and Trade Dress Infringement Law," 25th Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education [ICLE] (Traverse City, Michigan; July 23, 1999).
- (140) "This Year's Notable Federal Appellate Court Cases On Trademark/Trade Dress Infringement and False Advertising Law," 9th All Ohio Annual Institute On Intellectual Property, sponsored by the Cincinnati Bar Association and a consortium of Intellectual Property Law Associations (Cleveland, Ohio, September 30, 1999; and Cincinnati, Ohio, October 1, 1999).
- (141) "The Erosion/Explosion of the *Sears-Compco/Bonito Boats* Doctrine – The Avant Gospel According to the Federal Circuit Court," PLI's Fifth Annual Institute for Intellectual Property Law (New York, New York; October 7, 1999).
- (142) "Trademark Law Update – At the End of An Era," 24th Annual Intellectual Property Institute, sponsored by the Intellectual Property Section of the State Bar of California (Santa Monica, California; November 12, 1999).
- (143) "Comments on Design Protection under the Patent and Trademark Acts," Northern Kentucky Law Review, "Intellectual Property Law 2000 Symposium: Issues in the New Millennium" (Covington, Kentucky; February 5, 2000).
- (144) "The Last Year of the Millennium as Seen in Selected Federal Appellate Court Cases on Trademark and Trade Dress Infringement Law," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; February 17, 2000).
- (145) "Trademark/Trade Dress Basics – for GPs and Corporate Counsel," ALI-ABA seminar "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Arlington, Virginia; April 6, 2000).
- (146) "Something Old, Something New: The Emerging Millennium as seen in Selected Federal Appellate Court Cases on Trademark and Trade Dress Infringement Law," 26th Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education [ICLE] (Mackinac Island, Michigan; July 21, 2000).
- (147) "Selected Federal Appellate Court Cases on Trademark/Trade Dress Law: All That *Non-Graeme*, *Non-Jane*, *Non-Alan*, *Non-Jeff* Jazz," 10th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, Ohio, September 21, 2000; and Cincinnati, Ohio, September 22, 2000).

- (148) "Trade Dress in the Modern Millennium: Will the *Wal-Mart* Court Be Up to the *Marketing Displays* Task?," Trademark Examining Operation, U.S. Patent and Trademark Office (Arlington, Virginia; October 19, 2000).
- (149) "The Supreme Court's Year 2000 Trade Dress Docket," Wisconsin Intellectual Property Law Association (Milwaukee, Wisconsin; November 8, 2000).
- (150) "Recent Developments in Trademark Law and Trade Dress Law: Strategies for Success," National Intellectual Property Law Seminar, sponsored by Barristers Educational Services (New Orleans, LA; December 8, 2000).
- (151) "*Traffix* at the Intersection of Trade Dress and Patents: Is Functionality the Only Stop Light?," "Nimmer, Napster and Intellectual Property Lawyers" program at the Retreat/Seminar of and for the Judges of the U.S. District Court for the Central District of California (Ojai, California; February 2, 2001).
- (152) "2000: The First Year(?) of the New Millennium as Seen in Selected Federal Appellate Court Cases on Trademark and Trade Dress Infringement," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; February 15, 2001).
- (153) "Tenets of Trademark/Trade Dress Law -- For GPs and Corporate Counsel," ALI-ABA Seminar - "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Scottsdale, Arizona; March 22, 2001).
- (154) "*Postscript To A Panel: With Traffix At the Intersection Of Trade Dress And Patents, Can Functionality Be The Only Stop Light?*," 2001 Annual Meeting of the San Francisco Intellectual Property Law Association (Aptos, California; April 29, 2001).
- (155) "Selected Federal Appellate Court Cases on Trademark and Trade Dress Infringement: Presumptions in Peril, Dilution in Disarray, Trade Dress in *Traffix*," 27th Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education [ICLE] (Mackinac Island, Michigan; July 13, 2001).
- (156) "The Law of Trademark in Today's Business World," University of Kentucky College of Law, Office of Continuing Legal Education seminar entitled "Trade Secrets, Non-Competes and Unfair Competition," (Lexington, Kentucky; October 12, 2001).
- (157) "Recent Developments in Trademark and Trade Dress Law: Selected Federal Appellate Court Cases," 11th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, Ohio, October 30, 2001; and Cincinnati, Ohio, October 31, 2001).
- (158) "Recent Developments in Trademark Infringement Law: A Collection of Federal Appellate Court Cases," PLI's Seventh Annual Institute for Intellectual Property Law (San Francisco, California; November 15, 2001).

- (159) "Selected Federal Appellate Court Cases on Trademark and Trade Dress Law," South Bay Trademark Association (Palo Alto, California; November 16, 2001).
- (160) "The Use of Legal Experts in Trademark/Unfair Competition Litigation: To Try Or Not To Try," ALI-ABA Seminar Entitled "Litigating, Trademark, Trade Dress, and Unfair Competition Cases" (Orlando, Florida; January 3, 2002).
- (161) "Fundamentals of Trademark Law and Litigation – For GPs and Corporate Counsel," ALI-ABA Seminar Entitled "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Washington, D.C.; April 18, 2002).
- (162) "Tort Liability of Trademark Licensors: From 'Accountability' to 'Accountancy' – and Touching on Trustmarks," ALI-ABA Seminar Entitled "Intellectual Property Licensing in Today's E-conomy" (Boston, Massachusetts; May 31, 2002).
- (163) "Trademark Licensors' Liability for Their Licensees' Torts: From 'Accountability' to 'Accountancy' – and Touching On Trustmarks," Seminar by BAMSL, Bar Association of Metropolitan St. Louis (St. Louis, Missouri; July 18, 2002).
- (164) "Intriguing Issues of Trademark and Trade Dress Law in Selected Federal Appellate Court Cases," 28th Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education ("ICLE") (Bellaire, Michigan; July 26, 2002).
- (165) "Select Federal Appellate Court Cases on Trademarks/Trade Dress: Registration, Infringement, Remedies, and Insurance Coverage Included," 12th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, Ohio, September 26, 2002; and Cincinnati, Ohio, September 27, 2002).
- (166) "Does the Supreme Court's *Traffix* Case Knock Out Product Design Trade Dress Protection?" 2002 Leadership Meeting of the International Trademark Association [INTA] (Scottsdale, Arizona; November 15, 2002).
- (167) "Trademark Case Law Update: A Potpourri," 40th Annual Program on Intellectual Property Law, sponsored by The Institute for Law and Technology of The Center for American and International Law (Dallas, Texas; November 18, 2002).
- (168) "Guess What? Fair Use Isn't, Disparagement Is, and Parody Might Be Trademark Infringement," ALI-ABA Seminar Entitled "Litigating Trademark Domain Name, and Unfair Competition Cases" (Washington, D.C.; December 5, 2002).
- (169) "Domestic Appellate Court Decisions on Trademark Law: What's New in '01-'02?," 26th Mid-Winter Institute of the American Intellectual Property Law Association (Marco Island, FL; January 22, 2003).

- (170) "Fundamentals of Trademark Law and Litigation – for GPs and Corporate Counsel," ALI-ABA Seminar Entitled "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Philadelphia, PA; April 10, 2003).
- (171) "An Insider's View of *Victoria's Secret*," Philadelphia Bar Association, Intellectual Property Committee (Philadelphia, PA; April 10, 2003).
- (172) "Can Functionality Keep Product Design Trade Dress Away From a Collision Course With the U.S. Constitution?" 125th Annual Meeting of the International Trademark Association [INTA] (Amsterdam, Netherlands; May 7, 2003).
- (173) "Basic Principles of U.S. Trademark Law – Theory, Registration, Infringement and Dilution," U.S. Business Club of the Chamber of Commerce of Kortrijk (Kortrijk, Belgium; May 8, 2003).
- (174) "Browse At the Big Top . . . Linger in the Lingerie Shop . . ." State Bar of Texas Annual Meeting, I.P. Section (Houston, Texas; June 13, 2003).
- (175) "Domestic Trademark/Trade Dress Appellate Cases, Limited Edition: San Diego *Sans* Supremes," American Bar Association's 10th Annual IPL Conference (San Diego, CA; June 21, 2003).
- (176) "The Supreme Court Speaks Out on Dilution – And the Circuit Courts Comment on Other Issues," Institute for Continuing Legal Education (Mackinac Island, MI; July 18, 2003).
- (177) "*Victoria's Secret*: Anatomy of a Dilution Case . . . Post-Mortem, Too," Intellectual Property Owners [IPO] Annual Meeting (Chicago, IL; September 16, 2003).
- (178) "The Supreme Court Dispenses a Double Dose of Trademark/Unfair Competition Decisions – And the Circuit Courts Dole Out Lots More," 13th All Ohio Annual Institute On Intellectual Property [AOAIOIP], primarily sponsored by the Cincinnati Bar Association (Cleveland, OH, September 18, 2003; and Cincinnati, OH, September 19, 2003).
- (179) "Today's Trade Dress Test: Product Design Patent Protection Per the 'Progress Clause'," Joint Conference of the Oregon Patent Law Association and the Washington State Patent Law Association (Gleneden Beach, OR; September 20, 2003).
- (180) "The 'Progress Clause' Provides for Product Design Patent Protection – But Only Partially," Patent and Trademark Office Day seminar sponsored by Intellectual Property Owners (Washington, D.C.; December 8, 2003).
- (181) "*Victoria's Secret* Changes the Rules – Or Does It?" Trademark Dilution After *Victoria's Secret* seminar sponsored by ALI-ABA (Washington, D.C.; February 5, 2004).

- (182) "The Effects of Patents and the 'Progress Clause' on Trade Dress Protection," Dayton Intellectual Property Law Association (Dayton, OH; March 12, 2004).
- (183) "Feeling for the Foul Line: Fair Use Is Fair, Disparagement is Foul, Parody Hugs the Line," Litigating Trademark, Domain Name, and Unfair Competition Cases seminar sponsored by ALI-ABA (Chicago, IL; April 22, 2004).
- (184) "Non-Traditional Marks of the Product Design Variety: Distinctiveness, Functionality, and Preemption," 126th Annual Meeting of the International Trademark Association [INTA] (Atlanta, GA; May 3, 2004).
- (185) "Patents, Progress (Clause) and Protection (Trade Dress)," Toledo Patent Law Association (Toledo, OH; May 11, 2004).
- (186) Testimony and Prepared Statement on S.2002 and S. 2373 (effects of Section 211 of the Omnibus Appropriations Act of 1998), Committee on the Judiciary, United States Senate, 108th Congress, 1st Session (July 13, 2004).
- (187) "A Year's Worth of U.S. Appellate Court Decisions on Trademarks, Trade Dress and Unfair Competition," 14th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, OH, September 9, 2004; and Cincinnati, OH, September 10, 2004).
- (188) "Play-By-Play of the Trademark Law Game, the Whole 100 Yards," Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel seminar sponsored by ALI-ABA (Washington, D.C.; October 14, 2004).
- (189) "Recent Domestic Appellate Court Decisions on Trademark Registration, Validity, Infringement, Dilution, Trade Dress, False Advertising, Monetary Remedies, and Other Issues," Trademark Examining Operation and the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office (Arlington, VA; October 14, 2004).
- (190) "The Liabilities Associated With Owning Trademarks: The Protections That Liability Insurance May Provide," Creative Strategies for Building, Maintaining and Protecting Your Trademark Assets sponsored by Thompson Hine LLP (Cleveland, OH, April 20, 2005; and Cincinnati, OH, April 22, 2005).
- (191) "The Interface and Conflict Between Utility Patents, Design Patents and Copyrights, On the One Hand, and Trademark/Trade Dress Rights, on the Other Hand," Advanced Seminar on Trademark Law sponsored by Practising Law Institute (New York, NY; June 30, 2005).

- (192) "Annual Review of U.S. Appellate Court Decisions On Trademarks, Trade Dress and Unfair Competition: From Fair Use to Everything Else," 15th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, OH, September 22, 2005; and Cincinnati, OH, September 23, 2005).
- (193) "Here We Go Again – Trademark Law 101 and 102," Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel seminar, sponsored by ALI-ABA (San Antonio, TX; April 27, 2006).
- (194) "Annual Review of American Appellate Court Decisions on Trademarks, Trade Dress and Unfair Competition," 16th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, OH, September 14, 2006; and Cincinnati, OH, September 15, 2006).
- (195) "Non-Traditional Trademark Claims: Can the Same Rules Apply?" Litigating Trademark, Domain Name and Unfair Competition Cases seminar, sponsored by ALI-ABA (Boston, MA; October 19, 2006).
- (196) "Trademark Dilution – Viewed Historically, Philosophically and Practically – Both Before and After *'Victoria's Secret'*," Litigating Trademark, Domain Name and Unfair Competition Cases seminar, sponsored by ALI-ABA (Boston, MA; October 19, 2006).
- (197) "Sixth Circuit Trademark Law: What's New Since 2002?" Michigan Intellectual Property Law Association (Troy, MI; December 5, 2006).

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EXHIBIT 2

CASES IN WHICH KENNETH B. GERMAIN TESTIFIED IN COURT AS AN EXPERT WITNESS ON TRADEMARK/UNFAIR COMPETITION LAW: 2003-2006

<u>Law Firm (City)</u>	<u>Case Involved</u>
Santangelo Law Firm (Ft. Collins, CO)	<u>Vail Resorts, Inc. v. Vend-Tel-Co, Ltd.</u> (D. Colo.; No. 01-M-1172)
Baker & Hostetler (Columbus, OH)	<u>Restaurant Advertising Group, Inc. v. J.P. Morgan Chase</u> (S.D. Ohio; No. C2 04 1020)
McDermott Will & Emery (Los Angeles, CA)	<u>Magic Kitchen LLC, et al. v. Good Things Int'l Ltd.</u> (Calif. Super. Ct.; No. BC 288124)

CASES IN WHICH KENNETH B. GERMAIN WAS DEPOSED (BUT DID NOT TESTIFY IN COURT) AS AN EXPERT WITNESS ON TRADEMARK/UNFAIR COMPETITION LAW: 2003-2006

<u>Law Firm (City)</u>	<u>Case Involved</u>
Maginot Moore & Bowman (Indianapolis, IN)	<u>Eco Manufacturing LLC v. Honeywell International, Inc.</u> (S.D. Ind.; No. 1:03-CV-0170 DFH-TAB)
Frost Brown Todd LLC (Cincinnati, OH)	<u>Phillips Products Co., LLC v. R.H. Phillips, Inc.</u> (D. Minn., No. 02-CV-650 MJD/JGL)
Oreck, Bradley, Crighton, Adams & Chase (New Orleans, LA)	<u>The Hoover Company v. Oreck Holdings, LLC</u> (N.D. Oh.; No. 5:02CV 548)
Arent Fox PLLC (Washington, DC)	<u>United Industries Corp. v. Dow Agrosiences, LLC</u> (Missouri Circuit Ct.; Cause No. 012-8393)
Morris Manning & Martin, LLP (Atlanta, GA)	<u>Integreon Managed Solutions, Inc. v. Integreo, Inc.</u> (C.D. Ca.; Case No. CV05-4795 JRW(RCx))
Frank, Haron, Weiner and Navarro (Troy, MI)	<u>Price, Heneveld, Cooper, Dewitt & Litton v. Annuity Investors Life Ins. Co. (W.D. Mi.)</u>
Drinker Biddle & Reath, LLP (Philadelphia, PA)	<u>Celgene Corporation v. Centocor, Inc.</u> (E.D. Pa.; Case No. 03-cv-5978-RB)

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EXHIBIT 3

1. Complaint for Declaratory Judgment in *American Italian Pasta Co. v. New World Pasta Co.*, 4:02-cv-00594-SOW (W.D. Mo.) (6/18/02)
2. Notice of Opposition (7/22/04); Answer to Notice of Opposition (9/28/04)
3. Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding (3/3/05)
4. Opposer's Notices of Reliance Under Rule 2.122(c) (with exhibits)
 - a. Re Opposer's Exhibits 115-218
 - b. Re Opposer's Exhibits 219-23
 - c. Re Opposer's Exhibits 224-25
 - d. Re Opposer's Exhibits 226-27
5. Declarations:
 - a. T.S. Webster (3/3/06), including his Declaration in the New World case (11/13/02)
 - b. A. Willoughby (3/6/06), including her Report, with exhibits, in the New World case (2/21/03)
 - c. D. Lericos (3/3/06), with some exhibits
6. Depositions:
 - a. T.S. Webster (11/9/06), with exhibits and related procedural documents
 - b. A. Willoughby (11/3/06)
 - c. A.J. Lericos (11/3/06)
7. Reports:
 - a. AIPC Brand Health Tracking Study (Wave I), produced by Synovate (3/04)
 - b. Name Protect Trademark Investigation Report (11/28/06)

8. U.S. PTO Records:

- a. File History on U.S. Trademark Appl. Ser. No. 78/136,703
 - b. Miscellaneous files obtained from www.uspto.gov
9. Miscellaneous photocopied photographs of Opposer's MUELLER'S pasta packages
10. Printouts from www.aipc.com (12/12/06)
11. Schedule 2.1(a) [starting with page 5, and tab B] to "Asset Purchase Agreement."
12. Joie Warner's book, "Spaghetti . . . america's favorite pasta" (1st ed. 1994), with dust jacket

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA)	
COMPANY,)	
)	
Opposer,)	Opposition No. 91-161,373
)	
v.)	
)	
BARILLA G. E R. FRATELLI – SOCIETA)	
PER AZIONI,)	
)	
Applicant.		

EXPERT REPORT OF KENNETH B. GERMAIN

I, Kenneth B. Germain, declare and state as follows:

1. (a) My name is Kenneth B. Germain and I live in Cincinnati, Ohio, where I am a Partner in Thompson Hine LLP.* From 1988 until September 30, 2002, I was a Partner in Frost & Jacobs LLP/Frost Brown Todd LLC. From 1989 until 2006, I served as an Adjunct Professor of Law at the University of Cincinnati College of Law. In most academic years I taught "Unfair Trade Practices," "Introduction To Intellectual Property," "Trademark and Unfair Competition Law," or "Trademark Practice and Procedure." In 1990, I created, and since that time I have coordinated, the "All Ohio Annual Institute On Intellectual Property," a two-city (typically Cincinnati and Cleveland), full-day continuing legal education seminar that features top-flight lawyers, judges, professors, and administrators from all over the country. The 2006 program – the 16th annual program – was presented in Cleveland on September 14 and in Cincinnati on September 15 to a total of approximately 430 paid attendees.

* On January 2, 2007, I will become "Of Counsel" to Thompson Hine LLP; at that same time, I will assume the title of "Distinguished Professorial Practitioner in Residence" in connection with the Program on Law and Technology at the University of Dayton School of Law.

(b) Through the years, I often have served in an expert witness capacity in civil cases involving a wide variety of issues relating to the selection, adoption, use, registration, maintenance, and infringement of trade designations of all kinds. I was the defendant's legal expert witness in the *Traffix* case that went to the U.S. Supreme Court, but I was not called to testify because the case was resolved on summary judgment at the trial court level. I also have served as a consultant to counsel engaged in cutting-edge issues, including the U.S. Supreme Court's 2003 *Victoria's Secret* case.

(c) My credentials are to some extent detailed in my resume, a copy of which is attached to this Report as **Exhibit 1**. To summarize: I graduated from law school over 30 years ago. After spending two years as a junior faculty member at the Indiana University School of Law (Bloomington, Indiana), I spent the next 15 years as a professor at the University of Kentucky College of Law (Lexington, Kentucky), where I taught at least one intellectual property law course almost every year. The basic course was called "Unfair Trade Practices," and it emphasized trademarks and related unfair competition.

(d) In 1973, I started to publish in the area of trademarks and unfair competition, and, beginning in 1977, I have been called upon to address various continuing legal education groups (many of them involving intellectual property law specialists) on a wide variety of topics concerning trademarks and unfair competition. To date, I have given over 190 such lectures, many of which have been presented at programs of the nation's major trademark and/or patent law associations and over a dozen of which have been presented at the U.S. Patent and Trademark Office, to Trademark Trial and Appeal Board Administrative Trademark Judges and the Trademark Examining Attorneys comprising the entire "Trademark Examining Operation." A few years ago, I presented the Trademark and Unfair Competition developments lecture at the Annual Meeting of the American Intellectual Property Law Association, the largest organization of patent (and to a lesser extent, trademark and copyright) attorneys in the United States. In 2005, I lectured in New York, Cincinnati, and Cleveland. This year, I have lectured in San Antonio, Boston, Cincinnati, Cleveland, and Troy (Detroit-area).

(e) In 1986, I accepted an appointment as Visiting Professor of Law at the George Washington University National Law Center (Washington D.C.), a law school that is nationally renowned for its Intellectual Property program. I was invited to go there because of my reputation in the area of trademarks and unfair competition. After my year at George Washington, I became "Of Counsel" to a substantial Washington, D.C. intellectual property law firm (then known as Banner, Birch, McKie & Beckett) for a year. (From 1982 until 1986 I had served as part-time "Of Counsel" to a small intellectual property law firm in Lexington, Kentucky.)

(f) Since 1988, I have served as a full-time practicing trademark/unfair competition lawyer, first at Frost & Jacobs LLP (which later became Frost Brown Todd LLC), and more recently at Thompson Hine LLP. My practice includes counseling regarding the selection, adoption, use, registration, and protection of domestic trademarks. I have searched/"cleared" and filed/prosecuted hundreds of trademarks during my career. My practice also includes consulting (and, occasionally, litigation) concerning all aspects of trademark infringement and unfair competition.

(g) In 2001, I was named a charter member of the Advisory Council to the newly-created "J. Thomas McCarthy Institute for Intellectual Property and Technology Law." In 2004, I was named to the then-new Ohio Super Lawyers list (Intellectual Property) and to the Chambers USA: America's Leading Lawyers for Business list (top rating). I have been re-named to these lists each successive year.

2. I have been called upon as a potential expert witness on trademark and unfair competition matters on dozens of occasions during the past few decades. I have testified in court on approximately 15 occasions, and I have been deposed as part of the discovery process in many other cases. Exhibit 2 to this Report identifies all of my in-court and deposition appearances during the 2003-2006 time frame.

3. When I am retained as a potential expert witness in a trademark/unfair competition case, I proceed in the following manner: After preliminary discussions with the retaining attorney(s), I carefully read, study, and analyze the relevant pleadings, reports, discovery documents, physical evidence, etc. Then I further discuss the matter with the retaining attorney(s) and informally present my opinion(s) on the matter(s) at hand. Thereafter, I prepare and execute formal reports, sit for depositions, and sometimes testify in court, as appropriate.

4. I recently was retained as a potential expert witness on various issues in connection with the above-referenced case by Rothwell, Figg, Ernst & Manbeck, P.C. Compensation (payable to my law firm) was set at its usual level for work of this type (\$600/hour for work done in 2006); such compensation is not dependent in any way upon the outcome of the controversy. Neither my law firm nor I have any other financial interest in the outcome of this case.

5. A list of the specific materials I have reviewed in connection with this Expert Report is attached hereto as **Exhibit 3**. With regard to PTO principles, practice and procedure, I have conducted and supervised independent statutory, decisional, administrative, and secondary authority research, and I have drawn upon my own knowledge and experience, both academic and practical.

6. I believe that the educational, experiential, factual, and legal factors related earlier in this Report and its Exhibits give me an adequate and proper basis to comment and opine upon the facts and issues involved in this case, and that my views will be of assistance to the Board, in its role as the trier of fact.

7. (a) I have been asked to study and opine about the "Declaration of Timothy S. Webster in Opposition to Applicant's Motion for Summary Judgment" (3/3/06), which Opposer submitted in support of its arguments in this Opposition. Because Mr. Webster appended his "Affidavit of Timothy S. Webster in Opposition to New World Pasta's Motion for Summary Judgment" (11/13/02), initially submitted in connection with the civil case captioned *American Italian Pasta Co. v. New World Pasta Co.* (W.D. Mo.; No. 4:02-cv-00594-SOW), to his just-referenced "Declaration," I also have considered that "Affidavit." Similarly, I have considered

the "Deposition of Timothy S. Webster" (11/9/06) taken in connection with the current Opposition. I have reached these conclusions about Mr. Webster's Declaration (and related documents):

(b) In Mr. Webster's Declaration, he repeatedly referred to Opposer's phrase "America's Favorite Pasta" as a "slogan" (§§ 3-6), but he *never* referred to that phrase as a "brand" or a "trademark." This demonstrates, in the manner of an admission against interest, Mr. Webster's – and, arguably, also Opposer's – recognition that "America's Favorite Pasta" does not qualify as a trademark (upon which an opposition to registration of Applicant's mark BARILLA – AMERICA'S FAVORITE PASTA can be based).

(c) In Mr. Webster's 2002 Affidavit:

(i) He repeatedly referred to "MUELLER'S brand" (note "all caps") as contrasted with "America's Favorite Pasta" (note "initial caps" only) thus indicating the perceived brand status *only* of MUELLER'S (and *not* of America's Favorite Pasta) (§ 4);

(ii) He compared "American pasta" to "Italian pasta," treating both of these terms as generics (or sub-generics) (§ 8); and

(iii) He relied (in § 12) upon two Rachael Ray "exhibits," one of which makes no mention whatsoever of "America's Favorite Pasta" (Exh. F), and the other of which merely shows that phrase appearing on a product box oriented in a slanted position which gives little prominence to the phrase (Exh. G). None of these references supports Opposer's claim that "America's Favorite Pasta" is a trademark (upon which an opposition to registration of Applicant's BARILLA – AMERICA'S FAVORITE PASTA mark can be based).

(d) In Mr. Webster's very recent (11/9/06) Deposition:

(i) He variously referred to "America's Favorite Pasta" as a "mark and trade dress," P. 18, L. 15, *or* a "brand and mark and trade dress," P. 19, Ls. 4-5, *or* an "element of our branding and trade dress," P. 29, Ls. 14-15, *or* "our descriptor," P. 32, L. 24, *or* "image and

design," P. 33, L. 19, *or* "an integral and important part of Mueller's brand and trade dress and identity and consumer protection," P. 43, Ls. 13-16, *or* a "marketing slogan." P. 60, L. 4. This multiplicity of meanings is *not* indicative of trademark status – even though he also asserted that the subject phrase had been "prominently displayed." See, e.g., P. 12, Ls. 20-21.

(ii) When asked if he knew how consumers regarded "America's Favorite Pasta," he replied:

Yes, we did consumer research periodically, from time to time, to assess the brand's progress, its awareness in the consumer's mind, the importance of elements, and we believed and were validated that it was an important part of the way the consumer viewed Mueller's. P. 41, Ls. 10-16.

However, although this testimony was adduced as part of Opposer's case-in-chief, no supporting exhibits or even specific indication of the nature of the referenced "consumer research" was provided. Notably, the 2004 Synovate Study – conducted and reported during Mr. Webster's term as CEO of Opposer – did *not* substantiate this testimony. See ¶ 10 of this Expert Report, below, where the Synovate Study is summarized.

(iii) He discussed the "Asset Purchase Agreement" between Best Foods and AIPC (10/4/2000; Exhibit 102), according to which AIPC acquired the MUELLER'S brand (and other assets) from Best Foods. He acknowledged that in ¶ 2.1(a) of that Agreement Best Foods transferred to AIPC "all of the trademarks, trade names, designs, logos, marketing materials, trade dress, packaging artwork, logos, currently and historically used in the marketing of the Mueller's brand" P. 22, Ls. 19-24. This recitation tracks ¶ 2.1(a), except that ¶ 2.1(a) also mentions "other intellectual property (regardless of whether registered with any Governmental Authority) owned by Seller [Best Foods] and exclusively used in the Business including those set forth on Schedule 2.1(a), and all goodwill associated with each of the foregoing (the 'Intellectual Property')." The full text of ¶ 2.1(a) strongly suggests that Schedule 2.1(a) – which Applicant only received a week or so ago¹ – should have included all relevant unregistered marks (aka

¹ Mr. Webster admitted he did not know the whereabouts of Schedule 2.1(a), P. 52, Ls. 5-8, or have any recollection of whether "America's Favorite Pasta" appeared there. *Id.*, Ls. 13-19.

marks *not* "registered with any Governmental Authority"), such as "America's Favorite Pasta," if any had been viewed as amounting to "trademarks, trade names," etc., as listed in ¶ 2.1(a).² In fact, Schedule 2.1(a), which identifies itself as "Intellectual Property" on what appears to be a page (numbered "5") that precedes a divider lettered "B," lists various U.S. design patents, U.S. trademark registrations, foreign trademark registrations, U.S. copyright registrations, and foreign design patents. This Schedule does not list "unregistered marks" of any type or geographical origin, nor does it mention "America's Favorite Pasta" at all. This confirms my belief that the parties – including AIPC, the buyer – did not view "America's Favorite Pasta" as a trademark – certainly not as a significant trademark. (My opinion here is unaffected by Mr. Webster's self-serving statement that "America's Favorite Pasta" was "[a]n integral part of what we [AIPC] were acquiring." P. 23, Ls. 6-7.)

(iv) When asked why AIPC had decided to apply for registration of "America's Favorite Pasta" in 2003, Mr. Webster explained that AIPC had "spent an enormous sum . . . defending and protecting the mark and the ability to use the mark" – clearly alluding to the *New World Pasta* litigation. P. 42, L. 24 – P. 43, L. 2. But his explanation is off the mark, as that case had nothing to do with "America's Favorite Pasta" as a "mark"; rather, it solely involved whether that phrase constituted a factual claim that allegedly amounted to false advertising. See P. 60, Ls. 3-7. While AIPC might have felt that its investment in the *New World Pasta* case compelled it to invest even more in "defending and protecting" the subject phrase, this motivation does not support a claim that that phrase had been functioning as a "mark" in the marketplace – or even in Opposer's internal contemplation.

² Consistent with the postulated reason for omission of "America's Favorite Pasta" from Schedule 2.1(a) is § 20.2 and internally referenced Schedule 14.5 of the "Manufacturing and Distribution Agreement Between CPC International and American Italian Pasta Company" (Exhibit 100) that preceded the Asset Purchase Agreement by a few years. (CPC and Best Foods were related companies.) In § 20.2, CPC granted a license to AIPC, allowing AIPC "to apply to the Products as necessary CPC's trademarks Mueller's®, Napolena® and certain other Marks that CPC may designate . . . and set forth on Schedule 14.5 hereto." Schedule 14.5 (A02824), which is entitled "CPC Retail Marks," lists Mueller's® and Napolena® *only*. Likewise, AIPC's current website, www.aipc.com, lists as retail brands MUELLER'S, PENNSYLVANIA DUTCH, and a number of others, but *nowhere mentions* "America's Favorite Pasta."

(v) He stated that he was not aware of any situation in which "America's Favorite Pasta" had been used on any packaging without the MUELLER'S mark. P. 57, Ls. 19-22.

(vi) He recognized that AIPC typically has displayed MUELLER'S with an ® symbol and with a legend such as "Mueller's is a registered trademark of [current owner]." See, e.g., P. 61, L. 22 – P. 62, L. 13; P. 64, Ls. 10-13. He also acknowledged that AIPC's 2005 packaging showed "America's Favorite Pasta" *without* a "TM" symbol and *without* a verbal claim of trademark status. P. 64, L. 23 – P. 65, L. 13. This despite AIPC's use of a TM symbol in connection with MICRO QUICK (and probably with PASTA QUICK) type of MUELLER'S products. P. 65, L. 21 – P. 66, L. 15. Finally, he candidly admitted that during his years as AIPC's CEO, he had no knowledge that AIPC ever used "TM" or ® in connection with "America's Favorite Pasta." P. 67, Ls. 10-18. He explained this as follows: "My presumption was that as part of the trade dress and as part of the widely recognized continuously used image of the brand that it was protected through use and – as part of the trade dress of the Mueller's brand." P. 67, L. 22 – P. 68, L. 2. Consistent with this he acknowledged that, in Exhibits 1-40, "America's Favorite Pasta" always had been "linked with the Mueller's brand name" P. 69, Ls. 9-10. And he characterized the packaging phrase "Taste why Mueller's is America's Favorite Pasta" as "part of what we called romance language." P. 62, L. 24 – P. 63, L. 5. In my opinion, this portion of Mr. Webster's testimony does *not* prove his claim of trademark status for "America's Favorite Pasta."

8. (a) I also have been asked to study and opine about the "Declaration of Drew Lericos (3/6/06), which Opposer submitted in support of its arguments in this Opposition. In this connection, I also have considered the "Deposition of Andrew John Lericos" – clearly the same person as "Drew Lericos" – (11/3/06) taken in connection with the current Opposition.

(b) As explained in detail below, I have reached these conclusions about Mr. Lericos' Declaration and Deposition:

(i) As explained in ¶ 9, below, in his Declaration, Mr. Lericos badly overstated the centrality and importance of "America's Favorite Pasta" to Opposer's

MUELLER'S brand identity, and, in particular, he mistakenly concluded that that phrase is "a very valuable trademark." Nothing in Mr. Lericos' Deposition counteracts the overstatements in his Declaration.

(ii) The 2004 Synovate Study referenced by Mr. Lericos in connection with his Deposition (as Exhibit 79) confirms the less-than-trademark status/stature of Opposer's phrase "America's Favorite Pasta." This is explained in ¶ 10, below.

(iii) As explained in ¶ 11, below, in his Deposition, Mr. Lericos basically reiterated and confirmed the positions and statements he had taken in his Declaration.

9. (a) In Mr. Lericos' Declaration, he said that the 2001 study "confirmed that the heritage of Mueller's and its slogan AMERICA'S FAVORITE PASTA resonates with consumers." (¶ 7) However, despite using an "all caps" format – the conventional way of indicating claimed trademark status – for the phrase in issue, Mr. Lericos, with only one exception (found in ¶ 10), repeatedly referred to this phrase as a "slogan." Indeed it is obvious that this phrase/slogan is only of tertiary significance. For example, in ¶ 8, Mr. Lericos mentioned, in this purposeful and particular order "the Mueller's trademark," "the classic red, white and blue colors," and "[a] third key component . . . the slogan 'AMERICA'S FAVORITE PASTA'." Peculiarly, he then mentioned "the three key elements of the branding slogan 'AMERICA'S FAVORITE PASTA'" I find it hard to believe that he views "PASTA," the third word in the phrase, and undoubtedly a generic term in this context, as a branding element.

(b) In ¶ 10, Mr. Lericos stated that "AIPC [Opposer] considers its slogan AMERICA'S FAVORITE PASTA as a very valuable trademark." I find this extremely unusual, because AIPC, which clearly has had an appreciation of registered trademarks for some years – AIPC's predecessors' registration of MUELLER'S goes back many years,³ AIPC itself registered

³ Per www.uspto.gov, MUELLER'S was registered for various pasta products on 10/11/49, Reg. No. 516,167, issued to the C.F. Mueller Co. This registration was assigned to AIPC in 2000.

some marks in 1989 and 1992,⁴ and AIPC received a trademark registration by assignment more than a year before it filed for AMERICA'S FAVORITE PASTA.⁵ Note that AIPC did not seek to register AMERICA'S FAVORITE PASTA until 2003, *after* Applicant (Barilla) already had filed to register BARILLA – AMERICA'S FAVORITE PASTA, the mark AIPC now opposes.

10. AIPC Brand Health Tracking Study, Wave I (3/04) ["Synovate Study"], appearing as Exhibit 79 to Mr. Lericos' Deposition, and numbered A011285-594, was premised on AIPC's desire to gauge its brands' positions vis-à-vis its main competitors' (notably Barilla and New World Pasta) brands. Synovate Study at 1. It's "overall study objectives" include "Understand the drivers of brand choice . . ."; "Gain insight into how each of the key AIPC brands are perceived . . ."; and "Measure overall awareness of AIPC brands" *Id.* at 2. Approximately 600 interviews were conducted in early 2004 with regard to AIPC's MUELLER'S products. *Id.* at 3. Clearly, the Synovate Study was a serious, comprehensive effort to assess the importance and effectiveness of AIPC's brands, specifically including its MUELLER'S line. As such, its findings, some of which are summarized now, are not to be taken lightly.

(a) Under "Pasta Attribute Most Important," respondents rated the MUELLER'S brand name at only the 5% level. Synovate Study at 11.

(b) Under "Total Muellers: Brand Image Analysis," both MUELLER'S and competitive RONZONI were seen as "well-known brands, America's favorite brand . . ." and BARILLA was seen as a "favorite brand." *Id.* at 25. Thus, at least internally (to Synovate and AIPC), "America's favorite" was seen merely as a descriptive/generic term, *not* as part of an alleged trademark such as "America's Favorite Pasta."

⁴ Per www.uspto.gov, AIPC itself registered these marks years before it filed to register AMERICA'S FAVORITE PASTA:

AIPC AMERICAN ITALIAN PASTA COMPANY & Design, Reg. No. 1,550,381, issued on 5/9/89.

PASTA LA BELLA (stylized), Reg. 1,741,518, issued on 12/22/92.

⁵ Per www.uspto.gov, AIPC received and recorded an assignment of the trademark registration for PENNSYLVANIA DUTCH, Reg. No. 808,162, assigned to AIPC and recorded on 1/30/02.

(c) Under "Total Muellers: Ad Recall and Communication," this startling finding appeared: "No element of Muellers' [*sic*: Mueller's] advertising is particularly memorable to consumers." *Id.* at 31; accord, *id.* at 113 & 119. And in response to a question asking for specific aspects recalled from MUELLER'S ads, *nobody* mentioned "America's Favorite Pasta." *Id.* at 32. In contrast, under "Total Muellers: Recognition of AIPC Brands' Advertising," 25% of those aware of MUELLER'S advertising were aware of "Mueller's makes the meal, you make the difference" – a slogan that was called a "tagline." *Id.* at 33. Consistently, whereas Q. 6C probed awareness of that particular tagline, no analogous question regarding "America's Favorite Pasta" was asked. See *id.* at 34. Indeed, "America's Favorite Pasta" *never* was mentioned. Accord, *id.* at 120-21.

(d) Under "Category Drivers," MUELLER'S products were seen as good values, but "Attributes related to Heritage & Authenticity are also of little importance." *Id.* at 65. Likewise, under "Total Muellers: Importance Hierarchy," on a scale ranging from 100 (most important) down to 1 (least important), "America's favorite" – not in any way identified as having trademark significance – ranked 17th out of 24, with a rating of 55. *Id.* at 66.

(e) Under "Total Muellers: Brand Image Analysis," both MUELLER'S and RONZONI" are seen as well-known brands, America's favorite brand" *Id.* at 71. And on the chart under "Total Muellers: Strategic Matrix – Muellers," one of the categories – not at all identified as a brand – was "America's favorite." *Id.* at 73. In fact, this category also appeared on charts showing competitors' (including Barilla's) strategic matrixes. *Id.* at 75, 77, 79, 81.

11. The deposition of Andrew John ["Drew"] Lericos (11/3/06) largely reiterates and confirms things already encountered in Mr. Lericos' Declaration (commented upon in ¶ 9 of this Expert Report). In particular:

(a) Mr. Lericos repeated that the "branding elements" displayed by MUELLER'S pasta packages are "first and foremost . . . the Mueller's name in the red banner and part in the logo elements, including the star and the wheat field. Secondly . . . the white color . . . including the blue and red stripes . . . Third . . . 'America's Favorite Pasta' as a slogan" *Id.* at 25, lines 8-19. Accord, *id.* at 26, lines 3-15. Mr. Lericos soon added that "[w]e believe this

[America's Favorite Pasta] is an integral part of our package because in our consumer research, consumers have told us that Mueller's is an American brand and that they associate it with America . . . [s]o 'America's Favorite Pasta' is meaningful." *Id.* at 26, line 22 to P. 27, line 5. But I find this unpersuasive, as it elevates "America's Favorite Pasta" well beyond "American" per se and as it is quite counter to the 2004 Synovate Survey, which as carefully noted in ¶ 10(c) of this Expert Report, provides *no* trade identity support for this phrase.

(b) Mr. Lericos cast an additional cloud on the "branding element" concept when he referred to "Enriched Macaroni Product" as one of "the common branding elements" of the MUELLER'S product line. *Id.* at 38, lines 7-16. I simply cannot understand how a phrase that is so highly descriptive as to be incapable of functioning as a trademark can be considered a "predominant common [branding] element." *Id.* lines 15-16.

(c) I find totally unavailing – as a possible example of "use as a trademark" of "America's Favorite Pasta" – this longer slogan cited by Mr. Lericos: "Make pasta better with Mueller's, America's Favorite Pasta." *Id.* at 50, lines 23-25. I feel the same way about the two similar examples described on page 52, lines 14-15, and page 53, lines 3-4, respectively.

(d) Mr. Lericos completely undermined his employer's (AIPC's) claim of trademark status for "America's Favorite Pasta" when he characterized that phrase as "merely descriptive . . . it's the essence that it's an America pasta brand that Americans are fond of." *Id.* at 63, lines 8-12. This, admittedly, is a purely "descriptive," non-trademark usage/understanding. And I am not impressed by the 57% rating that Mr. Lericos referred to in support of the trade identity significance of the pivotal phrase. See *id.* at 66, lines 7-23.

(e) Starting on page 69, Mr. Lericos answered questions about Exhibit 79, which is the 2004 Synovate Study (commented upon in ¶ 10 of this Expert Report). He noted that the graph on page 72 (A011357) rates "America's Favorite" highly on the "Standardized Profile," and that the matrix on the next page shows that "America's Favorite Pasta" qualifies as "a very strong attribute for the Mueller's brand." *Id.* at 75, lines 9-10. I note that "attribute" is a descriptive, marketing term, rather than an identifying, trademark term.

(f) Without doubt, the volume of MUELLER'S pasta products sold in packages bearing "America's Favorite Pasta" in relevant years was very substantial. See *id.* at 77, line 7 to P. 78, line 5. This is a plus factor regarding secondary meaning, but it is not enough to convert a highly descriptive/generic, self-laudatory slogan into a trademark.

(g) Based on his years of experience in the food industry and his education, Mr. Lericos candidly admitted that it is "usual for food manufacturers to federally register important brands for products." *Id.* at 87, lines 11-16. (Why did AIPC wait until 2003?)

(h) When asked whether AIPC had made any efforts to advertise and/or promote "America's Favorite Pasta" apart from MUELLER'S, Mr. Lericos candidly answered "Not to my knowledge." *Id.* at 91, lines 1-7. His attempt to deflect attention from this by explaining the lack of separate attention as "[s]trictly due to budgeting restraints," *id.* lines 13-14, is not convincing.

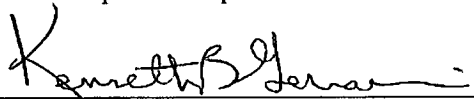
(i) Mr. Lericos acknowledged that the phrase "Mueller's is a registered trademark of the American Italian Pasta Company" appears on "every brand of pasta" sold by AIPC. *Id.* at 93, lines 3-11. And he acknowledged the purposeful presence of the federal registration symbol on all packages of MUELLER'S products. *Id.* lines 12-24. And he admitted that the slogan "America's Favorite Pasta" does not bear *any* claim of trademark status, either on packages or in advertising. *Id.* at 94, lines 3-22. This was revisited in the specific context of whether a "TM" indicator even had been used in connection with "America's Favorite Pasta," and the answer was "Not to my knowledge." *Id.* at 102, lines 12-24.

(j) Mr. Lericos recognized that "America's Favorite Pasta" is a "laudatory term." *Id.* at 98, lines 6-9. But he noted how, from a package design perspective, that slogan was given visual prominence. *Id.* at 100, lines 9-23. I don't doubt the latter, but I do (strongly) doubt that it converted this weak descriptive/generic phrase into a trademark -- especially when utterly no claim of trademark status ever was made for this phrase.

(k) When asked directly, "To your knowledge, has any survey or retailer ever told you that a consumer asked for 'America's Favorite Pasta'?" Mr. Lericos again said, "Not to my knowledge." *Id.* at 103, lines 16-19.

* * * * *

This Report is premised on the information and legal authorities that I have been able to review as of today's date. Thus, I hereby reserve the right to supplement this Report, as appropriate, to account for later-available information and/or legal authorities. Also, although I have not referred to all of the items listed in **Exhibit 3** in this Report, the unreferenced items may have informed my understanding of the facts and issues, and affected the opinions expressed herein.


Kenneth B. Germain (December 14, 2006)

615587.1

EXHIBIT 1

KENNETH B. GERMAIN

Phone: (513) 352-6527 Fax: (513) 241-4771 E-mail: Ken.Germain@ThompsonHine.com

**PROFESSIONAL
POSITIONS**

Partner: Thompson Hine LLP (Cincinnati, OH) (2002-)
Adjunct Professor: University of Cincinnati College of Law (1988-)

Member: Frost Brown Todd LLC [formerly Frost & Jacobs LLP]
(Cincinnati, OH) (1988-2002)
Of Counsel: Banner, Birch, McKie & Beckett [now Banner & Witcoff]
Washington, DC (1987-88)
Adjunct Professor: American University Washington College of Law
Washington, DC (1987-88)
Visiting Professor: George Washington University National Law Center
Washington, DC (1986-87)
Professor of Law: University of Kentucky College of Law
Lexington, KY (1971-86)
Counsel: King & Schickli (Lexington, KY) (1982-87)
Instructor in Law: Indiana University School of Law
Bloomington, IN (1969-71)

**LEGAL
AFFILIATIONS
AND
RECOGNITIONS**

State Bar of California (1970-) [inactive]
District of Columbia Bar (1988-) [inactive]
Ohio State Bar (1989-)

Board of Advisors, *Restatement of Unfair Competition* (1987-92)
Advisory Board, *Patent, Trademark and Copyright Journal* (1987-)
Founder/Chair, All Ohio Annual Institute on Intellectual Property (1990-)
Member, Board of Directors, United States Trademark Assn. (1990-92)
Member, Cincinnati Intellectual Property Law Association (1988-)
The Best Lawyers in America (1991-92 and later editions)
Marquis' Who's Who in American Law
Marquis' Who's Who in the World
Guide to the World's Leading Experts in Trade Mark Law (1996 and later)
Who'sWhoLegal, The International Who's Who of Trademark Lawyers (2001-)
Chambers USA, America's Leading Lawyers for Business (2004-)
Ohio Super Lawyers 2005, 2006
Member, CPR/INTA Panel of Neutrals (2000-)
Member, Advisory Council, J. Thomas McCarthy Institute for Intellectual
Property and Technology Law (2001-)

**LEGAL
EDUCATION**

New York University School of Law, J.D., 1969
N.Y.U. Law Review, Associate Editor
American Jurisprudence Prizes for Excellence (5)

**PRE-LEGAL
EDUCATION**

Rutgers College, A.B., 1966 (Magna Cum Laude)
Elected to Membership in Phi Beta Kappa (1966)

PUBLICATIONS BY KENNETH B. GERMAIN

- (1) Section 43(a) of the Lanham Act: You've Come a Long Way, Baby - Too Far, Maybe? 49 Indiana L.J. 84 (1973); reprinted in 64 Trademark Rep. 193 (1974); 13 Publishing, Entertainment, Advertising L.Q. 215 (1974); and 6 Patent L. Rev. 323 (1974).
- (2) Legal Writing and Moot Court at Almost No Cost: The Kentucky Experience, 25 J. Legal Ed. 595 (1973).
- (3) Book Review (of E. Kitch and H. Perlman, Legal Regulation of the Competitive Process), 5 Rutgers-Camden L.J. 185 (1973).
- (4) Book Review (of J. T. McCarthy, Trademarks and Unfair Competition), 61 Kentucky L.J. 931 (1973).
- (5) Book Review (of S. Oppenheim and G. Weston, Unfair Trade Practices and Consumer Protection), 49 New York University L. Rev. 1256 (1974).
- (6) Remedies (Kentucky Law Survey), 63 Kentucky L.J. 777 (1975).
- (7) Trademark Registration Under Sections 2(a) and 2(e) of the Lanham Act: The Deception Decision, 44 Fordham L. Rev. 249 (1975), reprinted in 66 Trademark Rep. 97 (1976).
- (8) Remedies (Kentucky Law Survey), 64 Kentucky L.J. 233 (1976).
- (9) Remedies (Kentucky Law Survey), 65 Kentucky L.J. 285 (1976).
- (10) Sears/Compco Revisited: May Products and Packages Be "Simulated" in the Late Seventies? 1978 American Patent L. Assn. Bull. 160.
- (11) Tort Liability of Trademark Licensors in an Era of "Accountability": A Tale of Three Cases, 69 Trademark Rep. 128 (1979).
- (12) Book Review (of E. Kitch & H. Perlman, Legal Regulation of the Competitive Process, 2d ed.), 33 Vanderbilt L. Rev. 259 (1980).
- (13) The Thirty-Fourth Year of Administration of the Lanham Trademark Act of 1946, 71 Trademark Rep. 285 (1981), reprinted as 2 U.S.T.A., 1981-82 Trademark Law Handbook (Clark Boardman Co. 1982).
- (14) Trademark Developments [in Court of Customs and Patent Appeals Cases], 92 Fed. Rules Dec. 245 (1982).

PUBLICATIONS BY KENNETH B. GERMAIN (cont.)

- (15) The Supreme Court's Decision in the Inwood Case: Declination of Duty, 70 Kentucky L.J. 731 (1982).
- (16) The Thirty-Fifth Year of Administration of the Lanham Trademark Act of 1946, 72 Trademark Rep. 559 (1982), reprinted as U.S.T.A., 1982-83 Trademark Law Handbook (Clark Boardman Co. 1983).
- (17) The Thirty-Sixth Year of Administration of the Lanham Trademark Act of 1946, 73 Trademark Rep. 577 (1983) (with Steven M. Weinberg), reprinted as U.S.T.A., 1983-84 Trademark Law Handbook (Clark Boardman Co. 1984).
- (18) Recent Developments in Trademark Law, 1984 American Intellectual Prop. L. Bull. 631.
- (19) The Thirty-Seventh Year of Administration of the Lanham Trademark Act of 1946, 74 Trademark Rep. 469 (1984) (with Steven M. Weinberg), reprinted as U.S.T.A., 1984-85 Trademark Law Handbook (Clark Boardman Co. 1985).
- (20) Book Review (of J. T. McCarthy, Trademarks and Unfair Competition, 2d ed.), 34 Catholic U. L. Rev. 595 (1985).
- (21) The U.S. Supreme Court's Treatment of Trade Designation Cases in the Last Ten Years: From "Declination" to "Duty", appearing as Chapter 2 of the Southwestern Legal Foundation 1986 Patent Law Annual (Matthew Bender 1986).
- (22) Recent Case Law Developments-Trademarks, 1989 American Intellectual Prop. L. Bull. 57.
- (23) The Chameleonic Character of Non-Incontestable Trademark Registrations, www.CorporateIntelligence.com/issues.cfm?Story=60&Author=Germain.
- (24) Lawyers Who Need Lawyers: When to Retain a Legal Expert in a Trademark/Unfair Competition Case, www.CorporateIntelligence.com/issues.cfm?Story=74&Author=Germain.

PROFESSIONAL LECTURES GIVEN BY KENNETH B. GERMAIN

- (1) "Expanding Scope of Section 43(a) of the Lanham Act," United States Trademark Association, 1977 Trademark Basics Forum (Reston, Virginia; October 5, 1977).
- (2) "Introduction: Infringement and Other Unfair Competition Related Causes of Action Including § 43(a) of the Lanham Act as a Basis for Action and Jurisdiction," American Bar Association National Institute on Trademark Litigation (San Francisco, California; March 9, 1978).
- (3) "Section 43(a) of the Lanham Act," Cincinnati Patent Law Association, Monthly Meeting (Cincinnati, Ohio; April 25, 1978).
- (4) "Sears/Compco Revisited" May Products and Packages be 'Simulated' in the Late Seventies?" American Patent Law Association, 1978 Spring Stated Meeting (Rochester, New York; May 4, 1978).
- (5) "Introduction to the Law Regarding Trademark Infringement, Unfair Competition, and Section 43(a) of the Lanham Act," American Bar Association, National Institute on Trademark Litigation (Atlanta, Georgia; March 8, 1979).
- (6) "Tort Liability of the Trademark Licensor: A Developing Trend in an Era of 'Accountability'," United States Trademark Association, 101st Annual Meeting (Palm Beach, Florida; May 18, 1979).
- (7) "Quick Course on the Principal Principles of Trademark Law," Kentucky Bar Association, Annual Convention (Lexington, Kentucky; May 25, 1979).
- (8) "Trademark Owners Beware: Licenses May Beget Liability," San Francisco Patent and Trademark Law Association, Monthly Meeting (San Francisco, California; November 1, 1979).
- (9) "Caveat Franchisor: You May be Held 'Accountable' For the Torts of Your Franchisee," American Bar Association, Forum Committee on Franchising, Second Annual Forum (San Francisco, California; November 2, 1979).
- (10) "Section 43(a) -- The 'Black Hole' of the Lanham Act: How Can It Help the Trademark Owner," Practising Law Institute, Current Developments in Trademark Law and Unfair Competition 1980 (New York, New York; July 10, 1980).
- (11) "Liability of Trademark Licensors for the Torts of Their Licensees: The 'Accountability Principle in Action,'" BNA Education Systems, Trademarks and Unfair Competition: Recent Trends in the Law (Washington, D.C.; October 21, 1980).

- (12) "Review of the 1980-81 Trademark Cases Decided by the United States Court of Customs and Patent Appeals," Eighth Judicial Conference of the United States Court of Customs and Patent Appeals (Washington, D.C.; April 10, 1981).
- (13) "Current Review of U.S. Developments in Trademark Law: The Good, The Bad and The Audacious," United States Trademark Association, 103rd Annual Meeting (San Francisco, California; May 13, 1981).
- (14) "Overview of the Substantive Principles of Trademark Law and Unfair Competition Before and During the Eighties: A Tripartite Analysis," BNA Education Systems, Trademark and Unfair Competition Litigation, Law and Practice (Hilton Head, South Carolina; June 29, 1981).
- (15) "Arbitration of Trademark Disputes as an Alternative to Litigation: An Introduction," BNA Education Systems, Trademark and Unfair Competition Law, Litigation and Practice (Hilton Head, South Carolina; July 3, 1981).
- (16) "Current Review of U.S. Developments in Trademark Law: Mixed Bag," United States Trademark Association, 104th Annual Meeting (New Orleans, Louisiana; May 8, 1982).
- (17) "Overview of the Substantive Principles of Trademark and Unfair Competition Law: A Tripartite Analysis," BNA Education Systems, U.S. Trademark and Unfair Competition Law and Practice (Montebello, Quebec, Canada; July 26, 1982).
- (18) "Trademark Law Basics," Fayette County Bar Association, Continuing Legal Education Program (Lexington, Kentucky; November 5, 1982).
- (19) "The Capsule-Color Cases," Cincinnati Patent Law Association (Cincinnati, Ohio; December 9, 1982).
- (20) "1982-83 U.S. Trademark Law Highlights: Mostly For the Good," United States Trademark Association, 105th Annual Meeting (Reno, Nevada; May 9, 1983).
- (21) "What Every Trade Secret Lawyer Should Know About Recent Trademark Cases," Bureau of National Affairs, Trade Secrets - Protecting Vital Corporate Information (Hilton Head, South Carolina; June 29, 1983).
- (22) "Recent Developments in Trademark and Unfair Competition Law," American Bar Association, Section of Patent, Trademark and Copyright Law, Annual Meeting (Atlanta, Georgia; August 2, 1983).
- (23) "The Section 2(a)(2)(e) 'Deception Decision' -- Revisited," United States Patent and Trademark Office Examining Operation, Trademark Lecture Series (Arlington, Virginia; October 21, 1983).

- (24) Testimony and Prepared Statement on S.1990 (leading to the Trademark Clarification Act of 1984, P.L. 98-204, 98 Stat. 3335), Subcommittee on Patents, Copyrights and Trademarks, Committee of the Judiciary, United States Senate, 98th Congress, 2d Session (February 1, 1984).
- (25) "Review of Current Developments in U.S. Trademark/Unfair Competition Law in the Courts of General Jurisdiction: Lots of Action," United States Trademark Association, 106th Annual Meeting (Toronto, Ontario, Canada; May 14, 1984).
- (26) "Overview of Developments in Trademark and Unfair Competition Law During the June 1982 - May 1984 Biennium: Much Movement," Bureau of National Affairs, Recent Developments in Trademark and Unfair Competition Law (Hilton Head, South Carolina; June 18, 1984).
- (27) "Highlights of 1983-84 Court Cases in the Areas of Trademark Law and Unfair Competition: Law on the Move," United States Patent and Trademark Office Examining Operation, Trademark Lecture Series (Arlington, Virginia; June 26, 1984).
- (28) "Recent Developments in Trademark law: 1984, A Year of Subtle Distinction(s)," American Intellectual Property Law Association, Annual Meeting (Washington, D.C.; October 26, 1984).
- (29) "1985 Domestic Trademark Law Cases: Hot and Heavy," Association of Corporate Patent Counsel, Mid-Winter Meeting (Tucson, Arizona; January 27, 1985).
- (30) "Judicial and Legislative Developments in Domestic Trademark Infringement and Registration Law," Los Angeles Patent Law Association, Spring Seminar (Santa Barbara, California; May 5, 1985).
- (31) "Obtaining and Maintaining Trademarks: Guidelines for the General Practitioner," Louisville Bar Foundation, Intellectual Property Seminar (Louisville, Kentucky; June 7, 1985).
- (32) "Overview of the Substantive Principles of Trademark and Unfair Competition Law: A Bipartite Analysis," Bureau of National Affairs, Trademark Law, Practice and Litigation (Amelia Island, Florida; June 24, 1985).
- (33) "Developments in Domestic Trademark Infringement Law - With Emphasis Upon Sixth Circuit/Ohio Law," Cincinnati Patent Law Assn./Cincinnati Bar Assn., Corporate Law Committee Joint Meeting (Cincinnati, Ohio; July 15, 1985).
- (34) "National Trends in Trademark Law Infringement Litigation in the Courts of General Jurisdiction," United States Patent and Trademark Office, Trademark Examining Operation (Arlington, Virginia; July 22, 1985).

- (35) "Recent Developments in Trademark Law Domestic Infringement and Registration Matters," Institute of Continuing Legal Education, Eleventh Annual Intellectual Property Law Workshop (Mackinac Island, Michigan; August 2, 1985).
- (36) "The Supreme Court's Handling of Trade Designation Cases, 1975-85: From 'Declination' to 'Duty,'" Dayton Patent Law Association (Dayton, Ohio; October 11, 1985).
- (37) "Trademark Incontestability According to the Supreme Court's Park 'N Fly Decision: Much Ado About Very Little?" Patent Law Association of Pittsburgh (Pittsburgh, Pennsylvania; November 20, 1985).
- (38) "Major Domestic Judicial and Legislative Trademark Law Developments During 1980-85, An Era of Consequence," American Bar Association., Patent, Trademark & Copyright Section, Changes in Intellectual Property Law in the Eighties (Arlington, Virginia; April 10, 1986).
- (39) "Recent Developments in Domestic Trademark Law -- With a Focus on Ninth Circuit Cases," Los Angeles Patent Law Association Spring Seminar (Palm Springs, California; May 17, 1986).
- (40) "The U.S. Supreme Court's Treatment of Trade Designation Cases in the Last Ten Years -- From 'Declination' to 'Duty,'" Southwest Legal Foundation, Twenty-Fourth Annual Institute on Patent Law (Dallas, Texas; June 5, 1986).
- (41) "Recent Developments in Domestic Trademark Infringement and Registration Law," Institute of Continuing Legal Education, Twelfth Annual Intellectual Property Law Workshop (Traverse City, Michigan; July 18, 1986).
- (42) "National Trends in Substantive Trademark Litigation in the Courts of General Jurisdiction," United States Patent and Trademark Office, Trademark Examining Operation, Trademark Law Update Program (Arlington, Virginia; August 21, 1986).
- (43) "Recent Case Law Developments: Trademark Registration Law and Trademark/Unfair Competition Infringement Litigation," Bureau of National Affairs, The Trademark Registration Process and Current Issues (Washington, D.C.; September 16, 1986).
- (44) "Trademark Infringement: Emphasis on Enforcement," American Corporate Counsel Association, Guiding the Corporation into the Future (Arlington, Virginia; November 14, 1986).
- (45) "Trademarks in the Modern Competitive Environment," United States Trademark Association, 109th Annual Meeting (Boston, Massachusetts; April 27, 1987).
- (46) "Trademarks: Policy, Registration, Infringement," Georgetown University Law Center/District of Columbia Bar, Continuing Legal Education Division, Mini-Course (Washington, D.C.; May 18, 1987).

- (47) "More (Still More?) Developments in Domestic Trademark Infringement and Registration Law," Institute of Continuing Legal Education, Thirteenth Annual Intellectual Property Law Workshop (Boyne Highlands, Michigan; July 24, 1987).
- (48) "National Trends in Domestic Trademark Law: Litigation in the Courts of General Jurisdiction, 1986-87," United States Patent and Trademark Office, Trademark Examining Operation, Fourth Annual Trademark Law Update Program (Arlington, Virginia; September 10, 1987).
- (49) "The General/Corporate Practitioner's Role Regarding Trademarks," University of Kentucky Continuing Legal Education "Fall Football Weekend Workshop" (Lexington, Kentucky; September 19, 1987).
- (50) "Trademark Litigation: Policy, Substance, Jurisdiction and Remedies," District of Columbia Bar/Georgetown University Law Center Continuing Legal Education, Litigating Trademark and Copyright Cases (Washington, D.C.; October 20, 1987).
- (51) "Litigation of Civil Actions Under the Trademark Counterfeiting Act of 1984," Bureau of National Affairs, Developments in Trademark Law (Washington, D.C.; February 19, 1988).
- (52) "Remedies for Infringement of Registered and Unregistered Trademarks -- Counterfeiting and Contempt Considered," American Bar Association, Section of Patent, Trademark and Copyright Law, Intellectual Property Law -- Agency, Licensing, Litigation and Corporate Practice (Arlington, Virginia; March 25, 1988).
- (53) "'Unfair Competition' Under Section 43 of the Trademark Law Revision Act of 1988: The Baby Has Come a Long Way - Not Maybe," Cincinnati Patent Law Association monthly meeting (Cincinnati, Ohio; June 24, 1988).
- (54) "1988 - The Year of the Act/Acronym: USTA TRC TLRA S1883 HR4156 VIS", Institute of Continuing Legal Education, Fourteenth Annual Intellectual Property Law Workshop (Mackinac Island, Michigan; July 29, 1988).
- (55) "Recent Developments in Federal Trademark Legislation -- The Trademark Law Revision Act of 1988: Caveat Congress?", United States Patent and Trademark Office, Trademark Examining Operation, Trademark Lecture Series (Arlington, Virginia; September 22, 1988).
- (56) "The New Trademark Act: Law and Lore", Dayton Patent Law Association (Dayton, Ohio; December 9, 1988).
- (57) "Trademark Infringement Cases: Why, What, How and For What?," Fourteenth Oregon Patent Law Association-Washington State Patent Law Association Joint Seminar (Glen Eden Beach, Oregon; February 24, 1989).

- (58) "Domestic Developments in Trademark Law: Of Caselaw and Congress," ABA Patent, Trademark and Copyright Law Section's Fourth Annual Spring Seminar on Intellectual Property Law (Arlington, Virginia; March 29, 1989).
- (59) "Judicial Developments in Domestic Trademark Law: Hitting The High Points," Cincinnati Bar Association/Cincinnati Patent Law Association, 1989 Intellectual Property Law Institute (Cincinnati, Ohio; May 12, 1989).
- (60) "Interesting Issues in Trademark Law Arising Before the Courts of General Jurisdiction and the Federal Circuit," Institute of Continuing Legal Education, Fifteenth Annual Intellectual Property Law Workshop (Traverse City, Michigan; July 21, 1989).
- (61) "The Lanham Act Revised - And Ready to Roll," Cleveland Patent Law Association, Intellectual Property Law Seminar (Akron, Ohio; September 23, 1989).
- (62) "Trademark Review - Bonito Boats, Too," American Intellectual Property Law Association, Annual Meeting (Arlington, Virginia; October 20, 1989).
- (63) "Sentimental Journey: Developments in Domestic Trademark Caselaw During the Almost-Over Eighties," U.S. Patent and Trademark Office, Trademark Examining Operation, Sixth Annual Trademark Law Update Program (Arlington, Virginia; October 26, 1989).
- (64) "Trademark Infringement and Unfair Competition: Exiting the Era of the Eighties," Cincinnati Intellectual Property Law Association (Cincinnati, Ohio; November 30, 1989).
- (65) "Judicial and Legislative Legacies of the Eighties Regarding Trademark and Unfair Competition Law," Philadelphia Patent Law Association (Philadelphia, Pennsylvania; February 15, 1990).
- (66) "Selected Domestic Appellate Cases on Trademark Law and Initial Developments Under the Reborn Trademark Act," ABA Patent, Trademark & Copyright Law Section's Fifth Annual Spring Seminar on Intellectual Property (Arlington, Virginia; April 4, 1990).
- (67) "Judicial Developments in Domestic Trademark and Unfair Competition Law: Lots of Action," All Ohio Annual Institute on Intellectual Property, (Cincinnati, Ohio, June 14, 1990; and Cleveland, Ohio, June 15, 1990).
- (68) "Dilution - A Dangerous Doctrine," Practising Law Institute, Current Developments in Trademark Law and Unfair Competition 1990 (New York, New York; June 22, 1990).
- (69) "Recent Developments in Trademark and Unfair Competition Law: The Meat's In The Miscellany," Sixteenth Annual Intellectual Property Law Workshop, Institute of Continuing Legal Education (Bellaire, Michigan; July 19, 1990).

- (70) "Antipasto of the Day: Current Developments in U.S. Trademark Law," U.S. Trademark Association, 1990 Paralegal Forum (Washington, D.C.; September 26, 1990).
- (71) "Analyses of Interesting Aspects of Domestic Appellate Decisions Involving Trademark Law," Cincinnati Intellectual Property Law Association (Cincinnati, Ohio; November 9, 1990) and Dayton Intellectual Property Law Association (Dayton, Ohio; November 13, 1990).
- (72) "That Was The Year That Was: 1990ish Domestic Appellate Court Decisions Involving Trademark Validity, Infringement, and Licensing Issues," U.S. Patent and Trademark Office, Trademark Examining Operation, Seventh Annual Trademark Law Update Program (Arlington, Virginia; January 10, 1991).
- (73) "Scratching The Surface Of Trademark Law," ALI-ABA Conference Entitled Trademarks, Copyrights, and Unfair Competition for the General Practitioner (Washington, D.C.; April 11, 1991).
- (74) "False Advertising Under Lanham Act § 43(a) - Then and Now," ALI-ABA Conference Entitled Trademarks, Copyrights, and Unfair Competition for the General Practitioner (Washington, D.C.; April 11, 1991).
- (75) "Federal Unfair Competition Under Lanham Act § 43(a) - The Way It Is, The Way It Was," San Francisco Patent and Trademark Law Association, Spring Seminar (Napa, California; May 4, 1991).
- (76) "Summary of Selected Domestic Appellate Trademark and Unfair Competition Cases, 1990-91: Infringement, Licensing and Registration Issues," Cincinnati Bar Association/Cincinnati Intellectual Property Law Association, 1991 Intellectual Property Law Institute (Cincinnati, Ohio; June 6, 1991).
- (77) "Annual Review of Selected Domestic Appellate Court Trademark and Unfair Competition Cases: Isn't It Grand?", Institute of Continuing Legal Education, Seventeenth Annual Intellectual Property Law Workshop (Mackinac Island, Michigan; August 2, 1991).
- (78) "Trademark Licensing - Recent Appellate Cases Concerning Tort Liability of Licensors and Other Aspects of the Licensing Relationship," Fourth Annual Symposium on Intellectual Property and the Corporate Client, Corporate Counsel Center of Northwestern University School of Law (Chicago, Illinois; October 8, 1991).
- (79) "Trademark and Unfair Competition Law According to American Appellate Courts Circa 1991," Annual Meeting, American Intellectual Property Law Association (Arlington, Virginia; October 19, 1991).
- (80) "1991 In Review: Trademarks - Unfair Competition, Too," U.S. Patent and Trademark Office, Eighth Annual Trademark Law Update Program (Arlington, Virginia; January 9, 1992).

- (81) "U.S. Trademark and Unfair Competition Law: The Most Recent Gospel According To The Appellate Courts," American Bar Association Section of Patent, Trademark and Copyright Law, Annual Spring CLE Program (Los Angeles, California; March 31, 1992).
- (82) "Taking Trademark Law From The Top," ALI-ABA Conference on Trademarks, Copyrights, and Unfair Competition for the General Practitioner (Washington, D.C.; April 9, 1992).
- (83) "Trademarks: Sixth Circuit Review, Intent-To-Use, Too," Ohio State Bar Association, Annual Convention, Seminar of the Intellectual Property Law Section (Columbus, Ohio; May 15, 1992).
- (84) "A General Overview of Trademark Matters," Northern Kentucky University College of Law CLE Conference on Overview Of Trademarks, Copyrights And Patents And Related Intellectual Property Matters For The General Attorney (Greater Cincinnati Airport; June 19, 1992).
- (85) "U.S. Appellate Trademark And Unfair Competition Case Law - Fifth Circuit Cases Boldly Briefed," State Bar of Texas, Annual Meeting (Corpus Christi, Texas; June 27, 1992).
- (86) "Trademarks For Traverse: Another Year's Highlights," Eighteenth Annual Intellectual Property Law Workshop sponsored by the Michigan Institute of Continuing Legal Education (Traverse City, Michigan; June 17, 1992).
- (87) "Hot Spots of U.S. Appellate Court Trademark Infringement and Registration Cases: Pig Sandwiches, Kings of Beaches, Mexican Motifs - and More," All Ohio Annual Institute On Intellectual Property program (Cleveland, Ohio, September 24, 1992; and Cincinnati, Ohio, September 25, 1992).
- (88) "Domestic Appellate Court Trademark Infringement Case Law: What's New In '92," U.S. Patent and Trademark Office's Ninth Annual Trademark Law Update Program (Arlington, Virginia; October 13, 1992).
- (89) "Current And Emerging Issues In U.S. Trademark And Unfair Competition Law," Intellectual Property-Trade-Marks Law Seminar sponsored by the National Judicial Institute (Montebello, Quebec, Canada; November 20, 1992).
- (90) "Can Trade Dress Be 'Inherently Distinctive'? Sí, Señor!," Cincinnati Intellectual Property Law Association's monthly meeting (Cincinnati, Ohio; February 10, 1993).
- (91) "Nuts & Bolts of Trademark Law," Cincinnati Bar Association's YLS NO Brown Bag Seminar Series program (Cincinnati, Ohio; February 17, 1993).

- (92) "Protection of Trademarks 'Beyond Confusion' - Dilution, Disparagement & Parody," Trademarks, Copyrights and Unfair Competition For the General Practitioner, sponsored by ALI-ABA (Arlington, Virginia; April 15, 1993).
- (93) "The Extra-Confusion Actions: Dilution, Disparagement & Parody," Patents, Trademarks, Copyrights and Other Intellectual Property Law Matters, sponsored by the Northern Kentucky Bar Association (Fort Mitchell, Kentucky; June 4, 1993).
- (94) "Mid-'93 Report on Domestic Appellate Court Trademark Infringement Case Law," 19th Annual Intellectual Property Law Workshop, sponsored by the Michigan Institute of Continuing Legal Education (Mackinac Island, Michigan; July 9, 1993).
- (95) "Multifarious Issues in Recent Domestic Appellate Court Cases on Trademarks and Unfair Competition," 1993 All Ohio Annual Institute On Intellectual Property (Cleveland, Ohio, September 20, 1993; and Cincinnati, Ohio, September 21, 1993).
- (96) "1993 In Review - Domestic Appellate Court Cases On Trademark Infringement And Unfair Competition," U.S. Patent and Trademark Office's Tenth Annual Trademark Law Update Program (Arlington, Virginia; December 7, 1993).
- (97) "Inside Advice From Outside Counsel About Trademark Policies and Policing," American Corporate Counsel Association, Southwest Ohio Chapter, Monthly Meeting (Cincinnati, Ohio; May 26, 1994).
- (98) "Can - And Should - 'Color Per Se' Be Eligible For Registration and Protection: An Attempt To Color Coordinate The Symbolic Significance Of A Single Color," Cincinnati Intellectual Property Law Association, Monthly Meeting (Cincinnati, Ohio; June 15, 1994).
- (99) "Interesting Issues For ICLE: Domestic Appellate Court Trademark Infringement, Unfair Competition, And Registration Cases," 20th Annual Intellectual Property Law Workshop, Michigan Institute of Continuing Legal Education (Bellaire, Michigan; July 22, 1994).
- (100) "Another Year's Crop Of Domestic Appellate Court Cases On Trademarks And Unfair Competition," 1994 All Ohio Annual Institute On Intellectual Property (Cleveland, Ohio, September 22, 1994; and Cincinnati, Ohio, September 23, 1994).
- (101) "Beyond Confusion" In Three Acts -- Dilution, Disparagement, Parody," Trademarks, Copyrights and Unfair Competition For the General Practitioner, sponsored by ALI-ABA, (Arlington, Virginia; April 4, 1995).
- (102) "Look Out, Licensors - Likely Liability For Licensees' Louse-Ups," 117th Annual Meeting of the International Trademark Association entitled Avoiding Liability: Trademark and Advertising Issues (Orlando, Florida; May 2, 1995).
- (103) "The Supreme Court's Opinion in *Qualitex*: Quality Without Quantity," Cincinnati Intellectual Property Law Association (Cincinnati, Ohio; May 25, 1995).

- (104) "Pressing Problems Pertaining To Trademarks And Unfair Competition: Color Per Se; Product Configurations; Dilution/Disparagement/Parody," 21st Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education (ICLE) (Mackinac Island, Michigan; July 14, 1995).
- (105) "Does Post-*Two Pesos* Protection Against Product Configuration Simulation Amount To A Poor Man's Patent?" Patent Prosecution and Litigation Seminar, National Council of Intellectual Property Law Associations (Akron, Ohio; July 21, 1995).
- (106) "Trademarks/Unfair Competition: *Three To Get Ready* (Color, Configuration, Dilution) *And One To Round It Out* (Miscellany)," 1995 All Ohio Annual Institute On Intellectual Property (Cleveland, Ohio, September 14, 1995; and Cincinnati, Ohio, September 15, 1995).
- (107) "An Unhurried Look At The Protectability/Preemption Of "Trade Dress," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; October 27, 1995).
- (108) "Trademarks/Unfair Competition: The Current Year In Review," 1995 Meeting of the American Intellectual Property Law Association (Washington, D.C.; October 28, 1995).
- (109) "Trademarks: What They Are, And How They Can Be Registered," Cincinnati Paralegal Association (Cincinnati, Ohio; November 8, 1995).
- (110) "Protectability/Preemption of 'Trade Dress' -- Patent Problems Predominate," Columbus Intellectual Property Law Association (Columbus, Ohio; March 21, 1996).
- (111) "Trade Dress As Trademark: What Are The Rules?" Trademarks, Copyrights, and Unfair Competition for the General Practitioner, sponsored by ALI-ABA (Chicago, Illinois; April 19, 1996).
- (112) "Patent Preemption Of Product Simulation: Provocative But Practical," Indiana State Bar Association, Intellectual Property Section (Indianapolis, Indiana; April 20, 1996).
- (113) "Protectability/Preemption Of Trade Dress: A Tricky Topic For The Tri-Cities," Dayton Intellectual Property Law Association, Tri-Cities Meeting (Dayton, Ohio; April 25, 1996).
- (114) "Patent Law And Trademark Law At A Crossroads Called 'Trade Dress': Which Has The Right Of Way?" Association of Corporate Patent Counsel (Hot Springs, Virginia; June 19, 1996).

- (115) "Titleless In Traverse," 22nd Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education (ICLE) (Traverse City, Michigan; July 19, 1996).
- (116) "Domestic Appellate Trademark And Unfair Competition Cases: AOAIOIP, AOAIOIP And Away," 6th All Ohio Annual Institute On Intellectual Property, sponsored by the Cincinnati Bar Association and a Consortium of Intellectual Property Law Associations (Cincinnati, Ohio, September 19, 1996; and Akron, Ohio, September 20, 1996).
- (117) "Does Modern Trade Dress Protection Cause A Constitutional Conflict Between The Copyright-Patent Clause And The Commerce Clause?" Faculty Colloquium given at the University of Kentucky College of Law (Lexington, Kentucky; October 18, 1996).
- (118) "U.S. Appellate Court Decisions On Infringement Issues Involving Trademark And Unfair Competition Law," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; October 25, 1996).
- (119) "Recent Developments In The Law Of Trademarks And Unfair Competition," 1996 Annual Meeting of the American Intellectual Property Law Association (Washington, D.C.; October 26, 1996).
- (120) "Summaries Of Selected Domestic Appellate Trademark And Unfair Competition Cases," 34th Annual Institute on Patent Law (Dallas, Texas; November 21-22, 1996).
- (121) "Modern Trade Dress Protection," Columbus Bar Association's Intellectual Property Seminar (Columbus, Ohio; December 9, 1996).
- (122) "Trade Dress Protection - Past, Present and Future," Seventh Annual Trademark, Copyrights, and Unfair Competition for the General Practitioner, sponsored by ALI-ABA, (Washington, D.C.; April 11, 1997).
- (123) "Anatomy of a Reverse Confusion Case," Cincinnati Intellectual Property Law Association, Monthly Meeting (Cincinnati, Ohio; May 28, 1997).
- (124) "Selected Domestic Appellate Cases On Trademarks And Unfair Competition: Que Buena!" 23rd Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education (ICLE) (Mackinac Island, Michigan; August 1, 1997).
- (125) "Trademarks, Trade Dress, Etc.: Domestic Appellate Caselaw, 1996-97," 7th All Ohio Annual Institute On Intellectual Property, sponsored by the Cincinnati Bar Association and a Consortium of Intellectual Property Law Associations (Cincinnati, Ohio, September 11, 1997; and Akron, Ohio, September 12, 1997).

- (126) "Recent Trademark Decisions," Practising Law Institute, Third Annual Institute for Intellectual Property Law (New York, New York; September 23, 1997).
- (127) "U.S. Appellate Court Decisions on Issues Involving Trademarks, Trade Dress and Unfair Competition," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; October 16, 1997).
- (128) "Trademark, Trade Dress and Unfair Competition: Recent Developments and 100 Years of Change," 1997 Annual Meeting of the American Intellectual Property Law Association (Arlington, Virginia; October 18, 1997).
- (129) "Priming and Preparing Patent Practitioners to Avoid Precarious Pitfalls Pertaining to Product Configuration Protection Posing as 'Trade Dress'," 1998 Washington State/Oregon Patent Law Associations Joint Meeting (Welches, Oregon; April 17, 1998).
- (130) "Trademark Fundamentals For The General Practitioner," 1998 ALI-ABA Seminar entitled "Trademarks, Copyrights, and Unfair Competition For The General Practitioner" (Arlington, Virginia; April 23, 1998).
- (131) "Recent Developments In Trademark Law," ABA Annual Meeting (Williamsburg, Virginia; June 24-28, 1998).
- (132) "Selected Federal Appellate Court Cases on Trademark, Trade Dress and False Advertising Law," ICLE Intellectual Property Law Workshop (Mackinac Island, Michigan; July 23-25, 1998).
- (133) "Recent Developments in Trademark and Unfair Competition Law," 8th All Ohio Annual Institute On Intellectual Property, sponsored by the Cincinnati Bar Association and a Consortium of Intellectual Property Law Associations (Cleveland, Ohio, October 8, 1998; and Cincinnati, Ohio, October 9, 1998).
- (134) "Carefully Chosen Federal Appellate Court Cases on Trademark and Trade Dress Infringement Law," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; January 26, 1999).
- (135) "Trademark and Trade Dress Basics for the General Practitioner," Lorman Seminar: "Understanding Basic Trademark Law Principles" (Cincinnati, Ohio; February 10, 1999).
- (136) "Resolved: That U.S. Trademark Law Sometimes is Trumped By Patent and Copyright Law in Regard to Product Configuration Trade Dress," International Trademark Association Advanced Symposium: "Evolution and Revolution in Trademark Law" (New York, New York; March 4-5, 1999).
- (137) "Dilution Doctrine and Decisions -- Then and Now", Annual "Tri-Cities" Meeting of the Dayton, Cincinnati and Columbus Intellectual Property Law Associations (Dayton, Ohio; April 20, 1999).

- (138) "Trademark Law Fundamentals – For GPs and Corporate Counsel", ALI-ABA Seminar: "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Philadelphia, Pennsylvania; April 29, 1999).
- (139) "1998-99 Federal Appellate Court Cases on Trademark and Trade Dress Infringement Law," 25th Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education [ICLE] (Traverse City, Michigan; July 23, 1999).
- (140) "This Year's Notable Federal Appellate Court Cases On Trademark/Trade Dress Infringement and False Advertising Law," 9th All Ohio Annual Institute On Intellectual Property, sponsored by the Cincinnati Bar Association and a consortium of Intellectual Property Law Associations (Cleveland, Ohio, September 30, 1999; and Cincinnati, Ohio, October 1, 1999).
- (141) "The Erosion/Explosion of the *Sears-Compco/Bonito Boats* Doctrine – The Avant Gospel According to the Federal Circuit Court," PLI's Fifth Annual Institute for Intellectual Property Law (New York, New York; October 7, 1999).
- (142) "Trademark Law Update – At the End of An Era," 24th Annual Intellectual Property Institute, sponsored by the Intellectual Property Section of the State Bar of California (Santa Monica, California; November 12, 1999).
- (143) "Comments on Design Protection under the Patent and Trademark Acts," Northern Kentucky Law Review, "Intellectual Property Law 2000 Symposium: Issues in the New Millennium" (Covington, Kentucky; February 5, 2000).
- (144) "The Last Year of the Millennium as Seen in Selected Federal Appellate Court Cases on Trademark and Trade Dress Infringement Law," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; February 17, 2000).
- (145) "Trademark/Trade Dress Basics – for GPs and Corporate Counsel," ALI-ABA seminar "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Arlington, Virginia; April 6, 2000).
- (146) "Something Old, Something New: The Emerging Millennium as seen in Selected Federal Appellate Court Cases on Trademark and Trade Dress Infringement Law," 26th Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education [ICLE] (Mackinac Island, Michigan; July 21, 2000).
- (147) "Selected Federal Appellate Court Cases on Trademark/Trade Dress Law: All That *Non-Graeme*, *Non-Jane*, *Non-Alan*, *Non-Jeff* Jazz," 10th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, Ohio, September 21, 2000; and Cincinnati, Ohio, September 22, 2000).

- (148) "Trade Dress in the Modern Millennium: Will the *Wal-Mart* Court Be Up to the *Marketing Displays* Task?," Trademark Examining Operation, U.S. Patent and Trademark Office (Arlington, Virginia; October 19, 2000).
- (149) "The Supreme Court's Year 2000 Trade Dress Docket," Wisconsin Intellectual Property Law Association (Milwaukee, Wisconsin; November 8, 2000).
- (150) "Recent Developments in Trademark Law and Trade Dress Law: Strategies for Success," National Intellectual Property Law Seminar, sponsored by Barristers Educational Services (New Orleans, LA; December 8, 2000).
- (151) "*TrafFix* at the Intersection of Trade Dress and Patents: Is Functionality the Only Stop Light?," "Nimmer, Napster and Intellectual Property Lawyers" program at the Retreat/Seminar of and for the Judges of the U.S. District Court for the Central District of California (Ojai, California; February 2, 2001).
- (152) "2000: The First Year(?) of the New Millennium as Seen in Selected Federal Appellate Court Cases on Trademark and Trade Dress Infringement," U.S. Patent and Trademark Office's Annual Trademark Law Update Program (Arlington, Virginia; February 15, 2001).
- (153) "Tenets of Trademark/Trade Dress Law -- For GPs and Corporate Counsel," ALI-ABA Seminar - "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Scottsdale, Arizona; March 22, 2001).
- (154) "*Postscript To A Panel: With TrafFix At the Intersection Of Trade Dress And Patents, Can Functionality Be The Only Stop Light?*," 2001 Annual Meeting of the San Francisco Intellectual Property Law Association (Aptos, California; April 29, 2001).
- (155) "Selected Federal Appellate Court Cases on Trademark and Trade Dress Infringement: Presumptions in Peril, Dilution in Disarray, Trade Dress in *TrafFix*," 27th Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education [ICLE] (Mackinac Island, Michigan; July 13, 2001).
- (156) "The Law of Trademark in Today's Business World," University of Kentucky College of Law, Office of Continuing Legal Education seminar entitled "Trade Secrets, Non-Competes and Unfair Competition," (Lexington, Kentucky; October 12, 2001).
- (157) "Recent Developments in Trademark and Trade Dress Law: Selected Federal Appellate Court Cases," 11th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, Ohio, October 30, 2001; and Cincinnati, Ohio, October 31, 2001).
- (158) "Recent Developments in Trademark Infringement Law: A Collection of Federal Appellate Court Cases," PLI's Seventh Annual Institute for Intellectual Property Law (San Francisco, California; November 15, 2001).

- (159) "Selected Federal Appellate Court Cases on Trademark and Trade Dress Law," South Bay Trademark Association (Palo Alto, California; November 16, 2001).
- (160) "The Use of Legal Experts in Trademark/Unfair Competition Litigation: To Try Or Not To Try," ALI-ABA Seminar Entitled "Litigating, Trademark, Trade Dress, and Unfair Competition Cases" (Orlando, Florida; January 3, 2002).
- (161) "Fundamentals of Trademark Law and Litigation – For GPs and Corporate Counsel," ALI-ABA Seminar Entitled "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Washington, D.C.; April 18, 2002).
- (162) "Tort Liability of Trademark Licensors: From 'Accountability' to 'Accountancy' – and Touching on Trustmarks," ALI-ABA Seminar Entitled "Intellectual Property Licensing in Today's E-economy" (Boston, Massachusetts; May 31, 2002).
- (163) "Trademark Licensors' Liability for Their Licensees' Torts: From 'Accountability' to 'Accountancy' – and Touching On Trustmarks," Seminar by BAMSL, Bar Association of Metropolitan St. Louis (St. Louis, Missouri; July 18, 2002).
- (164) "Intriguing Issues of Trademark and Trade Dress Law in Selected Federal Appellate Court Cases," 28th Annual Intellectual Property Law Workshop, sponsored by the Institute of Continuing Legal Education ("ICLE") (Bellaire, Michigan; July 26, 2002).
- (165) "Select Federal Appellate Court Cases on Trademarks/Trade Dress: Registration, Infringement, Remedies, and Insurance Coverage Included," 12th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, Ohio, September 26, 2002; and Cincinnati, Ohio, September 27, 2002).
- (166) "Does the Supreme Court's *TrafFix* Case Knock Out Product Design Trade Dress Protection?" 2002 Leadership Meeting of the International Trademark Association [INTA] (Scottsdale, Arizona; November 15, 2002).
- (167) "Trademark Case Law Update: A Potpourri," 40th Annual Program on Intellectual Property Law, sponsored by The Institute for Law and Technology of The Center for American and International Law (Dallas, Texas; November 18, 2002).
- (168) "Guess What? Fair Use Isn't, Disparagement Is, and Parody Might Be Trademark Infringement," ALI-ABA Seminar Entitled "Litigating Trademark Domain Name, and Unfair Competition Cases" (Washington, D.C.; December 5, 2002).
- (169) "Domestic Appellate Court Decisions on Trademark Law: What's New in '01-'02?," 26th Mid-Winter Institute of the American Intellectual Property Law Association (Marco Island, FL; January 22, 2003).

- (170) "Fundamentals of Trademark Law and Litigation – for GPs and Corporate Counsel," ALI-ABA Seminar Entitled "Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel" (Philadelphia, PA; April 10, 2003).
- (171) "An Insider's View of *Victoria's Secret*," Philadelphia Bar Association, Intellectual Property Committee (Philadelphia, PA; April 10, 2003).
- (172) "Can Functionality Keep Product Design Trade Dress Away From a Collision Course With the U.S. Constitution?" 125th Annual Meeting of the International Trademark Association [INTA] (Amsterdam, Netherlands; May 7, 2003).
- (173) "Basic Principles of U.S. Trademark Law – Theory, Registration, Infringement and Dilution," U.S. Business Club of the Chamber of Commerce of Kortrijk (Kortrijk, Belgium; May 8, 2003).
- (174) "Browse At the Big Top . . . Linger in the Lingerie Shop . . ." State Bar of Texas Annual Meeting, I.P. Section (Houston, Texas; June 13, 2003).
- (175) "Domestic Trademark/Trade Dress Appellate Cases, Limited Edition: San Diego *Sans* Supremes," American Bar Association's 10th Annual IPL Conference (San Diego, CA; June 21, 2003).
- (176) "The Supreme Court Speaks Out on Dilution – And the Circuit Courts Comment on Other Issues," Institute for Continuing Legal Education (Mackinac Island, MI; July 18, 2003).
- (177) "*Victoria's Secret*: Anatomy of a Dilution Case . . . Post-Mortem, Too," Intellectual Property Owners [IPO] Annual Meeting (Chicago, IL; September 16, 2003).
- (178) "The Supreme Court Dispenses a Double Dose of Trademark/Unfair Competition Decisions – And the Circuit Courts Dole Out Lots More," 13th All Ohio Annual Institute On Intellectual Property [AOAIOIP], primarily sponsored by the Cincinnati Bar Association (Cleveland, OH, September 18, 2003; and Cincinnati, OH, September 19, 2003).
- (179) "Today's Trade Dress Test: Product Design Patent Protection Per the 'Progress Clause'," Joint Conference of the Oregon Patent Law Association and the Washington State Patent Law Association (Gleneden Beach, OR; September 20, 2003).
- (180) "The 'Progress Clause' Provides for Product Design Patent Protection – But Only Partially," Patent and Trademark Office Day seminar sponsored by Intellectual Property Owners (Washington, D.C.; December 8, 2003).
- (181) "*Victoria's Secret* Changes the Rules – Or Does It?" Trademark Dilution After *Victoria's Secret* seminar sponsored by ALI-ABA (Washington, D.C.; February 5, 2004).

- (182) "The Effects of Patents and the 'Progress Clause' on Trade Dress Protection," Dayton Intellectual Property Law Association (Dayton, OH; March 12, 2004).
- (183) "Feeling for the Foul Line: Fair Use Is Fair, Disparagement is Foul, Parody Hugs the Line," Litigating Trademark, Domain Name, and Unfair Competition Cases seminar sponsored by ALI-ABA (Chicago, IL; April 22, 2004).
- (184) "Non-Traditional Marks of the Product Design Variety: Distinctiveness, Functionality, and Preemption," 126th Annual Meeting of the International Trademark Association [INTA] (Atlanta, GA; May 3, 2004).
- (185) "Patents, Progress (Clause) and Protection (Trade Dress)," Toledo Patent Law Association (Toledo, OH; May 11, 2004).
- (186) Testimony and Prepared Statement on S.2002 and S. 2373 (effects of Section 211 of the Omnibus Appropriations Act of 1998), Committee on the Judiciary, United States Senate, 108th Congress, 1st Session (July 13, 2004).
- (187) "A Year's Worth of U.S. Appellate Court Decisions on Trademarks, Trade Dress and Unfair Competition," 14th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, OH, September 9, 2004; and Cincinnati, OH, September 10, 2004).
- (188) "Play-By-Play of the Trademark Law Game, the Whole 100 Yards," Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel seminar sponsored by ALI-ABA (Washington, D.C.; October 14, 2004).
- (189) "Recent Domestic Appellate Court Decisions on Trademark Registration, Validity, Infringement, Dilution, Trade Dress, False Advertising, Monetary Remedies, and Other Issues," Trademark Examining Operation and the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office (Arlington, VA; October 14, 2004).
- (190) "The Liabilities Associated With Owning Trademarks: The Protections That Liability Insurance May Provide," Creative Strategies for Building, Maintaining and Protecting Your Trademark Assets sponsored by Thompson Hine LLP (Cleveland, OH, April 20, 2005; and Cincinnati, OH, April 22, 2005).
- (191) "The Interface and Conflict Between Utility Patents, Design Patents and Copyrights, On the One Hand, and Trademark/Trade Dress Rights, on the Other Hand," Advanced Seminar on Trademark Law sponsored by Practising Law Institute (New York, NY; June 30, 2005).

- (192) "Annual Review of U.S. Appellate Court Decisions On Trademarks, Trade Dress and Unfair Competition: From Fair Use to Everything Else," 15th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, OH, September 22, 2005; and Cincinnati, OH, September 23, 2005).
- (193) "Here We Go Again – Trademark Law 101 and 102," Trademarks, Copyrights, and Unfair Competition for the General Practitioner and the Corporate Counsel seminar, sponsored by ALI-ABA (San Antonio, TX; April 27, 2006).
- (194) "Annual Review of American Appellate Court Decisions on Trademarks, Trade Dress and Unfair Competition," 16th All Ohio Annual Institute On Intellectual Property [AOAIOIP], sponsored by the Cincinnati Bar Association and a consortium of intellectual property law associations (Cleveland, OH, September 14, 2006; and Cincinnati, OH, September 15, 2006).
- (195) "Non-Traditional Trademark Claims: Can the Same Rules Apply?" Litigating Trademark, Domain Name and Unfair Competition Cases seminar, sponsored by ALI-ABA (Boston, MA; October 19, 2006).
- (196) "Trademark Dilution – Viewed Historically, Philosophically and Practically – Both Before and After '*Victoria's Secret*'," Litigating Trademark, Domain Name and Unfair Competition Cases seminar, sponsored by ALI-ABA (Boston, MA; October 19, 2006).
- (197) "Sixth Circuit Trademark Law: What's New Since 2002?" Michigan Intellectual Property Law Association (Troy, MI; December 5, 2006).

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EXHIBIT 2

CASES IN WHICH KENNETH B. GERMAIN TESTIFIED IN COURT AS AN EXPERT WITNESS ON TRADEMARK/UNFAIR COMPETITION LAW: 2003-2006

<u>Law Firm (City)</u>	<u>Case Involved</u>
Santangelo Law Firm (Ft. Collins, CO)	<u>Vail Resorts, Inc. v. Vend-Tel-Co. Ltd.</u> (D. Colo.; No. 01-M-1172)
Baker & Hostetler (Columbus, OH)	<u>Restaurant Advertising Group, Inc. v. J.P. Morgan Chase</u> (S.D. Ohio; No. C2 04 1020)
McDermott Will & Emery (Los Angeles, CA)	<u>Magic Kitchen LLC, et al. v. Good Things Int'l Ltd.</u> (Calif. Super. Ct.; No. BC 288124)

CASES IN WHICH KENNETH B. GERMAIN WAS DEPOSED (BUT DID NOT TESTIFY IN COURT) AS AN EXPERT WITNESS ON TRADEMARK/UNFAIR COMPETITION LAW: 2003-2006

<u>Law Firm (City)</u>	<u>Case Involved</u>
Maginot Moore & Bowman (Indianapolis, IN)	<u>Eco Manufacturing LLC v. Honeywell International, Inc.</u> (S.D. Ind.; No. 1:03-CV-0170 DFH-TAB)
Frost Brown Todd LLC (Cincinnati, OH)	<u>Phillips Products Co., LLC v. R.H. Phillips, Inc.</u> (D. Minn., No. 02-CV-650 MJD/JGL)
Oreck, Bradley, Crighton, Adams & Chase (New Orleans, LA)	<u>The Hoover Company v. Oreck Holdings, LLC</u> (N.D. Oh.; No. 5:02CV 548)
Arent Fox PLLC (Washington, DC)	<u>United Industries Corp. v. Dow Agrosciences, LLC</u> (Missouri Circuit Ct.; Cause No. 012-8393)
Morris Manning & Martin, LLP (Atlanta, GA)	<u>Integreon Managed Solutions, Inc. v. Integreo, Inc.</u> (C.D. Ca.; Case No. CV05-4795 JRW(RCx))
Frank, Haron, Weiner and Navarro (Troy, MI)	<u>Price, Heneveld, Cooper, Dewitt & Litton v. Annuity Investors Life Ins. Co. (W.D. Mi.)</u>
Drinker Biddle & Reath, LLP (Philadelphia, PA)	<u>Celgene Corporation v. Centocor, Inc.</u> (E.D. Pa.; Case No. 03-cv-5978-RB)

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EXHIBIT 3

1. Complaint for Declaratory Judgment in *American Italian Pasta Co. v. New World Pasta Co.*, 4:02-cv-00594-SOW (W.D. Mo.) (6/18/02)
2. Notice of Opposition (7/22/04); Answer to Notice of Opposition (9/28/04)
3. Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding (3/3/05)
4. Opposer's Notices of Reliance Under Rule 2.122(c) (with exhibits)
 - a. Re Opposer's Exhibits 115-218
 - b. Re Opposer's Exhibits 219-23
 - c. Re Opposer's Exhibits 224-25
 - d. Re Opposer's Exhibits 226-27
5. Declarations:
 - a. T.S. Webster (3/3/06), including his Declaration in the New World case (11/13/02)
 - b. A. Willoughby (3/6/06), including her Report, with exhibits, in the New World case (2/21/03)
 - c. D. Lericos (3/3/06), with some exhibits
6. Depositions:
 - a. T.S. Webster (11/9/06), with exhibits and related procedural documents
 - b. A. Willoughby (11/3/06)
 - c. A.J. Lericos (11/3/06)
7. Reports:
 - a. AIPC Brand Health Tracking Study (Wave I), produced by Synovate (3/04)
 - b. Name Protect Trademark Investigation Report (11/28/06)

8. U.S. PTO Records:
 - a. File History on U.S. Trademark Appl. Ser. No. 78/136,703
 - b. Miscellaneous files obtained from www.uspto.gov
9. Miscellaneous photocopied photographs of Opposer's MUELLER'S pasta packages
10. Printouts from www.aipc.com (12/12/06)
11. Schedule 2.1(a) [starting with page 5, and tab B] to "Asset Purchase Agreement."
12. Joie Warner's book, "Spaghetti . . . america's favorite pasta" (1st ed. 1994), with dust jacket

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA COMPANY)	
)	
Opposer,)	
)	Opposition No. 91161373
v.)	
)	Mark: BARILLA - AMERICA'S
)	FAVORITE PASTA
BARILLA G.E.R. - Fratelli S.P.A.)	
)	Application No. 78/136,703
Registrant.)	
)	Published: March 23, 2004

DECLARATION OF ANN WILLOUGHBY

I, Ann Willoughby, declare:

1. I made a Report of Ann Willoughby on February 21, 2003 and a copy of that Report with the attachments is appended to this Declaration as Exhibit A. I hereby adopt Exhibit A as a part of this declaration submitted in the above-captioned proceedings. My background and experience are substantially detailed in paragraphs 1 through 7 of that report, updated as set forth in the Biography attached as Exhibit B, and I remain the President and CEO of Willoughby Design Group.
2. I have been asked by American Italian Pasta Company to provide this Declaration in support of its Opposition to Barilla's Motion for Summary Judgment in order to introduce Exhibit A and to provide further amplification of the statements made therein.
3. In addition to the work mentioned in my report, I have also reviewed a sample of a recently revised Mueller's pasta box, of which a photo is appended as Exhibit B. In adopting my prior Report appended as Exhibit A, I want to further address in

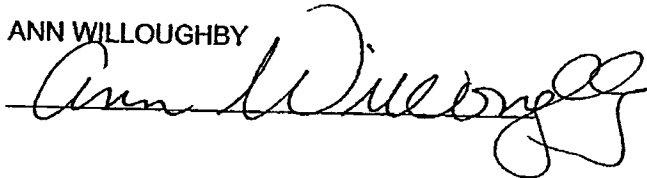
particular two of the conclusions and observations in paragraph 22 of my report.

4. First, It remains my opinion that "AIPC's use of the term "America's Favorite Pasta" on Mueller's packaging is puffery and has no impact on the purchasing decision of the consumer other than brand recognition." This said, I believe that consumers of food products in general and pasta in particular can regard a term or phrase as puffery and still associate and identify that term or phrase as a branding statement, either alone or in connection with a mark. For example, a well-known phrase in the greeting card field would be "When you care enough to send the very best." That statement is in large part puffery, suggesting to the consumer that one greeting card (in this case, Hallmark), has the "very best" cards. Nonetheless, while the consumer may give little weight to the factuality of the phrase, recognizing it as mere puffery, the consumer also draws a connection between that phrase and Hallmark, and regards it as proprietary. Midwest air – the best care in the air, UMB, America's Strongest Banks, BMW – the ultimate driving machine. Other examples of phrases which may be puffery but serve a branding function include the use of "The Best Care in the Air" by Midwest Airlines, "America's Strongest Banks" by UMB, and "The Ultimate Driving Machine" by BMW, as well as others mentioned in paragraph 20 of my report. It is my opinion that the presentation of the phrase "America's Favorite Pasta" on the Mueller's packaging (which is again evolving since my report but still retains the phrase "America's Favorite Pasta" on the front of the package), while not influencing the consumer in regard to a factual determination about the product, does associate it with the Mueller's name and that phrase does, in fact, serve as a brand identifier.

5. In the last bullet point of paragraph 22 of my report attached as Exhibit A, I also reached the conclusion that "(a)ll of these trade dress features, including the phrase 'America's Favorite Pasta,' serve as a trademark function and help consumers recognize the Mueller's brand." This reflects that a number of constituent elements may serve, either individually or collectively, to provide a brand identity. The consumer seeing the Mueller's packaging on the supermarket shelf may draw upon the different elements to identify the brand. I am of the opinion that like the Mueller's name and the red, white and blue packaging, the phrase "America's Favorite Pasta" performs a trademark function for American Italian Pasta Company. The fact that the phrase is puffery does not diminish its connection to the Mueller's brand.

The undersigned, Ann Willoughby, declares that all statements made herein are true; that all statements made herein of his own knowledge are true and that all statements made on information and believe are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the document.

ANN WILLOUGHBY



Date: Mar. 6, 2006

American Italian Pasta Company
v.
New World Pasta Company

REPORT OF ANN WILLOUGHBY

February 21, 2003



1. I am a brand designer and the owner and founder of Willoughby Design Group. My firm specializes in brand and communications design for corporate, institutional and retail manufacturers of branded and packaged goods. I have over 30 years experience as a professional designer and brand consultant. I have authored an article entitled "the Design Capital of America," which appeared in Ingram's Magazine November 2002 edition. A copy is attached.
2. I have been retained by Hovey Williams, LLP on behalf of American Italian Pasta Company to review the written submissions to the court, including the complaint, the answer and counterclaim, the motions and responses, and the exhibits thereto, the dried pasta sections of markets, including displays of the Mueller's dry pasta products, the use of advertising slogans on packaging for consumer products or advertising of such slogans, any other materials necessary to conduct a study, and preparation of a report setting forth my finding and opinions in the case of AIPC v. New World Pasta now pending in the United States District Court for the Western District of Missouri, Western Division.
3. I am currently President and CEO of Willoughby Design Group located in Kansas City, Missouri. We have a staff of 18. We provide strategic services and brand identity design, positioning, naming, and design for brand communications, environments, packaged goods and services. Our clients include Hallmark Cards, Lee Jeans, Interstate Brands Corporation (Wonder Bread, Butternut, Hostess and Dolly Madison), The Kauffman Foundation, Playtex and Best Choice.
4. Willoughby Design Group has developed packaging and brand identity design for Max Factor, Oil of Olay, Camay, Weight Watchers, Pampers, Hills Science Diet, and Black and Decker, among others.
5. I provide advice to companies on brand and trademark issues and occasionally I have consulted with law firms on issues involving brand, trademark and trade dress.
6. In June 1994, I testified as an expert witness in the field of brand design on behalf of Luzier in the case of Bath & Body Works, Inc. and Baths, Inc. v. Luzier Personalized Cosmetics in the United States District Court for the Southern District of Ohio.
7. In addition to the clients that Willoughby Design Group serves, I am active on two National Design Boards. As a board member of AIGA (American Institute of Graphic Arts) I am responsible to 17,000 design professionals and students in design schools by providing guidance on ethics, business practices and advice on design issues. The AIGA board helps set design policy for our members and is the leading advocate for design thinking and education in the US. I am currently working on developing new standards for judging the AIGA 365 design competition on Brand Strategy and Brand Design Systems (this includes packaging). The AIGA 365 competition is the premier graphic design competition in the US. I am a judge in this year's show for Comprehensive Brand Strategies and Corporate Communications Design. I was also a judge for the 2002 competition and the 1999 competition. I am helping develop a pilot program for Executive Design Leadership at Harvard in August 2003.

16. To provide context for the evaluation of the Mueller's brand it is useful to understand the history of puffery in early advertising and good package design. Puffery is a tradition in American commerce. Since the inception of branded products manufactures have used names, slogans and symbols associated with grand ideals to boost confidence, sales and brand awareness of their products. It is both cultural and human nature that people want to buy products from companies who claim they are the best, the favorite, the biggest, the ultimate, etc. People understand intuitively the implications in names and slogans as exaggerated claims. It is part psychological and part economic that puffery is acceptable as a cultural agreement. My favorite restaurant, the best car made, etc. Our American tradition and economic model is built on that desire to improve ones life through the use of brand name products. The cosmetic market would collapse if women didn't desire to look better, all the while knowing that most of what they see and read is puffery. Only when a company is specific about measurable and factual qualities or properties of its products does a consumer expect truth, i.e. ingredient labels, nutrition facts, fabric content and made in the USA. A Chrysler ad in the New York Times, Feb 16, 03 reads, "...6 speed transmission," a measurable quality. However, it continues on "...50% American imagination, 50% German precision, 100% passion," which is puffery. See Exhibit C. Even though specific percentages of each quality are given, the consumer understands that you can't measure precision, imagination or passion, but you can measure how many speeds a transmission has. In our desire to believe Chrysler is a better car, we allow Chrysler to puff away. In Kansas City, a city famous for its steak, three different steakhouses claim the best steak in the city, but who is to say which one really is the best? See Exhibit D. Is a car bought from Superior Lexus any different than one bought from any other Lexus dealer? Is UMB really America's Strongest Bank? Other puffery examples in names and slogans: Best Western, Best Foods, Preferred Mutual Insurance Company, The Greatest Show on Earth, BMW, The Ultimate Driving Machine, Bayer, The World's Best Aspirin, Hush Puppies, The Earth's Most Comfortable Shoe, Prudential, Preferred Reality. See Exhibit E

17. At the same time in the early days of packaged goods development, when Mueller's was a new brand, it was common to adopt patriotic imagery and names that associated the product with ideas that consumers respected. Association has been used for the last 150 years to imply that one brand is better or more desirable than the competition. Manufacturers have always used associations to imbue their products with status and increase desire to purchase. Association with American symbols is one of the most long-standing traditions in branding and advertising in our country. Use of the American flag, the colors red, white and blue, and associations with American ideals is part of our cultural heritage and common agreement as both citizens and consumers. "Being American and showing patriotism is good for the country and good for commerce," we all have heard. Patriotic products reinforce our sense of belonging and purpose as a citizen of the US. Emotionally, people have always responded to products that claim to be American because they symbolize values we share as a culture. Association with famous Americans is common, and it doesn't necessarily mean they founded or support the brand, i.e. John Hancock, Dolly Madison, Washington Mutual and Franklin Mint. Other examples of companies who use a patriotic or American association to suggest a powerful or large geographic reach are First National Bank, Capitol Records, Uncle Sam's Cereal, Camel Cigarettes (American Blend), National Car Rental, American Airlines, America West Airlines, Drive the USA in Your Chevrolet, Bank of America, the New York Yankees, and Columbia Tristar Entertainment (Statue of Liberty). See Exhibit F.

18. The phrase, "America's Favorite" is an expression that has been used since the founding of our country to express patriotic ideals. A Google search turned up 647,000 uses of this phrase (see exhibit G) and most of these are pure puffery, i.e. "America's Favorite Son." The most important point I wish to make is that the phrase "America's Favorite" has multiple meanings. The phrase has no inherent specific subjective meaning or factual (objective) meaning. Only when a company links a specific claim directly to the words "America's Favorite" does the phrase acquire a specific meaning to the consumer, i.e. America's Favorite Mustard (is #1 in US sales.) A product can be #1 in sales or market share, but the phrase "America's Favorite" does not imply either a subjective or factual meaning until the manufacturer indicates why the product is America's favorite. In the case of Mueller's the consumer can "Taste why Mueller's is America's favorite pasta." This phrase is completely subjective and is considered puffery by consumers. In my experience if communicating the fact that the product is #1 in sales is important, companies will state a specific claim.

19. The Mueller's brand has evolved over a long period and the trade dress elements of the brand identity that are part of the trademark were first used starting in the early 1900's and thus have equity with consumers. The first use of the phrase "America's Favorite" on the Mueller's packaging was in the mid-fifties.

20. Mueller's brand identity (image) and trade dress was established over the past 100 years. Over the decades, consumers and generations of families have purchased the Mueller's brand based on their family experience and recognition of the product through advertising, promotions and packaging. Of these three forms of brand communication, product packaging is the most critical in terms of providing consistent visual and verbal clues and signals so that consumers can locate the product in self-service grocery chains. Notice how beer, Coke, Campbell's Soup and most packaged good products change in very small steps over the years. Even when commercials change the core products, package design and trade dress features remain consistent on TV and in the store. Coke is associated with red, Wonder Bread owns dots, BMW owns the "Ultimate Driving Machine," Hush Puppy owns "The World's Most Comfortable Shoe," Chevy owns "Like a Rock". Manufacturers literally own these trade dress elements because consumers associate these visual and verbal words and graphics with the brands they buy.

21. It was the early positioning of Mueller's as an American brand, expressed in packaging through the white package with patriotic colors and symbols, that established the brand heritage that would help Mueller's build a lasting consumer bond as a trusted brand.

Advertising, pasta shapes (with American names like elbow, noodles, shells, twist, along with American recipes reinforced the association of Mueller's with American pride, home cooking in war time and peace throughout the 20th century.

Note in Exhibit B, Mueller's packaging from 1914 (the first sample found). The packaging design has remained true to their core brand trade dress although the fonts and images have been updated. Today's packaging still has dominant blue ends with a small red stripe and a white field where the brand name and brand elements are used. From 1914 until 2003 the Mueller's name is consistently red. The first use (that we have) of the flag as a trademark is in 1914. In fact, people referred to Mueller's as the flag brand during the early 1900s. Today the flag is used in a more modern form as part of the trade

dress and brand identity as a more symbol icon (stars and stripes) than a descriptive symbol. See Exhibit H

22. In conclusion, these are my observations:

- The phrase "America's Favorite Pasta" has multiple meanings that are subjective as used by Mueller's.
- The word "favorite" is subjective and has hundreds of meanings.
- Mueller doesn't use the statement "America's Favorite Pasta" in conjuncture with one of the possible measurable meanings of favorite, i.e. number one in sales, market share etc.
- The only reference to the meaning of "America's Favorite Pasta" on the packaging is "taste" which is also a subjective term.
- AIPC's use of the term "America's Favorite Pasta" on Mueller's packaging is puffery and has no impact on the purchasing decision of the consumer other than brand recognition.
- Mueller's has used the phrase "America's Favorite" beginning in the 1950's on either packaging or in promotions.
- The phrase "America's Favorite Pasta," the colors, logo, patriotic symbols and American associations (as distinct from Italian, see Exhibit I) are all part of Mueller's long brand heritage and are familiar to generations of American families.
- Mueller's brand heritage is expressed in these trade dress features, evolved over 100 years with cultural and commercial acceptance.
- All of these trade dress features, including the phrase "America's Favorite Pasta," serve as a trademark function and help consumers recognize the Mueller's brand.


Ann Willoughby Date

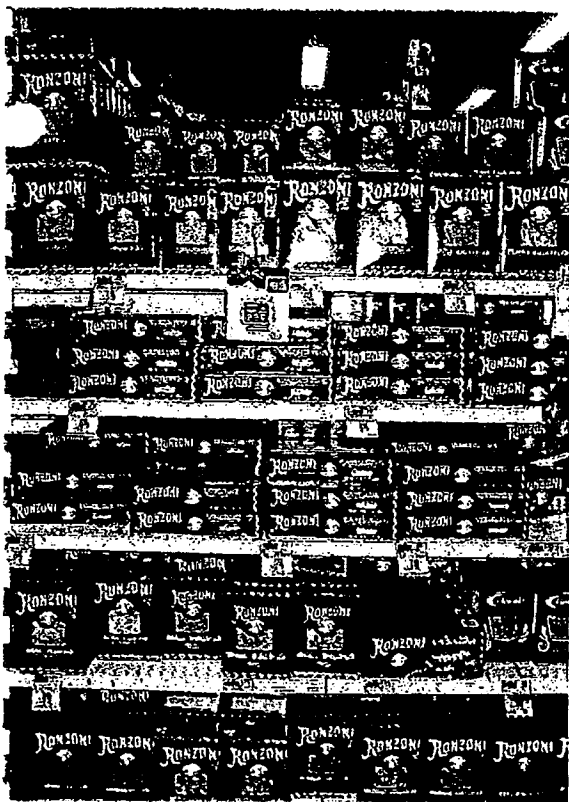


Exhibit A



THE DESIGN CAPITAL OF AMERICA IT'S WELL WITHIN OUR REACH

Ingram's October cover headline, "Building a Greater Kansas City, The Architectural/Design Capital of America," caught my attention. I love the sound of "The design capital of America" as in "I am from Kansas City, you know, the design capital." But is it possible? Or even desirable?

I think it is not only possible for Kansas City to be one of the leading design centers in the world, it is one of the best opportunities for KC to succeed as an economic leader in coming decades. Please allow me to explain and perhaps paint a somewhat optimistic, but entirely plausible, picture of how this scenario might unfold.

Richard Florida, author of *The Rise of the Creative Class*, says, "Human creativity—the ability to generate and implement new ideas—is the key to economic growth." If this is true, and I believe it is, Kansas City should welcome talented young designers, scientists, engineers, architects, researchers, artists and writers with open arms. We should support and nurture the creative communities that already exist.

Back in the 1970s, I started my design business in the newly developed Westport Square. It was a moment when almost every business in Westport was run by a young entrepreneur. Westport was a cluster of creative people who fed off of each other's enthusiasm, ideas and mutual support. And everyone wanted to be near what was then Kansas City's creative epicenter. However, an important ingredient in Westport's early success was the corporate and civic investment, both economic and social.

So what will it take for Kansas City to become a creative design center in this decade when the bottom line is often the most immediate factor in determining our investment strategies?

Perhaps we need a better understanding of the value-link between the creative factor and Kansas City's future economic, social and cultural health.

The creative factor is about investing in people and the creative environment that nurtures them. No one could have predicted that Joyce Hall would have started a social

expression empire or that Ewing Kauffman would build a multi-billion dollar pharmaceutical company.


We became the engineering hub in the early twentieth century because bright young engineers like Clinton Burns and Robert McDonnell, E.B. Black and Tom Veatch were on the leading edge of solving the technical and geographic transportation problems of their day. They built bridges, clean water and sewage facilities, tunnels, highways, airports, power plants: the physical infrastructure for our young country.

Because of this legacy, our engineering firms design the most famous stadiums in the world today.

Because of Joyce Hall's legacy to design, Hallmark is still able to recruit top design talent out of the best design schools and pay them competitive national wages.

The ability of a city to attract the best creative minds and knowledge-based workers ultimately helps business and fosters entrepreneurs (think Hallmark, Cerner, Sprint, Marion Labs, Black & Veatch). As companies move from tangible, physical assets as their primary sources of wealth to intellectual capital, these young minds will create new wealth in patents, brands and processes that will drive growth and value in the future.

One way to realize this vision of growth is to invite and support the next generation of KC business. Be a mentor. Share your passion and expertise. Help nurture ideas and show enthusiasm for fledgling efforts. By being responsive and open to creative new ideas, the arts, science and technology, you are surely contributing to a stronger (and more interesting) Kansas City business community.

And, to the possibility that we all can proudly say we are from "the design capital of the United States." 

Ann Willoughby is Founder and President of Kansas City-based Willoughby Design Group founded in 1978. She is on the AIGA National Board of Directors and the steering committee of AIGA Brand Experience. You can reach her at aun@willoughbydesign.com or at 816-561-4189.

**One way to realize this vision
of growth is to invite and
support the next generation
of KC business. Be a mentor.**

- d. 2001 – How Magazine International Design Annual
1 Merit Award
- e. 2001 – How Magazine Self Promotion Competition
4 Awards
- f. 2000/2001 – AAF 9th District ADDY Competition
6 ADDY Awards
4 Citations of Excellence
- g. 2001 – Graphic Design:usa American Graphic Design Award
- h. 2001-Graphis Letterhead 5
1 Award
- i. 2001 – National Mature Media Awards
2 Awards
- j. 1999/2000 – AAF 9th District ADDY Competition
2 Citations of Excellence
- k. 2000 Omni's – American Advertising Awards (Ad Club of Kansas City)
4 Gold Awards
8 Silver Awards
7 Bronze Awards
- l. 2000 – PRINT's Regional Design Annual
2 Awards
- m. 1999 Omni's – American Advertising Awards (Ad Club of Kansas City)
4 Gold Awards
5 Silver Awards
9 Bronze Awards
- n. 1998 Omni's – American Advertising Awards (Ad Club of Kansas City)
2 Gold Awards
- o. 1996 Omni's – American Advertising Awards (Ad Club of Kansas City)
7 Gold Awards
- p. 1992 and 1990 – Kansas City art Director's Show
1 Gold Award each year
- q. 1989 – Kansas City Art Director's Show
1 Silver Award
- r. 1988 – University and College Designers Association
1 Award

Ann Willoughby

Work: Willoughby Design Group
602 Westport Rd
Kansas City, MO 64111
Phone: 816-561-4189
Fax: 816-561-5052

Home: 1025 W. 60th Terrace
Kansas City, MO 64113
Phone: 816-333-6417
Fax: 816-333-3190

I am a brand designer and the owner and founder of Willoughby Design Group. My firm specializes in brand and communications design for corporate, institutional and retail manufacturers of branded and packaged goods.

I am currently President and CEO of Willoughby Design Group located in Kansas City, Missouri. We have a staff of 18. We provide strategic services and brand identity design, positioning, naming, and design for brand communications, environments, packaged goods and services. Our clients include Hallmark Cards, Lee Jeans, Interstate Brands Corporation (Wonder Bread, Butternut, Hostess and Dolly Madison), Kauffman Foundation, Playtex and Best Choice.

Willoughby Design Group has developed packaging and brand identity design for Max Factor, Oil of Olay, Camay, Weight Watchers, Pampers, Hills Science Diet, Black and Decker, among others.

Professional Associations

AIGA National Board of Directors
AIGA National Board for Center for Brand Experience
AIGA Kansas City Chapter Advisory Board
HOW Magazine Editorial Board
Kansas City Ad Club member

Civic Boards

Kansas City Zoo Board
De La Salle Board

My company, Willoughby Design Group, has received a number of national and regional awards for brand identity design including:

- a. 2002 - How Magazine Self-Promotion Annual
- b. 2002 Prism Award
- c. 2001 Omni's - American Advertising Awards (Ad Club of Kansas City)
 - Best of Show
 - 6 Gold Awards
 - 5 Silver Awards
 - 3 Bronze Awards

- s. 1988 Omni's – American Advertising Awards (Ad Club of Kansas City)
1 Gold Award
3 Silver Awards
- t. 1988 – Kansas City Art Directors Show
1 Silver Award
- u. Print Magazine's Regional Design Annual
3 Awards
- v. 1987 – Communication Arts Design Annual
1 Award
- w. 1987 Omni's – American Advertising Awards (Ad Club of Kansas City)
1 Gold Award
2 Silver Awards
- x. 1987 – Kansas City Art Director's Show
6 Gold Awards
- y. 1987 – New York Art Director's Show
1 Award
- z. 1987 – Print Magazine's Regional Design Annual
3 Awards
- aa. 1986 – Kansas City Art Director's Show
2 Gold Awards
1 Silver Award
- bb. 1986 Omni's – American Advertising Awards (Ad Club of Kansas City)
1 Gold Award
5 Silver Awards
- cc. 1986 – Print Magazine's Regional Design Annual
2 Awards

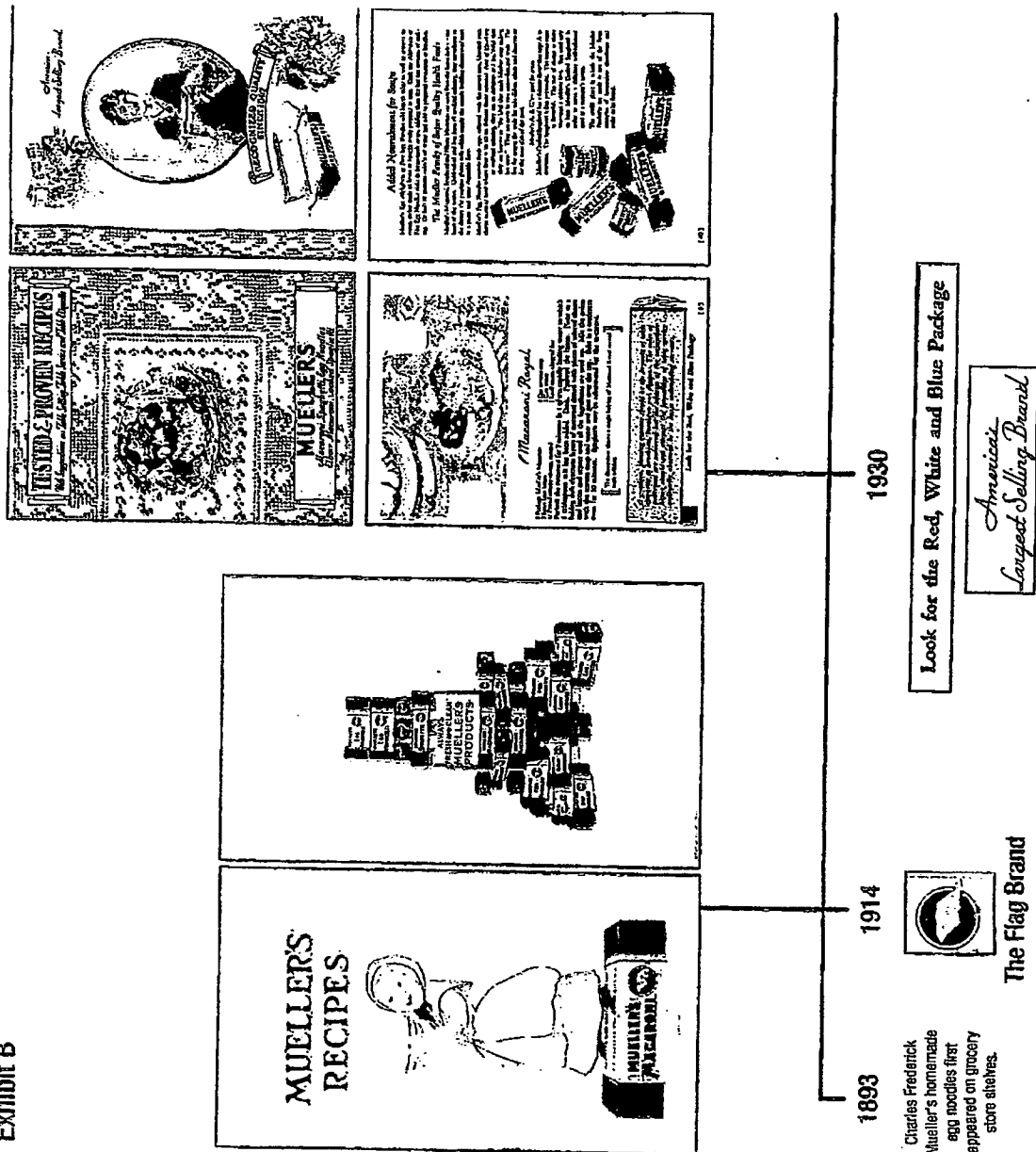
Teaching Experience

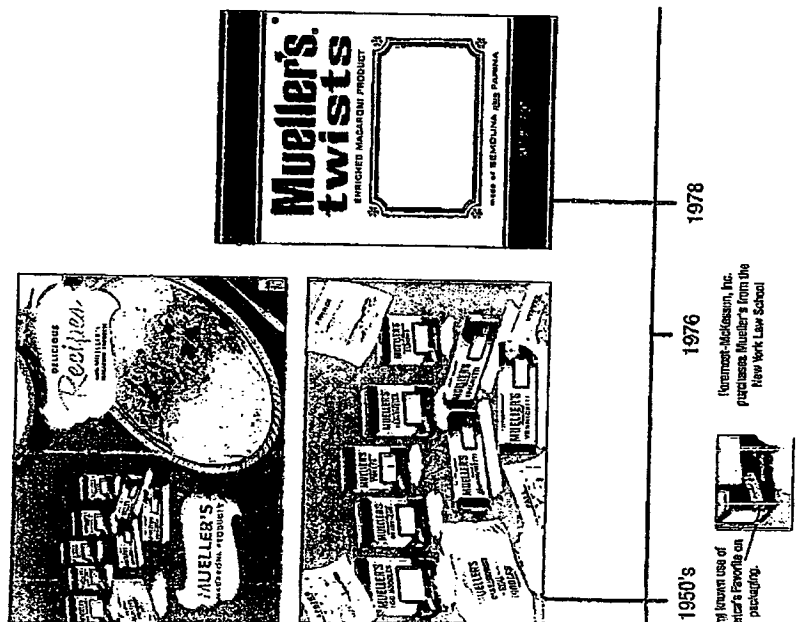
I have taught at the University of Kansas and the Kansas City Art Institute. As a visiting professor at KU I was instrumental in building a pilot program that helped graduating seniors and business create successful hiring models.

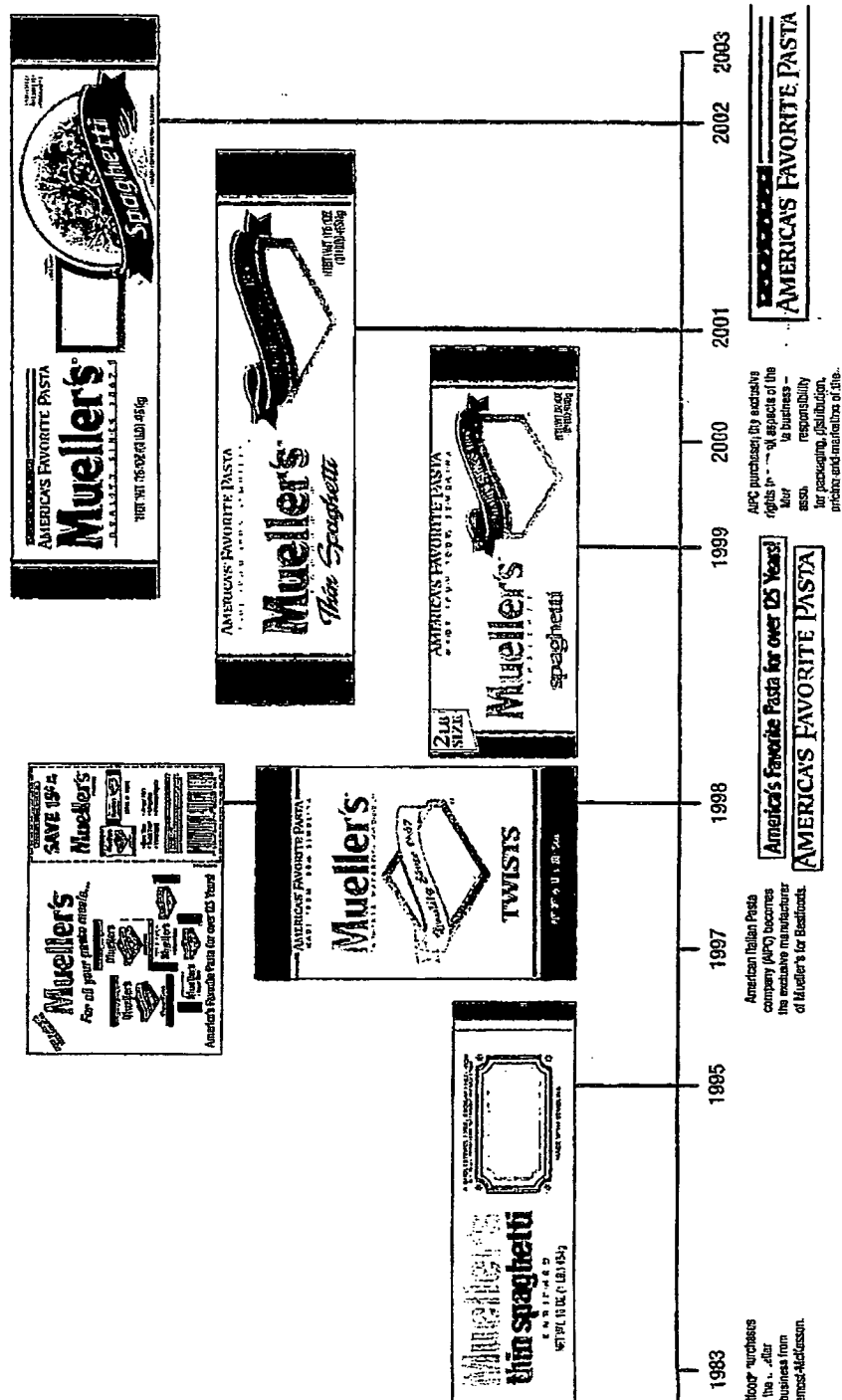
Expert Testimony

In June 1994, I testified as an expert witness in the field of brand design on behalf of Luzier in the case of Bath & Body Works, Inc. and Baths, Inc. v. Luzier Personalized Cosmetics in the United States District Court for the Southern District of Ohio.

Exhibit B







AIPC purchases the exclusive rights to all aspects of the Mueller's business - manufacturing, distribution, pricing and marketing of the...

American's Favorite Pasta for over 125 Years!

American Italian Pasta company (AIPC) becomes the exclusive manufacturer of Mueller's for Barilla.

1983 Mueller's For all your pasta needs...



THE CHRYSLER CROSSFIRE

1.6 L 16V 200 HP
 5-SP. MANUAL TRANSMISSION
 0-60 M.P.H. 10.5 SECS.
 TOP SPEED 140 M.P.H.
 0-100 M.P.H. 22.5 SECS.

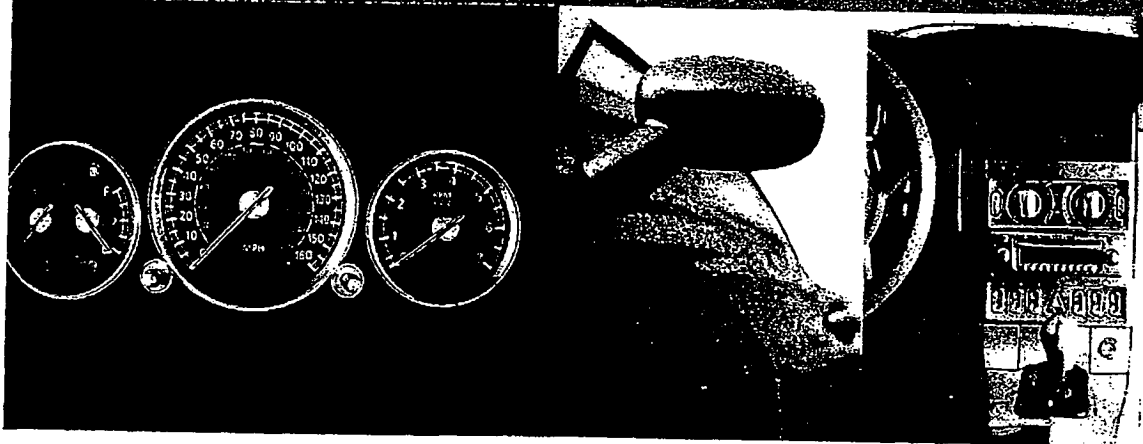
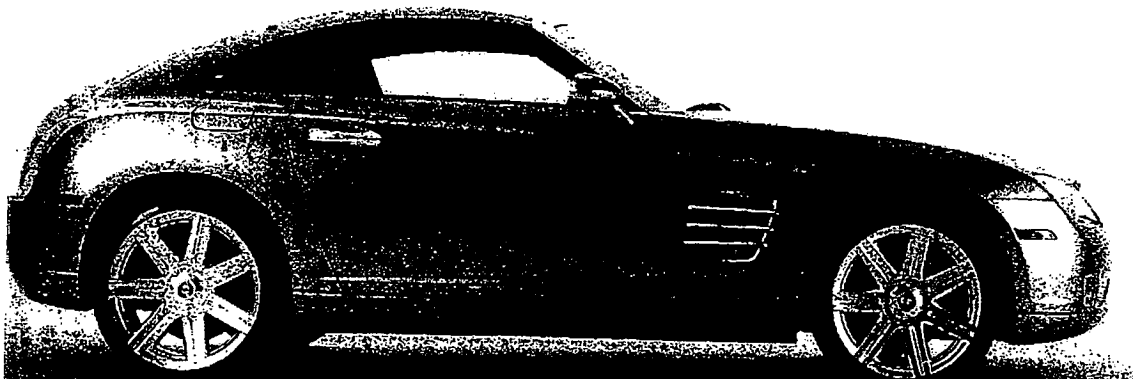


Exhibit C

The Majestic Steakhouse-
"The finest in beef, jazz and fun!"



931 BROADWAY
KANSAS CITY, MISSOURI 64105-1508


816-471-3184 (voice)
816-471-8686 (fax)
majesticsteak@earthlink.net
info@majesticgroup.com (e-mail)

COLUMBIA (IN THE CITY)

THE MAJESTIC STEAKHOUSE
KANSAS CITY, MISSOURI
KANSAS CITY, MISSOURI
KANSAS CITY, MISSOURI

Located at 10th and Broadway in the historic Thompson Hotel building in Downtown Kansas City, The Majestic Steakhouse offers the best in Beef, Jazz and Fun. The old Thompson Hotel building was originally a school and hotel built in 1911. During the 1920's, the hotel was transformed into a speakeasy and a meeting place for many of Kansas City's famous and powerful leaders. The building was renovated in the mid 1980's to its former grandeur and is listed on the National Register of Historic Places. Located in Kansas City, The new 10th and Broadway Steakhouse opened its doors in March 1993, serving a tradition of fine food and drink. There is no other place for fine food in the old Thompson Hotel at 10th and Broadway.


The Golden Ox-
"Kansas City's Finest Steak"



THE
GOLDEN
OX

the Golden Ox menu

Our steaks are broiled over a sharp, hot flame from real charcoal that finishes the meat to a sear on the outside - juicy and tender within - with the rich juices that melt to the tantalizing taste and aroma.




From Our Hickory Charcoal Broiler


<p>Kansas City Strip The steak was born here, (our #1 Seller), for the hearty eater, a boneless sirloin from premium steers, aged to perfection. 24oz. (Bone-In) \$32.95, 14oz. \$25.95</p>	<p>Filet Mignon Of the finest beef tenderloin. 10oz. \$26.95, 7oz. \$21.95</p>
--	---

The Hereford House-
"The Best Steak in Kansas City"

ANDERSON
RESTAURANT GROUP



HEREFORD HOUSE



HEREFORD HOUSE
KANSAS CITY, MISSOURI

P
PIERPONT

HR
HOLLYWOOD ROOM


CATERING SOLUTIONS

HEREFORD HOUSE

KANSAS CITY • LEAWOOD • LAWRENCE • INDEPENDENCE

Specialty Steaks, Burgers, Sandwiches, and More!

Over 50 Years of Service



Hereford House chefs excel in the art of selecting the finest beef, patiently aging it to the peak of tenderness, flavor and perfection and serving it to you straight from the charcoal grill savoring, succulent and sizzling. The magic of the Hereford House — a relaxed congenial atmosphere, superb food, your favorite cocktails and friendly service — makes your visit a special occasion.

Join our exclusive **Steak & Seafood Club**

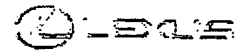
A restaurant only stays in business for 55 years if it serves the **BEST STEAK IN TOWN!**

Exhibit D



SUPERIOR LEXUS

HOME | CONTACT US | LEXUS.COM



Unilever Bestfoods
North America



Preferred Mutual

Insurance Company

MIDWEST EXPRESS AIRLINES

The best care in the air.



Prudential

Preferred Realty



UMB

Financial
Corporation



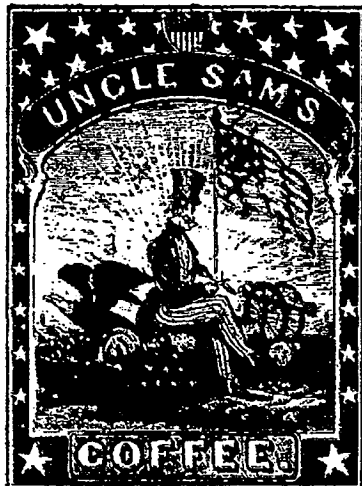
The Ultimate
Driving Machine



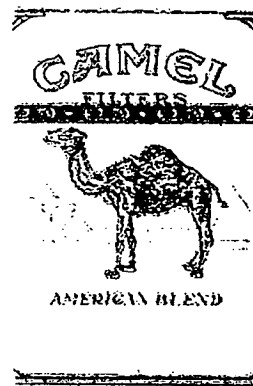
Exhibit E



John Hancock
Insurance for the Unexpected
Investments for the Opportunities™



Mobil



AMERICA WEST AIRLINES
American Airlines



Exhibit F

On October 1, 1957, Jack C. Webb began a Kansas City tradition—the Herford House—that endures to this day. Located close to stockyards that processed the finest corn-fed beef from Missouri, Kansas, Iowa, and Nebraska, the Herford House popularity was natural in a city considered the major beef capital of the Midwest. "Locals" from as far away as Sedalia traveled to dine on America's finest steaks. Dinner at the Herford House was on the itineraries of Kansas City visitors.

Google™

[Advanced Search](#)

[Preferences](#)

[Language Tools](#)

[Search Tips](#)

america's favorite

Google Search

[Web](#) [Images](#) [Groups](#) [Directory](#) [News](#)

Searched the web for america's favorite

Results: 1 - 10 of about 707,000. Search took 0.06 seconds

Landover Baptist: Where The Worthwhile Worship, Unserved Unwelcome ...

A Handful of Bush Supporters Take To the Streets In Support of the President

The national counter-protest was organized by FreeRepublic.Com Read More> ...

Description: "The Largest, most powerful assembly of worthwhile Christians to ever exist." Unserved Not Welcome!

Category: [Society > Religion and Spirituality > ... > Christianity > Parodies](#)

www.landoverbaptist.org/ - 42k - [Cached](#) - [Similar pages](#)

America's Favorite Golf Schools: Golf School Vacations

America's Favorite Golf Schools. 2, 3 and 5 day Golf School Vacations. ... America's

Favorite Golf Schools 1295 SE Port St. Lucie Blvd. ...

Description: Offers two, three, and five day golf vacation getaways at over 40 locations worldwide.

Category: [Sports > Golf > Instruction > Golf Schools](#)

www.afgs.com/ - 28k - [Cached](#) - [Similar pages](#)

ILLT - America's Favorite Quilting Magazine

Win \$250! Your quilt could be on the cover of our next issue!!! Enter our on-going Cover Contest! Meet the editor! Jean Ann Wright. Dear Quilters, ...

Description: By Harris Publications.

Category: [Arts > Crafts > Quilting > Publications](#)

www.quiltmag.com/ - 17k - [Cached](#) - [Similar pages](#)

Click Here for Directions to our Corporate Offices

Click Here for Directions to our Corporate Offices.

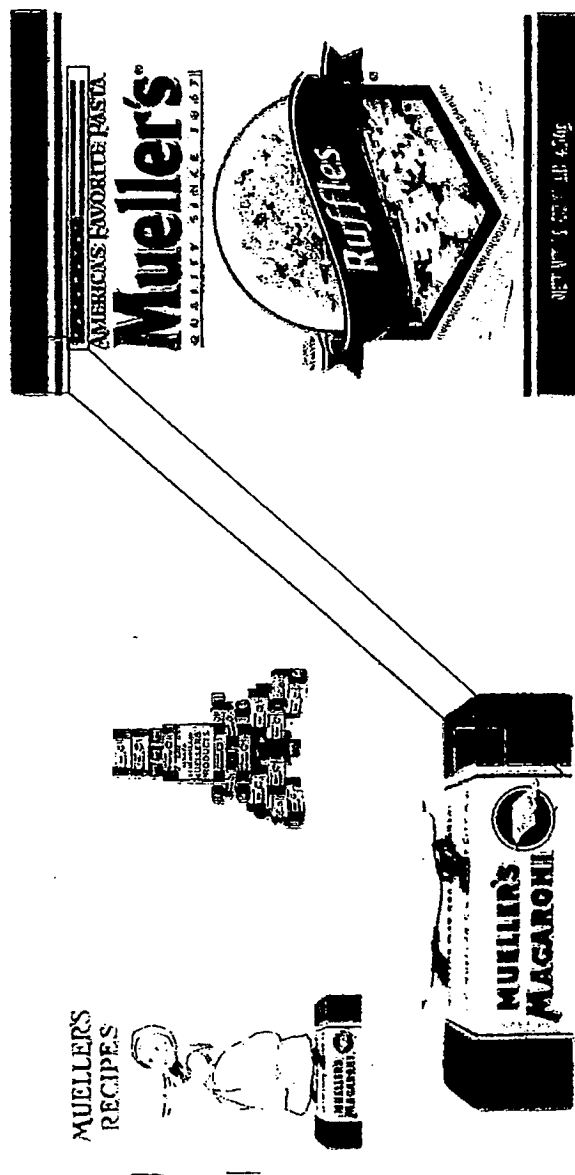
Description: Brands include Oreo Cookies and Planters Peanuts. Fun stuff, information, and on-line shopping for...

Category: [Business > Food and Related Products > Snack Foods](#)

www.nabisco.com/ - 7k - [Cached](#) - [Similar pages](#)

Exhibit G

Packaging Comparison, 1914 to the present



Mueller's is an American brand, with remarkably constant packaging dating back to 1914.

- Red white and blue package
- American Flag on package - "The Flag Brand"
- American rather than Italian pasta names and recipe.

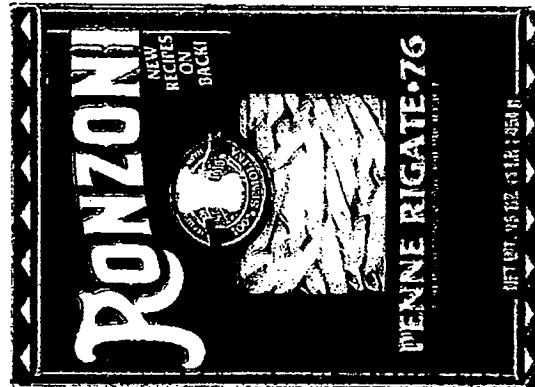
Exhibit H



Dominant use of red, white, and blue
 Stars and stripes shows it is a flag brand
 American description for pasta name
 Distinctly American recipes on box
 Mostly white package



Use of green, white and red represents the Italian flag
 Claims it is Italy's #1 pasta
 Italian description for pasta name
 Multi-lingual packaging
 Mostly blue package



Triangle pattern and type treatment
 is more Old World Style
 Italian description for pasta name
 Mostly blue package
 Distinctly Italian recipes on box

WILLOUGHBY DESIGN GROUP

B I O G R A P H Y

NAME

Ann Willoughby

TITLE

Founder/President

page 1 of 2



Ann Willoughby is the President and Creative Director of Willoughby Design Group, a brand innovation and identity design firm she founded in 1978. Willoughby Design has developed brand identity systems for groundbreaking retail start-ups including Three Dog Bakery, Einstein Bros Bagels, Noodles, SPIN! and Kevin Carroll. Other retail clients include Buckle, Lee Company, Hallmark, Interstate Brands Corporation, Playtex and Nestle.

Each year more and more companies turn to Ann and her collaborative team of 18 to help them create innovative products, communications and brand experiences that bring heightened beauty, emotion, simplicity and meaning to new generations.

Willoughby's holistic approach to design and business is reflected in the company's unique studio environment — a collaborative space where designers work alongside entrepreneurs, strategists, writers and specialists to innovate. The Willoughby studio, complete with a meditation room and off-site Design Barn retreat helps attract and retain top creative talent and brings blue chip clients to Kansas City.

Ann is a former National Board Director for AIGA, the professional asso-

[802] WESTPORT ROAD KANSAS CITY, MO 64111 PHONE: 816.561.4189 FAX: 816.561.5052
WEB SITE: WWW.WILLOUGHBYDESIGN.COM

EXHIBIT

B

ciation for design. Ann serves on the National Board for AIGA Center for Brand Experience and is a member of the Editorial Board of HOW magazine. She was co-chair of the 2004 AIGA Business & Design Conference in New York.

Ann attended the pilot AIGA design leadership program at Harvard Business School and in 2005 the Aspen Design Summit. Ann is a frequent design judge and in 2005 served as judge for Communication Arts Design Annual 2005, the Dallas Society of Visual Communication, Hawaii's 5-0 Design Competition and the 11th Y Design Conference in San Diego.

The Willoughby team curated and designed "The Best of Brochure Design" for Rockport Publishers, Inc. as well as the Dictionary of Brand from A-Z for the AIGA Center for Brand Experience.

Willoughby Design Group has won awards from Print, Communication Arts, Graphis, and AIGA and has been published for over 25 years in national and international competitions and books. In 2005 Rockport selected Willoughby Design Group as one of the best Design Firms in US. Also in 2005 the firm was awarded a HOW Perfect TEN award for Kevin Carrol's identity and book, "Rules of the Red Rubber Ball."

Ann has taught design at the University of Kansas and at the Kansas City Art Institute. As a Visiting Professor at K.U., she was instrumental in building a pilot program that helped graduating seniors and businesses create successful engagement models. Teaching and Community outreach to women and children remain two of Ann's passions as she works with many organizations through her firm and the Willoughby Design Barn.

NEW LOOK!
SAME GREAT TASTE



America's Favorite Pasta

Sea Shells



ENRICHED MACARONI PRODUCT



MADE WITH NORTH AMERICAN GROWN DURUM WHEAT

NET WT 16 OZ (1 LB) 454 g

EXHIBIT

B

A GOOD CARB

Did you know that pasta is really a **GOOD CARB**?

PASTA has only a moderate effect on blood glucose levels, unlike other starches such as white bread, rice and potatoes, which means **PASTA** is not as readily converted into sugar.

PASTA is low on the *Glycemic Index* (GI) - and low GI Foods are digested more slowly, stay in the digestive system longer and help to naturally satisfy hunger! So, eating a delicious meal that includes **PASTA** can truly be one of your more healthful alternatives.

For more information about the Glycemic Index, Visit www.glycemic.com

GENERAL GLYCEMIC INDEX OF COMMON FOODS

PASTA Kidney Beans	→	LOW: 0-55 GI
Granola Bar Rye Bread	→	MEDIUM: 55-70 GI
Baked Potato White Rice	→	HIGH: 70 + GI

Eat Lower GI foods as a more healthful alternative!

COOKING DIRECTIONS

1. **BOIL** water (4 quarts per 16 oz of pasta).
2. **ADD** salt to taste (optional).
3. **ADD** pasta. Wait for reboil.
4. **COOK** uncovered, stirring occasionally, 11 to 12 minutes or until desired tenderness.
5. **REMOVE** from heat and drain.
TIP- If preparing a pasta salad, rinse with cold water after draining.



Sea Shells Con Broccoli

PREP TIME: 10 MIN COOK TIME: 10 MIN SERVES: 4

- 16 oz Mueller's® Sea Shells
4 cups fresh broccoli florets, uncooked
1/4 cup extra virgin olive oil
1 clove garlic, minced or 1 tsp garlic powder
1 tsp dried basil
1/2 tbsp dried rosemary
1/4 cup sun dried tomatoes, chopped fine
1/4 cup white wine (optional)
1 cup chicken or vegetable broth
1 cup Parmesan cheese
Salt and pepper to taste

- Cook Sea Shells according to package directions, adding broccoli the last 2 minutes of cooking time.
- Drain, cover and set aside.
- Heat olive oil in a large skillet; add garlic, basil, rosemary and sun dried tomatoes.
- Cook 1 minute.
- Add wine and reduce by 1/2. Add broth.
- Toss in broccoli and shells; stir until heated through.
- Add cheese and season to taste with salt and pepper.



VISIT MUELLERSMEAL.COM FOR
OTHER DELICIOUS RECIPES

Nutrition Facts

Serving Size 3/4 cup (58g) dry
Servings Per Container 8

Amount Per Serving

Calories 210 **Calories from Fat 10**

% Daily Value*

Total Fat 1g **2%**

Saturated Fat 0g **0%**

Trans Fat 0g

Cholesterol 0mg **0%**

Sodium 0mg **0%**

Total Carbohydrate 41g **14%**

Dietary Fiber 2g **8%**

Sugars 2g

Protein 7g

Vitamin A 0% • **Vitamin C 0%**

Calcium 0% • **Iron 10%**

Thiamine 30% • **Riboflavin 16%**

Niacin 20% • **Folate 25%**

*Percent Daily Values are based on a 2,000 calorie diet. Your daily values may be higher or lower depending on your calorie needs:

	Calories:	2,000	2,500
Total Fat	Less than	65g	80g
Sat Fat	Less than	20g	25g
Cholesterol	Less than	300mg	300mg
Sodium	Less than	2,400mg	2,400mg
Total Carbohydrate		300g	375g
Dietary Fiber		25g	30g

Calories per gram:

Fat 9 • Carbohydrate 4 • Protein 4

INGREDIENTS: DURUM SEMOLINA, NIACIN, FERROUS SULFATE (IRON), THIAMINE MONONITRATE, RIBOFLAVIN, FOLIC ACID.

CONTAINS WHEAT INGREDIENTS

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KANSAS CITY, MO 64118

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1500 EAST PASTA DRIVE, KANSAS CITY, MO 64118

Ann Willoughby

November 3, 2006

Page 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN ITALIAN PASTA
COMPANY,

Applicant,

vs.

Opposition No. 91-161,373

BARILLA G. E. R. FRATELLI-
SOCIETA PER AZIONI,

Opposer.

DEPOSITION OF

ANN WILLOUGHBY

November 3, 2006
3:10 p.m.

Law Offices of Hovey Williams LLP
2405 Grand Boulevard
Kansas City, Missouri

Bobbi J. Pyle, Certified Court Reporter for the State of Missouri

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APPEARANCES

FOR THE APPLICANT:

ROTHWELL, FIGG, ERNST & MANBECK

BRIAN E. BANNER, ESQUIRE

1425 K Street NW, Suite 800

Washington, DC 20005

FOR THE OPPOSER:

HOVEY WILLIAMS, LLP

THOMAS H. VAN HOOZER, ESQUIRE

CHERYL L. BURBACH, ESQUIRE

2405 Grand Boulevard, Ste. 400

Kansas City, MO 64108-2519

ALSO PRESENT:

MS. KATIE GRAY

449c8f7e-487e-4bdc-8353-0e4f4d91dd5c

1

STIPULATIONS

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IT IS HEREBY STIPULATED AND AGREED by and between counsel for the applicant and counsel for the opposer that this deposition may be taken in stenographic shorthand by Bobbi J. Pyle, Certified Court Reporter, and afterwards reduced into typewriting.

IT IS FURTHER STIPULATED AND AGREED by and between the parties that presentment to the attorneys of record of a copy of this deposition shall be considered submission to the witness for signature within the meaning of the Trial Procedure and Introduction of Evidence 703.01(j) -- 37 CFR 2.123(e)(5); but shall in no way be considered as a waiver of the witness's signature, to be signed by the witness at any time before or at the trial of this case, and if not signed by the time of trial it may be used as if signed.

IT IS FURTHER STIPULATED AND AGREED between counsel for the respective parties hereto that the deposition of the witness may be signed before a notary public.

1 Deposition of Ann Willoughby

2 November 3, 2006

3 PROCEEDINGS

4 (The proceedings were scheduled to
5 begin at 2:00 p.m. Proceedings actually
6 began at 3:10 p.m.)

7 ANN WILLOUGHBY, of lawful age,
8 being first duly sworn to tell the truth, the
9 whole truth, and nothing but the truth,
10 deposes and says on behalf of the opposer, as
11 follows:

12 THE REPORTER: Do you solemnly
13 swear that the testimony you are about to
14 give in the cause pending will be the truth,
15 the whole truth, and nothing but the truth?

16 THE WITNESS: I do.

17 DIRECT EXAMINATION

18 BY-MS.BURBACH:

19 Q. Would you please state your name
20 for the record?

21 A. Ann Willoughby.

22 Q. Ann, have you ever been deposed
23 before?

24 A. Yes.

25 Q. More than once?

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1 A. Once or twice.

2 Q. Okay. I'll just go over a few
3 ground rules that you're probably aware of,
4 but just to refresh your memory.

5 I would ask that you let me
6 complete questions before you answer.

7 A. Okay.

8 Q. Refrain from saying "um-hum" or
9 shrugging. Make sure you say "yes" or "no"--

10 A. Okay.

11 Q. --so the court reporter can take
12 it down. It's important that we don't try
13 to speak over each other.

14 A. Okay.

15 Q. So try to do that. And you
16 understand you're required to tell the truth,
17 you're speaking under oath?

18 A. Yes.

19 Q. And this would be as if you were
20 testifying at a trial?

21 A. Yes.

22 Q. I want to ensure you understand
23 the question so if at any point you don't
24 understand my question, feel free to ask me
25 to clarify.

1 And lastly, if you need a break,
2 just let me know and we'll take a break.

3 A. Okay.

4 Q. All right. Have you used any
5 other names other than Ann Willoughby?

6 A. I've used Ann Willoughby Beresford
7 before.

8 Q. Will you spell that?

9 A. Yes. B-e-r-e-s-f-o-r-d.

10 Q. And could you give us your
11 address?

12 A. Yes. 1025 West 60th Terrace,
13 Kansas City, Missouri 64113.

14 Q. At this point, I want to go
15 through your education.

16 A. Okay.

17 Q. Where and when did you graduate
18 high school?

19 A. I graduated in 1964 in Jackson,
20 Mississippi.

21 Q. And where did you -- You went to
22 college afterwards, I assume?

23 A. Yes, um-hum.

24 Q. Where did you go?

25 A. University of Southern Mississippi

1 in Hattiesburg.

2 Q. And did you receive a degree from
3 there?

4 A. I did, BSA in design and fine
5 arts.

6 Q. Do you have any other degrees?

7 A. No.

8 Q. Do you have any other classes or
9 education you've taken since then?

10 A. No, but I've taught.

11 Q. Tell me about that.

12 A. I've taught at the University of
13 Kansas and I've taught--

14 Q. What did you teach there?

15 A. I taught design.

16 Q. And when did you do that?

17 A. I did that from 1980 to 1986.

18 And I've taught courses all around the
19 country, but, like, at the Art Institute and
20 things like that, like, seminars or maybe a
21 five-week course.

22 Q. And you said it was a bachelor's
23 of fine arts, right?

24 A. Yes.

25 Q. Okay. After you graduated --

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1 we'll go through your employment history now.

2 A. Okay.

3 Q. So if you would tell me where you
4 began working after you graduated from college
5 up to the present day.

6 A. Okay. Well, actually when I was
7 in college, I ran an advertising department
8 for a department store in Hattiesburg for
9 three years.

10 When I graduated, I came to Kansas
11 City and I started working at Macy's in their
12 advertising department doing merchandising and
13 design and fashion illustration, you know,
14 basically my background.

15 And after that, I started my own
16 business.

17 Q. So that would have been in 1965,
18 approximately; is that right?

19 A. I graduated from high school in
20 '64 and from college in '69.

21 Q. Okay. And so you worked at Macy's
22 in '69?

23 A. Oh, it was probably '69, '70-ish,
24 you know, until, like, '71 or so.

25 Q. Okay. And then you started a

1 company?

2 A. In about '72, yes.

3 Q. What was the name of that company?

4 A. I was freelancing -- I had
5 children -- Ann Willoughby Design, but then I
6 officially started my company in 1978.

7 Q. Is that where you've been ever
8 since?

9 A. Yes, sir -- yes, ma'am.

10 Q. What's your title with the company?

11 A. I'm the CEO and creative director.

12 Q. And have you had any other titles
13 there since the company has been formed?

14 A. Well, no.

15 Q. How many employees does your
16 company currently have?

17 A. We have 19.

18 Q. Are you a member of any
19 professional organizations?

20 A. Yes. I'm a former national board
21 member of the AIGA, which is the professional
22 association for design in the U.S.

23 I'm now on the AIGA center for
24 brand design.

25 I'm on the center for sustainable

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1 design.

2 I'm an advisory board member,
3 chair, of the AIGA here.

4 And I'm an editorial board person
5 on a couple magazines. HOW Magazine is one
6 and it's one of the AIGA magazines.

7 (Deposition Exhibit-95 was marked
8 by Ms. Burbach for identification.)

9 Q. (By Ms. Burbach) Okay. I'm going
10 to hand you what's been marked as Exhibit 95.

11 A. Okay.

12 Q. I know opposing counsel already has
13 a copy. This will help us both go through
14 it.

15 You said you were on the AIGA
16 national board of directors?

17 A. I'm a former.

18 Q. Former?

19 A. Yeah. I just went off the board
20 last year.

21 Q. Okay. Can you identify what
22 Exhibit 95 is by the way?

23 A. You mean this?

24 Q. Um-hum.

25 A. It's American Italian Pasta--

1 Q. No, no, I mean the title. What
2 is this document I handed you?

3 A. This is basically my r, sum, .
4 That's what I would call it.

5 Q. When you were on the board of
6 directors at AIGA, what were your
7 responsibilities on the board?

8 A. Well, I did a few things. I
9 chaired a design and business conference in
10 New York two years ago and I helped start a
11 design program at the Harvard Business School
12 for designers.

13 And several other things, but those
14 are the two big initiatives I was in charge
15 of.

16 Q. Did you say you were currently on
17 the national board center for brand
18 experience?

19 A. Yeah, brand experience.

20 Q. And what is that?

21 A. It's a board, a national board
22 that reaches across different disciplines and
23 we help educate companies and educators and
24 professionals about branding.

25 Q. Okay. And the AIGA center for

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1 sustainable design, can you tell me what that
2 is?

3 A. Well, that's a new board that I'm
4 on, because I really believe in sustainability.
5 and I'm working with a lot of big companies
6 now about how they talk about sustainability,
7 companies like HP and Harmon Miller, Monterey
8 Bay Aquarium, companies like that.

9 Q. And you said you were on the
10 editorial board of a couple magazines?

11 A. HOW Magazine.

12 Q. What is HOW Magazine?

13 A. HOW Magazine is a design trade
14 publication marketed to designers.

15 Q. What are your responsibilities?

16 A. Look at articles, help guide with
17 editorial content, find designers to be in
18 the magazine, things like that.

19 Occasionally I will write something
20 for them.

21 Q. Okay. I notice in your r, sum, it
22 says you're associated with the Kansas City
23 Ad Club?

24 A. I'm a member.

25 Q. And what is the Kansas City Ad

1 Club?

2 A. Basically it's an association of
3 advertising professionals in the city and it's
4 networked all across the country..

5 Q. Have you published any articles?

6 A. I've written a few. I write
7 probably one every year or so for, like, a
8 magazine like CA, which is Communication Arts.

9 Q. Okay.

10 A. And I also -- I think I've written
11 a couple for Ingram's or for magazines here
12 in Kansas City, just once in a while if I'm
13 asked to do so.

14 Q. I notice on the second page
15 through the -- it looks like four pages in,
16 there are a number of awards on there.

17 A. Right.

18 Q. I won't ask you to go through all
19 of them, but can you tell me what these
20 awards are?

21 A. Well, it's a variety of things.
22 Often I'm a judge for these competitions and
23 sometimes -- we usually don't judge the
24 things that we are entering, but our company
25 has won a lot of awards for design.

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1 And I'm very involved in the AIGA
2 and some of the local design awards, just
3 really kind of helping them guide what should
4 be rewarded, not just good design, but what's
5 good strategy and things like that.

6 Q. Who usually gives these awards?

7 A. Well, it depends. Sometimes
8 they're given by magazines, like, Communication
9 Arts.

10 HOW has one. AIGA probably has
11 the most prestigious in the country.

12 And there are, you know, the
13 Advertising Federation which is here in Kansas
14 City, they give them. They have Omni's, and
15 there's several others.

16 Q. Are you nominated for an award, is
17 that how you receive them usually?

18 A. Some cases you're nominated and
19 some cases you enter.

20 Q. Who nominates, typically?

21 A. Well, it depends on what it's for.
22 Like, I was nominated last year to be an
23 AIGA design fellow and you don't nominate
24 yourself for that, other people do. And then
25 I was selected.

1 Sometimes they ask you -- they'll
2 call and say, "Would you please enter a
3 certain book you designed? We think it will
4 be well received," and I do, and it wins.
5 Sometimes I'm invited and sometimes we just
6 enter.

7 Q. What's an AIGA fellow?

8 A. Well, should be a "fellowette" or
9 some-thing, right?

10 It is an award given to designers
11 across the country in major cities who are
12 outstanding. And there's probably 30 right
13 now around the country, something like that.

14 Q. So do your peers nominate you,
15 then?

16 A. Yes, yes, nominated by peers.

17 What it means is that you've done
18 something nationally and also in the community
19 to advance design and design thinking.

20 Q. Have you been an expert witness
21 before in a lawsuit?

22 A. Yes.

23 Q. Can you tell me about that, what
24 case it was?

25 A. It was in June of 1994, I was an

1 expert witness in the field of brand design
2 on behalf of Luzier.

3 It was in the case of Bath and
4 Body Works vs. Luzier. It was in the United
5 States District Court for the Southern
6 District of Ohio.

7 Q. Do you recall if that case
8 involved a trademark infringement claim?

9 A. Yes, it did.

10 Q. And were you qualified as a
11 witness -- I mean, were you certified as a
12 witness in that case?

13 A. Yes, yes. And I testified.

14 Q. An expert witness, I should say.

15 A. Yes.

16 Q. Let's talk about your company a
17 little bit.

18 A. Okay.

19 Q. What does Willoughby Design Group
20 do?

21 A. We're involved in branding and we
22 do two kinds of projects.

23 We help start-ups, entrepreneurs,
24 small business people, like, Einstein Bagels,
25 we helped them start that.

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1 And we've helped a lot of
2 companies, like, Three Dog Bakery start their
3 business and we help them with their business
4 plans, with their identity, with their
5 environments. And we design those things.

6 And the other kind of companies we
7 work with are large companies like Hallmark
8 or Nestle's who have initiatives and they'll
9 ask us to help with those.

10 They usually have something to do
11 with innovation where they have a new product
12 or -- recently we've been doing some new
13 product development for Nestle's centered
14 around nutrition, which is a big thing now.

15 We just help them develop
16 strategies, the product concepts, the naming,
17 the design of the bottles, things like that.

18 Q. Do you also help re-design
19 packaging or products?

20 A. Yes. One of our largest clients
21 for the past, I don't know, 10 or 15 years
22 has been Interstate Brands.

23 We help them with all of the
24 strategy on all of their brands, both their
25 cakes and the bread brands. And we help --

1 totally updating them every year, new
2 strategies.

3 I know last year we came out with
4 some whole wheat white bread and some new
5 products.

6 Q. Could you identify some of the
7 brands that you're working on?

8 A. Baker's Inn is one. Wonder is
9 one. We do Dolly. We do Twinkies. We
10 even worked on the Will Ferrell -- the design
11 of his outfit a little bit.

12 So we're involved in some of those
13 promotions, as well.

14 Q. Have you had other customers or
15 clients that you've worked with in the food
16 industry?

17 A. We've done a little bit of work
18 with Frito Lay. We've done work with LPK
19 and P&G.

20 We haven't worked for them in
21 probably several years, but we used to do a
22 lot of work with P&G.

23 Q. I think you touched on this a
24 little bit, but do you -- for these
25 companies, do you consult with them regarding

1 the packaging of their products?

2 A. Yes.

3 Q. Do you consult with them regarding
4 shelf placement?

5 A. I'm not sure--

6 Q. Like, in a grocery store or
7 location?

8 A. Do you mean in terms of how their
9 products are sold in or how they are
10 displayed on the shelf?

11 Q. Well, you tell me the difference.

12 A. Okay. We're not involved in the
13 product placement because that's a whole
14 different thing figuring out the allotments
15 for your shelf space.

16 Although sometimes we do encourage
17 companies to put their products together so
18 that they're not all spread out all across
19 the store. Sometimes we'll do, like, an end
20 cap or something so that it really makes the
21 product -- the way it looks together, it
22 really reads a lot better.

23 But normally what we do, though,
24 is when we design products for the shelf, we
25 make sure they really stand out and they're

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1 true to the brand and, you know, the
2 identity, the information hierarchy, the icons,
3 everything, you know, is fresh and it's easy
4 to read and easy for consumers to see what's
5 in it and how it works.

6 And sometimes we'll -- for example,
7 right now bread manufacturers are starting to
8 make smaller loaves of bread. I don't know
9 if you've seen that or not. But now that
10 means sometimes they stand up and set on
11 their end.

12 So we have to, like, figure out
13 how to design them so they work better for
14 the consumer.

15 So we're constantly looking at new
16 materials and new ways to package things so
17 they're fresher and, you know, more appealing
18 to the consumer.

19 Q. How do you decide how to package
20 something? What kind of -- do you use
21 research or studies? What would you use to
22 decide?

23 A. We have a lot of suppliers we work
24 with in the packaging industry and they're
25 always calling on us and saying, "Have you

1 seen this new container and have you thought
2 about this?"

3 And a lot of times our clients
4 will -- like, P&G, for example, they have all
5 their research labs and everything so they're
6 very well informed, as well.

7 But if we're working with a new
8 company, we have to do all the research and
9 find everything and have it sourced.

10 We just did a big project where we
11 had to have, like, seven different kinds of
12 bags made and they had to be made in the
13 orient and we had to go back and forth to
14 make sure they were right. We do that when
15 we have to.

16 (Deposition Exhibit 93 was marked
17 by Ms. Burbach for identification.)

18 Q. (By Ms. Burbach) Okay. I'm going
19 to hand you what is marked as Exhibit 93.

20 I'm going a little bit out of
21 order here, but can you tell me what that
22 document is?

23 A. This is a subpoena.

24 Q. Is this the subpoena that you
25 received in this case?

1 A. Yes, it is. Yes, it is.

2 Q. And are you here testifying today
3 on behalf -- or in response to the subpoena?

4 A. Yes, I am.

5 (Deposition Exhibit-94 was marked
6 by Ms. Burbach for identification.)

7 Q. (By Ms. Burbach) And I will also
8 hand you what is marked Exhibit 94. Do you
9 recognize this document?

10 A. Yes. This is the notice of
11 deposition.

12 Q. Did you receive that?

13 A. Yes, I did.

14 Q. On the notice of deposition--

15 A. Um-hum.

16 Q. --it says that the deposition was
17 to take place on November 2, 2006. Do you
18 see that?

19 A. Commencing on November 2nd, yes.

20 Q. Is it your understanding that we
21 re-scheduled for today--

22 A. Yes.

23 Q. --to assist opposing counsel with
24 schedules?

25 A. It was supposed to be at 2:00,

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